DEPARTMENT OF COMMERCE

Patent and Trademark Office

37 CFR Parts 1, 3 and 5

[Docket No. 950620162–5162–01]

RIN 0651–AA75

Changes to Implement 18-Month Publication of Patent Applications

AGENCY: Patent and Trademark Office, Commerce.

ACTION: Notice of proposed rulemaking.

SUMMARY: The Patent and Trademark Office (Office) is proposing to amend the rules of practice in patent cases primarily to implement changes related to the 18-month publication of patent applications in title 35, United States Code, contained in the Patent Application Publication Act of 1995 (H.R. 1733). Among the changes that are contained in H.R. 1733 would be the publication of patent applications after 18 months from the earliest filing date for which a benefit is sought, and the addition of provisional rights to the rights provided in a patent. These changes would apply to utility and plant applications other than provisional applications, but not to design applications.

DATES: Written comments must be submitted on or before September 19, 1995. A public hearing will be held on Tuesday, September 19, 1995, at 9:30 a.m. Those wishing to present oral testimony must request an opportunity to do so no later than September 14, 1995. Written comments and transcripts of the hearings will be available for public inspection on or about October 2, 1995, and will be available on or about October 2, 1995, through anonymous file transfer protocol (ftp) via the Internet (address: ftp.uspto.gov).

ADDRESSES: Address written comments and requests to present oral testimony to the Commissioner of Patents and Trademarks, Washington, D.C. 20231, Attention: Stephen G. Kunin, Deputy Assistant Commissioner for Patent Policy and Projects. In addition, written comments may also be sent by facsimile transmission to (703) 305–8825, with a confirmation copy mailed to the above address, or by electronic mail messages over the Internet to early-pub@uspto.gov. The public hearing will be held at the Holiday Inn—National Airport, 15th Street and Jefferson Davis Highway, Arlington, Virginia. The written comments and transcripts of the hearings will be available in Room 520 of Crystal Park One, 2011 Crystal Drive, Arlington, Virginia.

FOR FURTHER INFORMATION CONTACT: Stephen G. Kunin by telephone at (703) 305–8850, by facsimile at (703) 305–8825, by electronic mail at rbahr@uspto.gov, or Jeffrey V. Nase by telephone at (703) 305–9285, or by mail marked to the attention of Stephen G. Kunin, addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

SUPPLEMENTARY INFORMATION: This proposed rule change is designed primarily to implement the changes in practice related to the publication of patent applications provided for in H.R. 1733. H.R. 1733 was introduced in the House of Representatives on May 25, 1995. The amendments to title 35 relating to 18-month publication, if enacted as proposed, would be effective on January 1, 1996. A copy of this legislation may be obtained from the individuals identified in the **FOR FURTHER INFORMATION CONTACT** section of the notice.

Section 122 of title 35, United States Code, currently provides that patent applications are maintained in confidence until a patent is granted. H.R. 1733, if enacted, would amend 35 U.S.C. 122 to provide that each application for patent, except for design applications filed under 35 U.S.C. 171 and provisional applications filed under 35 U.S.C. 111(b), shall be published ''as soon as possible after the expiration of a period of 18 months from the earliest filing date for which a benefit is sought,'' but provides that applications that are no longer pending and applications that are subject to a secrecy order under 35 U.S.C. 181 shall not be published.

H.R. 1733 includes a provision (35 U.S.C. 122(b)(2)) that, upon request, an application of an independent inventor who has been accorded status under 35 U.S.C. 41(h) will not be published until three months after an Office action under 35 U.S.C. 132; however, applications filed under 35 U.S.C. 363 and applications claiming the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, 365(a) or 365(c) are not eligible for such a request. In addition, H.R. 1733 provides that an applicant making such a request must certify that the invention disclosed in the application was not or will not be the subject of an application filed in a foreign country. H.R. 1733 provides that the Commissioner may establish appropriate procedures and fees for such a request.

H.R. 1733, if enacted, would further amend 35 U.S.C. 119 to provide that the claim and certified copy of the original foreign application must be filed in the Office at such time during the pendency of the application as required by the Commissioner, and that the Commissioner may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim. H.R. 1733, if enacted, would likewise amend 35 U.S.C. 120 to provide that the Commissioner may determine the time period during the pendency of the application within which an amendment containing the specific reference to the earlier filed application shall be submitted, and that the Commissioner may consider the failure of the applicant to file a timely claim for priority as a waiver of any such claim.

H.R. 1733, if enacted, would further amend 35 U.S.C. 102(e) to include applications published pursuant to 35 U.S.C. 122(b) within its scope. H.R. 1733, if enacted, would provide that the costs of early publication shall be recovered by adjusting the filing, issue and maintenance fees, by charging a separate publication fee, or by any combination of these methods. H.R. 1733, if enacted, would also provide that, upon issuance of the application as a patent, the patent shall, where the invention claimed in the patent is identical to the invention claimed in the published application, include provisional rights during the period from publication until issuance of the patent.

H.R. 1733 also includes amendments relating to 20-year patent term and provisional applications. Specifically, H.R. 1733 includes an amendment to 35 U.S.C. 119(e) to provide that if the day that is twelve months after the filing date of a provisional application falls on a Saturday, Sunday, or Federal holiday within the District of Columbia, the period of pendency of the provisional application shall be extended to the next succeeding secular or business day. H.R. 1733 also includes an amendment to 35 U.S.C. 154(b) to: (1) Include an unusual administrative delay by the Office in issuing the patent as a basis for patent term extension; (2) provide that the total duration of all extensions under 35 U.S.C. 154(b) shall not exceed ten years, as opposed to the five year limit currently provided in Public Law 103–465; (3) provide that no patent that has issued before the expiration of three years after the filing date of the application or entry of the application into the national stage under 35 U.S.C. 371 shall be extended under 35 U.S.C. 154(b); (4) provide that no patent whose term has been disclaimed beyond a specified date shall be extended under 35 U.S.C. 154(b) beyond the expiration date specified in the terminal disclaimer, and (5) provide that any

period of extension under 35 U.S.C. 154(b) shall be reduced by the period during which the applicant for patent did not engage in reasonable efforts to conclude processing or examination of the application, rather than the ''due diligence'' provision applicable to extensions under 35 U.S.C. 154(b)(2) in Public Law 103–465.

The current planning approach to the implementation of early publication is to create an electronic data base which captures the technical content, i.e., the specification, abstract, claims and drawings, of the application-as-filed. A data capturing operation will enable the creation of a data base containing image and text equivalent of the technical contents of the application-as-filed. Application materials will be digital image and/or optical character recognition (OCR) scanned by the Office for entry into this electronic data base. This electronic data base will be used to provide a source for (a) meeting publication requirements for the applications, (b) providing a basis for electronic searching and retrieval of applications, and (c) providing a basis for producing copies of the technical contents of the application-as-filed. The publication of an application will take the form of publishing information necessary to identify the applicant and the technical subject matter of the application, i.e., a Gazette Entry, in a separate Gazette of Patent Application Notices, with a one-page printed publication, i.e., a Patent Application Notice or PAN, containing similar information for placement in the paper search files. Published applications will be assigned a sequential Patent Application Notice (PAN) number in the manner that issued patents are assigned a sequential patent number. In addition, a document including the Patent Application Notice and the technical contents of the application-as-filed, designated as the Technical Contents Publication, will be available to the public upon publication.

The digital images of the technical contents of the application-as-filed, i.e., the Technical Contents Publication, will be available for public review. Paper copies of the Patent Application Notice and Technical Contents Publication will also be available for purchase similar to the way paper copies of patents are currently available for purchase. When budgetary and process considerations permit, text searching of the Patent Application Notice and Technical Contents Publication will be implemented.

The information provided to Patent and Trademark Depository Libraries will be expanded to include weekly issues of the Gazette of Patent Application Notices (provided by the Government Printing Office), and a CD–ROM collection of facsimile images of the Patent Application Notices and Technical Contents Publications. The public would also be able to place subscription orders to receive weekly paper copies of the Patent Application Notices and Technical Contents Publications published in specific classes and subclasses similar to the way such orders are currently placed for issued patents, as well as subscription orders to receive the CD–ROM collection of facsimile images of the Patent Application Notices and Technical Contents Publications.

H.R. 1733, as proposed, does not specifically exclude applications that are national security classified from those applications to be published. Executive Order 12356 and a number of statutes, e.g., 42 U.S.C. 2011 et seq. (the Atomic Energy Act of 1954), 15 U.S.C. 1155 (provides that the Secretary of Commerce shall respect and preserve the security classification of inventions in the possession or control of the Department of Commerce), and 18 U.S.C. 798 (provides criminal sanctions for the disclosure of classified information) preclude the publication of a national security classified application. Further, the publication requirement in H.R. 1733, as proposed, provides some latitude to the Commissioner to publish applications later than 18 months from the earliest filing date for which a benefit is sought. Therefore, the publication of a national security classified application will be delayed until such application is either declassified, which will permit publication of the application, or subjected to a secrecy order pursuant to 35 U.S.C. 181, which will exclude the application from publication by the express terms of H.R. 1733, as proposed. In view of national security considerations, and the current statutory prohibitions on the disclosure of classified information, it is appropriate to specifically exclude those applications that are national security classified from publication under the provisions of H.R. 1733.

While H.R. 1733, if enacted, would not directly affect design applications, this notice of proposed rulemaking includes a proposed amendment to § 1.154 such that the arrangement for a design application will be consistent with the arrangements for a utility (§ 1.77) or plant (§ 1.163) application, as well as a proposed amendment to § 1.5 to provide that a paper concerning a provisional application must identify the provisional application as such and by application number. In addition, while this proposed rule change is designed primarily to implement the changes in practice related to the publication of patent applications provided for in H.R. 1733, a number of proposed rule changes set forth in this notice of proposed rulemaking would be desirable even in the absence of an 18-month publication system. Specifically, this proposed rule change is also designed to: (1) clarify which applications claiming the benefit of prior applications or prior applications for which a benefit is claimed in a later application will be preserved in confidence; (2) amend the rules pertaining to the format and standards for application papers and drawings to improve the standardization of patent applications; (3) broaden the application of § 1.131 to instances in which inventions of a pending application or patent under reexamination and a patent held by a single party are not identical, but not patentably distinct; (4) broaden the application of §§ 1.78(c) and (d) to patents under reexamination, (5) clarify the practice for the delivery or mailing of patents; (6) provide for the treatment of national security classified applications; (7) expedite the entry of international applications into the national stage; and (8) amend a number of rules for consistency and clarity. Since these proposed rule changes may be adopted as final rules even in the absence of an 18-month publication system, interested persons are advised to comment on any proposed rule change, regardless of whether H.R. 1733 is enacted.

If H.R. 1733 is amended during the legislative process, the final rules will comply with this legislation as enacted. If H.R. 1733 is not enacted, the proposed rules that would implement publication of patent applications would be withdrawn.

In a Notice of Public Hearing and Request for Comments on 18-Month Publication of Patent Applications (18-Month Publication Notice) published in the **Federal Register** at 59 FR 63966 (December 12, 1994) and in the Patent and Trademark Office Official Gazette at 1170 Off. Gaz. Pat Office 390–94 (January 3, 1995), the Office requested public comment on the procedures the Office should adopt if an 18-month publication system was enacted. The 18-Month Publication Notice set forth the Office's planning approach for the implementation of 18-month (pre-grant) publication of patent applications, and specifically presented fourteen (14) questions on which comment was invited. An oral hearing was conducted on February 15, 1995.

Sixty-five (65) written comments, as well as two (2) Law Review articles concerning the pre-grant publication of pending patent applications, were submitted. Of the sixty-five (65) comments, forty (40) submitted comments directed to at least one of the questions presented in the 18-Month Publication Notice. Sixteen (16) persons testified at the public hearing conducted on February 15, 1995.

Response to Comments on the 18-Month Publication Notice

The following questions were presented in the 18-Month Publication Notice. Each question is followed by a summary of the comments submitted in response to the question, and the proposed disposition of the issue presented in the question.

1. Should the PTO require that all official application-related materials be delivered to a central location? Specifically, what problems would a requirement that all official application-related materials be delivered to a central location cause?

Summary: A slight majority of the comments opposed a requirement that all official application-related materials be delivered to a central location.

Response: As the Office currently considers the delivery of all official application-related materials to a central location to be unnecessary to the currently planned approach to implementation of 18-month publication, no change to the rules of practice to require that all official application-related materials be delivered to a central location will be proposed.

2. Should the PTO adopt a standard application format? If so, what portions of the application papers should the PTO require be submitted in a standard size and/or format, and what sanction (e.g., surcharge) should be established for the failure to comply with these requirements?

Summary: A majority of the comments favored the implementation of a standard application format, so long as an applicant was given a time period in which to comply with this format, i.e., failure to comply with the standard application format did not deprive the application of a filing date. In addition, a number of comments indicated that any additional requirements should not be inconsistent with European Patent Office (EPO) or Patent Cooperation Treaty (PCT) requirements, or in excess of those requirements necessary for the implementation of 18-month publication.

Response: The Office is proposing to change the rules of practice to institute only those additional standardizations which are consistent with the requirements set forth in PCT Rule 11, and are considered necessary for the digital image and OCR scanning of application materials into an electronic data base. Those additional standardizations are that: (1) applications be submitted on flexible, strong, smooth, non-shiny, durable and white paper (PCT Rule 11.3); (2) the papers be typewritten by a typewriter or word-processor, i.e., hand-written application materials would no longer be acceptable, with 1½ or double spaced lines (PCT Rule 11.9(c)), and in permanent ''dark'' ink (PCT Rule 11.9(d)) and portrait orientation, i.e., with the shorter sides of the paper on the top and bottom (PCT Rule 11.2(d)); (3) the sheets of papers be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches) (PCT Rule 11.5), with a top margin of at least 2.0 cm. (¾ inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (¾ inch), and a bottom margin of at least 2.0 cm. (¾ inch) (PCT Rule 11.6(a)); (4) the pages of the application be numbered consecutively, with the numbers being centrally located above or below the text (PCT Rule 11.7); and (5) the claims be on a separate sheet (PCT Rule 11.4). Finally, §§ 1.52(b) and 1.84(x) are proposed to be amended to provide that no holes should be provided in the paper or drawing sheets due to the potential for their interference with the scanning operation.

Section 1.52(b) currently requires that application papers be written on but one side, and § 1.72(b) currently requires that the abstract be on a separate sheet. In an application filed without: (1) typewritten application papers on flexible, strong, smooth, non-shiny, durable and white paper; (2) 1½ or double spaced lines in portrait orientation; (3) permanent ''dark'' ink typing; (4) sheets of papers of the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches), with a top margin of at least 2.0 cm. (¾ inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (¾ inch), and a bottom margin of at least 2.0 cm. (¾ inch); (5) the pages of the application including claims and abstract be numbered consecutively, starting with page one, with the numbers being centrally located above or below the text; (6) application papers typed on but one side; and (7) an abstract and claims on a separate sheet, the applicant will be given a time period, non-extendable under § 1.136(a), in which to file a substitute specification in compliance with § 1.125 on application papers in compliance with §§ 1.52(a) and (b). The Office, however, does not propose to require a surcharge for the failure to comply with these standardizations on filing.

Additional standardizations to the rules of practice concerning drawings requirements are also being proposed. Currently, § 1.84(f) permits paper sizes of 21.6 cm. by 35.6 cm. (8½ by 14 inches), 21.6 cm. by 33.1 cm. (8½ by 13 inches), 21.6 cm. by 27.9 cm. (8½ by 11 inches), and 21.0 cm. by 29.7 cm. (DIN size A4). Section 1.84(f), as proposed, would permit paper sizes of only 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches). The use of these paper sizes, which correspond to the paper sizes required under § 1.52(b), as proposed, would not impact the current Automated Patent System (APS) database, and would permit a fully automatic scanning operation due to their similar size. To electronically store, display, and print drawings paper sheet sizes up to 21.6 cm. by 35.6 cm. (8½ by 14 inches) would require modifications of the APS system hardware, software, displays, and printers. In addition, the digital image scanning of drawing paper sheet sizes up to 21.6 cm. by 35.6 cm. (8½ by 14 inches) would require a semi-automatic scanning operation, thus increasing scanning costs significantly. Therefore, § 1.84(f), as proposed, would permit paper sheet sizes of only 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches), with a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (9/16 inch), and a bottom margin of at least 1.0 cm. (⅜ inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 on 21.0 cm. by 29.7 cm. (DIN size A4) sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9⅝ inches) on 21.6 cm. by 27.9 cm. (8½ by 11 inch) sheets (PCT Rule 11.6(c)). As PCT Rule 11.6(d) provides that the margin requirements apply to 21.0 cm. by 29.7 cm. (DIN size A4) sheets such that a copy of the drawings sheet on a 21.0 cm. by 29.7 cm. (DIN size A4) sheet leaves the required margin, the requirement for drawing sheet sizes of only 21.6 cm. by 27.9 cm. (8½ by 11 inches) or 21.0 cm. by 29.7 cm. (DIN size A4) is not a substantive drawing limitation in excess of PCT Rule 11.

Currently, formal drawings are not required until an application has been allowed. As a drawing figure will be included in the Gazette Entry in the Gazette of Patent Application Notices,

as well as the Patent Application Notice, drawings of sufficient quality for digital image scanning into an electronic data base will be necessary for the initial processing of the application. In instances in which an application is filed with drawings of such poor quality as to preclude their digital image scanning into the electronic data base, it will be necessary to set a time period, non-extendable under § 1.136(a), in which to file drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction by digital imaging.

Currently, a complete application under § 1.51(a) does not require an abstract on a separate sheet, claims on a separate sheet, application papers typed on but one side of the paper, or application papers or drawings of sufficient clarity, contrast, or quality or in the proper size or format for electronic reproduction, and, as such, an application may be filed under § 1.60 from a prior application not in a format necessary for the image and/or OCR scanning of the application materials into an electronic data base. Therefore, an amendment to § 1.60(d) is necessary to assure the prompt filing of application papers including an abstract and claims on a separate sheet, application papers typed on but one side of the paper, and application papers and drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction.

Currently, the filing of the copy of the specification from the prior application, or a new specification, in an application filed under § 1.62 is considered improper. As applications filed prior to January 1, 1996, will not have been image- or OCR-scanned into the electronic data base, the technical contents of an application filed under § 1.62 in which the prior application was itself filed prior to January 1, 1996, will not be contained in the electronic data base. For applications under § 1.62 which do not add additional disclosure, i.e., continuation or divisional applications, the Office will obtain the microfiche copy of the prior application and image or OCR scan it into the electronic data base. For applications under § 1.62 which add additional disclosure, i.e., continuation-in-part applications, a substitute specification and drawings will be necessary for image or OCR scanning into the electronic data base. Therefore, an amendment has been proposed to § 1.62 to provide that, where the application is a continuation-in-part application, a substitute specification in compliance with § 1.125 and drawings will be required.

Section 1.62 currently provides that no copy of the prior application or new specification is required, and further provides that the filing of such a copy or specification will be considered improper, and a petition is necessary to obtain the date of deposit of the request for an application under § 1.62 as the filing date. Section 1.62, as proposed, would provide that the failure to provide any required substitute specification would not affect the filing date of the application, but a time period, non-extendable under § 1.136(a), would be set for its filing. Section 1.62, as proposed, would further provide that any new specification filed in an application under § 1.62 would not be considered part of the original application papers, but would be treated as a substitute specification under § 1.125. Any request to treat a new specification filed in an application under § 1.62 as part of the original application papers may be by way of petition under § 1.182.

Finally, amendments to §§ 1.77, 1.154, and 1.163 have been proposed to provide a standard arrangement for utility, design, and plant applications, respectively. This standard arrangement will include, *inter alia*, a Fee Transmittal form for utility, design, and plant applications, a Utility Patent Application Transmittal form, a Design Patent Application Transmittal form, a Plant Patent Application Transmittal form, and a Plant Color Coding Sheet for plant applications. Standardized versions of the Fee Transmittal form, Utility Patent Application Transmittal form, Design Patent Application Transmittal form, Plant Patent Application Transmittal form, Plant Color Coding Sheet, as well as a standard Declaration form and Plant Patent Application Declaration form, are included as an Appendix A to this notice of proposed rulemaking.

3. Assuming that the entire application is not published, what information concerning the application should be published in the Gazette of Patent Application Notices?

Summary: A slight majority of the comments indicated that the printed publication should include the entire application, or at least the claims, each independent claim, or a claim of each statutory class in the application. The remaining comments that did not oppose pre-grant publication indicated that any Patent Application Notice should contain information similar to what is published in the Official Gazette or sufficient information to determine whether further investigation was warranted. Those comments that opposed any pre-grant publication opposed publication of any information other than the applicant's name, address and a ''non-enabling'' abstract of the invention.

Response: The Technical Contents Publication will include a copy of the Patent Application Notice, and the specification, abstract, claims and drawings of the application-as-filed. The Technical Contents Publication will be available for public review through video display terminals in the Public Search Room and through CD-ROM collections of facsimile images of Patent Application Notices and Technical Contents Publications in the Patent and Trademark Depository Libraries. Copies of the Patent Application Notices and Technical Contents Publications will also be available for purchase under the conditions that paper copies of patents are currently available for purchase. When budgetary and process constraints permit, text searching of the Patent Application Notices and Technical Contents Publications will be implemented.

H.R. 1733, if enacted, would not provide any appropriations to cover the costs of early publication, but would provide that these costs are to be recovered by adjusting the filing, issue and maintenance fees, by charging a separate publication fee, or by any combination of these methods, i.e., that the patent applicant is to bear the costs of publication. A number of comments have criticized this method of allocating the publication costs as pre-grant publication provides no benefit to the patent applicant. The Office was required to balance the requests for a printed publication conveying the greatest amount of application information with those comments opposing additional publication costs. To provide the maximum amount of application information at the lowest cost to applicant, the specification, abstract, claims and drawings of the application-as-filed will be available for public review in the Technical Contents Publication.

4. Should the patent applicant receive a copy of the published application—either published notice and/or application content at time of publication?

Summary: A majority of the comments indicated that the applicant should receive a copy of the Patent Application Notice.

Response: The Office proposes to provide for the delivery of the Patent Application Notice similar to the current delivery of patents.

5. Should the PTO permit an accelerated examination? If so, under what conditions?

Summary: A majority of the comments favored permitting accelerated examination. A number of comments indicated that accelerated examination should be provided for applicants who either: (1) meet the current conditions for accelerated examination; or (2) pay a relatively high fee, i.e., that the Office should add the payment of a high accelerated examination fee to the current conditions for providing an accelerated examination. A number of comments, however, indicated that adding the payment of a high accelerated examination fee to those conditions for providing an accelerated examination would benefit large companies at the expense of small entities.

Response: The Office will provide accelerated examination only under the current conditions set forth in § 1.102, as described in MPEP 708.02. Accelerated examination is currently provided depending upon the subject matter of the invention, medical condition of the applicant, business circumstances, or the willingness of the applicant to participate in a special accelerated examination procedure. Increasing the number of applications receiving accelerated examinations could diminish the availability or speed of accelerated examination to an individual applicant because there will be more applications receiving an accelerated examination. It would further delay the examination of applications not provided with accelerated examination. Adding a condition for providing accelerated examination which bears no relationship to the merits of the application or circumstances of the applicant, i.e., for the mere payment of a fee, is not considered appropriate. Therefore, the Office does not propose to change the conditions under which the examination of an application will be accelerated.

The Office, however, will continue to make special an application under the conditions currently set forth in MPEP 708.02 (VIII), special examining procedures for certain new applications—accelerated examination. MPEP 708.02 (VIII) provides that a new application may be granted special status provided that the applicant: (1) submits a written petition to make special accompanied by the fee set forth in § 1.17(i); (2) presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status; (3) submits a statement that a pre-examination search was made; (4) submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims; (5) submits a detailed discussion of the references pointing out with the particularity required by § 1.111 (b) and (c) how the claimed subject matter is distinguishable over the references; and (6) submits any affidavit or declaration under § 1.131 that is necessary to overcome the references before the application is taken up for action, but in no event later than one month after request for special status. An application granted special status under MPEP 708.02 (VIII) will be taken up by the examiner before all other categories of applications except those clearly in condition for allowance and those with set time limits, such as examiner's answers, etc., and will be given a complete first action which will include all essential matters of merit as to all claims.

6. Since the cost for publishing applications must be recovered from fees, how should the cost of publication be allocated among the various fees, including the possibility of charging a separate publication fee?

Summary: The overwhelming majority of comments opposed a separate publication fee. Most comments indicated that the costs of publication should be spread over the existing fees, with the remaining comments indicating that these costs should be absorbed by those accessing the published applications or the Office.

Response: H.R. 1733, if enacted, would not provide appropriations for the Office to absorb the publication cost, but provides that the ''Commissioner shall recover the costs of early publication . . . by adjusting the filing, issue, and maintenance fees, by charging a separate publication fee, or by any combination of these methods.'' Notwithstanding that H.R. 1733, if enacted, would not authorize the Office to recover the costs of publication through those seeking access to the published application, the demand for publication products, e.g., Patent Application Notices and Technical Contents Publications, would not be consistent, and it would not be possible to project the demand for publication products with the degree of precision necessary to recover a substantial portion of the publication costs through the inclusion of such costs in the fees charged for the publication products. In addition, the Office will supply, *inter alia,* CD-ROM collections of facsimile images of the Patent Application Notices and Technical Contents Publications under the condition that CD-ROM collections of patent images are currently supplied. As the Office has no authority to control the further duplication of such images, it would not be practicable to attempt to recover publication costs through increases in the fees charged for publication products, since those persons desiring copies of Patent Application Notices or Technical Contents Publications would simply obtain them from the original purchasers of the CD-ROM collections, who need not include any publication costs in their prices. Therefore, the Office proposes to adjust the filing, issue, and maintenance fees to recover the costs of publication.

In a Notice of Proposed Rulemaking published in the **Federal Register** at 60 FR 27934 (May 26, 1995) and in the Patent and Trademark Office Official Gazette at 1174 Off. Gaz. Pat Office 134–50 (May 30, 1995), a number of changes to the rules of practice to, *inter alia,* adjust patent and trademark fees to reflect the fluctuations in the Consumer Price Index (CPI) pursuant to 35 U.S.C. 41(f) were proposed (Patent and Trademark Fee Notice of Proposed Rulemaking). The proposed patent and trademark fee adjustments, if adopted in final rules, would take effect on October 2, 1995 (October 1, 1995 being a Sunday), prior to the effective date of the fee increase in this notice of proposed rulemaking to recover the costs of publication. The proposed amendments to §§ 1.19(b)(1)(i) and 1.19(b)(1)(ii) are repeated in this notice of proposed rulemaking for clarity.

The Office estimates that it will cost about $9 million to publish applications in Fiscal Year 1996. To allocate these costs among the filing fees of those applications which the Office anticipates will be filed in Fiscal Year 1996, the issue fee for those applications for which the Office anticipates payment of an issue fee in Fiscal Year 1996, and maintenance fees due at three (3) years and six (6) months, seven (7) years and six (6) months, and eleven (11) years and six (6) months for those patents for which the Office anticipates payment of the respective maintenance fees in Fiscal Year 1996, a further increase in the filing fee for an original nonprovisional (35 U.S.C. 111(a)) or reissue application to $780 ($390 for a small entity) and a plant application to $540 ($270 for a small entity), issue fee for an original or reissue application to $1280 ($640 for a small entity) and a plant application to $660 ($330 for a small entity), maintenance fee due at three (3) years and six (6) months to

$1020 ($510 for a small entity), maintenance fee due at seven (7) years and six (6) months to $2020 ($1010 for a small entity), and maintenance fee due at eleven (11) years and six (6) months to $3020 ($1510 for a small entity) is necessary to recover the costs of publication in Fiscal Year 1996. A comparison of existing fee amounts, fee amounts proposed in the Patent and Trademark Fee Notice of Proposed Rulemaking, and fee amounts proposed in this notice of proposed rulemaking is included as an Appendix B to this notice of proposed rulemaking.

7. Should the PTO require an affirmative communication from a patent applicant indicating that the applicant does not wish the application to be published, or should failure to timely submit a publication fee be taken as instruction not to publish the application? That is, should an application be published unless the applicant affirmatively indicates that the application is not to be published, regardless of whether a publication fee has been submitted? What latitude should the PTO permit for late submission of a publication fee?

Summary: An overwhelming majority of the comments (except for those who opposed any pre-grant publication) favored a requirement that an applicant affirmatively communicate that an application is being expressly abandoned to avoid publication of the application at 18 months.

Response: The Office does not process applications as abandoned until seven (7) months after the mailing date of an Office action to allow for extensions of time under § 1.136(a) and mailing delays. Where no response to an Office action setting a shortened statutory period for response of three (3) months mailed at 13 months after filing in an application is received, the application becomes abandoned by operation of 35 U.S.C. 133 at 16 months after filing, but is not recognized or processed by the Office as an abandoned application until 20 months after filing, and thus would be published in regular course at 18 months. Therefore, an applicant intending to permit an application to become abandoned for failure to respond to an Office action mailed within seven (7) months of the projected publication date must take affirmative action to avoid publication of the application.

The Office intends to indicate the projected date of publication on the filing receipt. Any person who wants to avoid publication of the application at 18 months must submit a letter of express abandonment in sufficient time to permit the Office to act on the letter. Likewise, any person who considers the projected date of publication on the filing receipt to be incorrect must submit a request to correct the projected date of publication in sufficient time to permit the Office to act on the request.

Currently, the Office considers two (2) months to be the minimum time necessary to avoid publication of an application. Therefore, any letter of express abandonment or request to withdraw the application from publication submitted less than two (2) months from the projected date of publication will not be considered effective to avoid publication of the application at the projected date of publication. The Office also intends to indicate on the filing receipt the date by which an application must be expressly abandoned to avoid its publication.

8. The delayed filing of either a claim for priority under 35 U.S.C. 119 or 120 may result in the delayed publication of the application. Should priority or benefit be lost if not made within a reasonable time after filing? What latitude should the PTO permit for late claiming of priority or benefit?

Summary: A large majority of the comments indicated that claims for priority under 35 U.S.C. 119 and 120 should be lost if not timely filed. A number of comments also indicated that there should be provisions for the acceptance of late claims for priority.

Response: The submission of a claim for priority under 35 U.S.C. 119 or 120 later than four (4) months prior to the publication date appropriate for an application claiming that priority date will result in delays in the publication of the application and will interfere with the publication process. Therefore, the Office proposes to change the rules of practice to provide that claims for priority under 35 U.S.C. 119 or 120 must be made within two (2) months of filing, or fourteen (14) months from the filing date for which a benefit is desired, whichever is later. To avoid a potential loss of patent rights to an applicant who inadvertently failed to present a timely claim for priority, the Office further proposes to provide for the acceptance of late claims for priority submitted during the pendency of the application with a surcharge, so long as the delay in submitting the claim for priority was unintentional.

9. Once the patent has issued, should the paper document containing information similar to that published in the Gazette of Patent Application Notices, i.e., the Patent Application Notice, be removed from the search files, and should publication information be included on the issued patent?

Summary: A majority of the comments indicated that the Patent Application Notice should not be removed from the search files.

Response: The Office will not remove the Patent Application Notice from the search files upon issuance of the patent.

10. After publication, should access to the content of the application file be limited to the originally filed application papers? If not, what degree of access should be permitted? Should access be limited to the content before publication, or should it extend to materials added after publication?

Summary: A majority of the comments indicated that, upon publication, the access to the content of the application file should not be limited.

Response: The Office proposes to change the rules of practice to provide that, upon publication, access to the entire content of the application file would be permitted. To avoid undue interference with the examination of the application, however, the public access to the application file of a pending published application is proposed to be limited to obtaining, upon the payment of the fee set forth in § 1.19(b)(2), a copy of the application file produced during non-working hours by the Office when the application file is made available by the appropriate patent application processing organization. The Office also proposes to provide, upon the payment of the fee(s) set forth in § 1.19(b)(4), as proposed, a copy of specifically identified document(s) contained in a pending published application.

The Office will provide public access to a database containing information concerning the status of a pending published application and the content of the application file similar to that contained in the Patent Application Location and Monitoring (PALM) system. Using this database, interested members of the public will be able to ascertain the status of a pending published application to determine whether obtaining a copy of the file wrapper and content of the application or any document(s) in the file wrapper is warranted. In addition, this database can also be used to permit specific identification of the document(s) of which a copy is desired, assuming that obtaining a copy of the entire file wrapper and content is not considered warranted.

The Office specifically proposes to provide a copy of a specifically identified document contained in a pending published application for a fee of $75.00. Each paper in the application file to which a separate paper number is assigned constitutes a document in

the application. As the cost of obtaining a pending published application from its location in the various patent application processing organizations throughout the Office is a substantial portion of the cost of providing a copy of the file wrapper and content of a pending published application, the fee for providing a copy of the first requested document from a pending published application must recover the cost of obtaining the application. The Office, however, will provide copies of additional documents from the same application in the same request for a fee of $25.00 per document.

11. After publication, should assignment records of a published application also be made accessible to the public?

Summary: An overwhelming majority of the comments indicated that, upon publication, the assignment records of an application should be accessible to the public.

Response: The Office proposes to change the rules of practice to provide that, upon publication, the assignment records of the application would be available by both application and Patent Application Notice (PAN) number and open to public inspection through the existing Patent Assignment Search System. The Office further proposes to permit applicants to indicate on the assignment cover sheet whether they want assignment information to be printed on the Patent Application Notice. The Office, however, does not propose to require that any assignment information be printed on the Patent Application Notice.

12. After publication, should access include the deposit of biological materials as set forth in § 1.802 et seq.?

Summary: A majority of the comments indicated that, upon publication, any deposit of biological materials should be accessible to the public. A number of comments, however, indicated that such access should be limited in the manner similar to that in European or Japanese laws, or that such access should be limited to experimental use.

Response: Section 1.809(c) currently provides that the applicant need not provide any necessary deposit of biological materials until three (3) months from the mailing of the Notice of Allowance and Issue Fee Due. The deposit of biological materials on filing of an application are often required by foreign laws. Applicants may not be able to claim priority under these laws based upon an earlier United States application filed without any necessary deposit of biological materials. The laws and rules of practice of the United States, however, do not require an applicant to make any deposit of biological materials until the application is allowed. *See, In re Lundak*, 723 F.2d 1216, 227 USPQ 90 (Fed. Cir. 1985). Accordingly, the Office proposes to change the rules of practice to provide that, upon publication, any deposit of biological materials that has been made would be available after deposit under the same conditions that such deposit of biological material would be available for an issued patent.

13. What types of problems will be encountered if all amendments must be made by (a) substitute paragraphs and claims, (b) substitute pages, or (c) replacement of the entire application?

Summary: A majority of the comments indicated that, if the rules of practice regarding the submission of amendments were changed, a requirement for substitute paragraphs and claims, or substitute pages would be acceptable.

Response: The Office currently considers changes in the procedures for entering amendments into applications to be unnecessary to the current planning approach to implementation of 18-month publication, and, as such, no change to the rules of practice to require substitute paragraphs and claims, substitute pages, or replacement of the entire application is being proposed.

14. Should protest procedures be modified to permit the third party submission of prior art only prior to a specific period after publication of the application? What action should be taken with respect to untimely submissions by a third party?

Summary: A majority of comments indicated that third party submissions of prior art patents and publications should be permitted for a limited period upon publication, but the overwhelming majority of comments opposed any pre-grant opposition procedure.

Response: The Office does not intend to institute any procedures that would amount to pre-grant opposition. H.R. 1732 was also introduced in the House of Representatives on May 25, 1995, and, if enacted, will expand reexamination, i.e., post-grant opposition, proceedings to provide a third party requester with increased participation rights, including the right to appeal any decisions favorable to patentability to the Board of Patent Appeals and Interferences and to the courts. In view of the opposition to pre-grant third party participation, i.e., support for the continued ex parte examination of pending applications, the Office proposes to change the rules of practice to limit the period for filing protests and petitions for the institution of public use proceedings.

The Office proposes to change the rules of practice concerning protests to provide that a submission by a third party in a pending application would be considered if: (1) it is submitted within two months of the date the application was published or prior to the mailing of a notice of allowance under § 1.311, whichever occurs first; (2) the submission has been served on the applicant in accordance with § 1.248 if filed after the date the application was published, and the submission indicates such service; (3) the submission is accompanied by a $220 fee if submitted after publication of the application; and (4) the application is still pending when the submission and application file is brought before the examiner.

The $220 fee for a protest submitted after publication of the application is considered appropriate. Any party submitting a protest after publication has benefitted by the publication of the application. The third party should not obtain this benefit solely at the expense of the patent applicant, but should obtain this benefit only upon payment of a fee. In addition, it is expected that any protest submitted after publication of the application will be considered late in the prosecution of the application, which will cause inconvenience both to the patent applicant and the Office. Therefore, the requirement for the payment of a fee is considered appropriate to defray the costs of the belated consideration of any such submission and discourage the submission of protests having questionable merit.

Third parties may continue to submit information concerning prior public use of the invention in accordance with § 1.292. Currently, § 1.292 does not set forth a time period within which a petition for the institution of public use proceedings must be filed. The Office proposes to further amend § 1.292 to provide that the public use petition will be entered if submitted within two months of the publication date of the application or prior to the mailing of a notice of allowance under § 1.311, whichever occurs first.

The proposed changes to §§ 1.291 and 1.292 are intended to limit any right of third parties to have information entered and considered in a pending application. They do not vest the applicant with any right to prevent the Office from sua sponte making such information of record in the application or relying upon such information in subsequent proceedings in the application, i.e., they do not limit the authority of the Office to re-open the

prosecution of an application to consider any information deemed relevant to the patentability of any claim.

A number of miscellaneous comments concerning the 18-month publication of patent applications were also received.

Comment 1: A number of comments opposed any pre-grant publication of pending applications as an improper limiting of the right of a patent applicant to maintain trade secrets, or argued that any pre-grant publication should not occur prior to 24 or 60 months from the earliest filing date.

Response: H.R. 1733, if enacted, would require the Commissioner to publish pending applications at 18 months. The proposed changes to the rules of practice concern the implementation of an 18-month publication system mandated by statute, not the advisability of an 18-month publication system. If legislation containing provisions for the publication of pending applications is enacted, it is not expected that the Office would have the discretion to determine whether or when pending applications are to be published. That is, it is expected that any legislation containing provisions for the publication of pending applications will mandate whether and when applications are to be published.

Comment 2: A number of comments indicated that the publication of pending applications should be joined with provisional rights.

Response: H.R. 1733, as proposed, provides for provisional rights. This issue, however, was not treated in the 18-Month Publication Notice or this notice of proposed rulemaking since it does not affect the way business is conducted with or within the Office.

Comment 3: One comment indicated that the requirement under 35 U.S.C. 112, first paragraph, for a disclosure of a best mode should be eliminated in view of 18-month publication.

Response: The requirement in 35 U.S.C. 112, first paragraph, for a disclosure of a best mode is a statutory, not regulatory, requirement. Therefore, the Office has no authority to eliminate or limit this requirement of the patent statutes.

Comment 4: One comment indicated that any publication of patent applications should address the situation in which: (1) an applicant files a continuing application prior to receiving a patent, and then maintains the pendency of continuing application(s), which are maintained in confidence, to obtain claims of various scope; (2) a second party invests resources in developing a product which does not infringe the claims of the patent, but which the applicant could draft claims in the continuing application(s) to cover; and (3) the applicant then permits a continuing application having claims which covers the second party's product to issue, thus checkmating the second party.

Response: H.R. 1733, if enacted, would provide that applications shall be published ''as soon as possible after the expiry of a period of 18 months from the earliest filing date for which a benefit is sought.'' Any continuing application which claims priority from any prior application would be published either 18 months after the filing date of the earliest filed prior application or as soon as possible after filing of the continuing application, and thus would not be maintained in confidence.

Comment 5: One comment indicated that applicants should obtain the defensive benefit of their filing date in a published application regardless of whether the application issues as a patent, either by statute or rule.

Response: H.R. 1733, if enacted, would provide that a published application is prior art under 35 U.S.C. 102(e) as of its filing date. As prior art is defined by statute, i.e., 35 U.S.C. 102, the Office has no authority to promulgate regulations defining what does or does not constitute prior art.

Comment 6: One comment indicated that any rulemaking should be postponed until there is pending legislation, and it is clear as to what form 18-month publication will take.

Response: As legislation has been introduced, the form that 18-month publication will likely take is known. As such, it is now appropriate to initiate the rulemaking process in light of the changes that would be necessitated by this legislation, the requirement for a rapid implementation, if enacted, and the desire on the part of the Office to receive public input prior to initiating the rulemaking process. If H.R. 1733 is amended during the legislative process, the final rules will comply with this legislation as enacted. If H.R. 1733 is not enacted, the proposed rules that would implement publication of patent applications would be withdrawn.

Comment 7: One comment indicated that it is unclear as to whether, when a restriction requirement is applied, each application will require a separate publication fee.

Response: No separate publication fee has been proposed. In accordance with current practice, each application would require separate filing, issue, and maintenance fees, which fees will be increased to recover the costs of publication.

Comment 8: Several comments indicated that the Office should not impose access fees for either copying the paper application files, or searching and copying a published application from any electronic data base.

Response: As discussed supra, the Office intends to provide free public access to images of the Patent Application Notices and Technical Contents Publications through video display terminals in the Public Search Room and through CD–ROM collections of facsimile images of Patent Application Notices and Technical Contents Publications in the Patent and Trademark Depository Libraries. Copies of the Patent Application Notices, Technical Contents Publications, or copies of the file wrapper and contents of the application will be available for a fee. The costs of publication have been allocated primarily to those applicants whose applications are being published. Since publication primarily benefits those seeking access to the published applications, it is reasonable to require such persons to pay a fee for making copies of the Patent Application Notices and Technical Contents Publications, or obtaining a copy of the file wrapper and application contents of a published application from the Office.

Comment 9: One comment indicated that the publication of applications may result in instances in which third parties will submit information to the applicant directly, rather than to the Office. In instances in which the applicant was previously aware of the information, but did not consider it material, the applicant cannot submit the information to the Office in that application (if after final or allowance), but will be charged with a § 1.56 violation if they do not file a continuation application to have it considered. Thus, § 1.56 should be amended such that an applicant in this situation no longer has a duty to submit information to the Office.

Response: Section 1.56 expressly provides that there is no duty to submit information which is not material to the patentability of any existing claim. Since the applicant previously determined that the information was not material, the fact that a third party has provided this previously known material to the applicant has no effect on the applicant's compliance with § 1.56. Second, since the applicant was previously aware of this information, the applicant is under a duty to bring such information to the attention of the Office if it is material, regardless of the actions of any third party, and the applicant is not under a duty to bring such information to the attention of the

Office if it is not material, again regardless of the actions of any third party. In either instance, the third party's actions have no bearing on whether the applicant is in compliance with § 1.56. Therefore, no change to § 1.56 is being proposed.

Comment 10: One comment indicated that § 1.56 should be modified or abolished. Where information is brought to the attention of the applicant after allowance, the applicant should be considered to have met his or her duty of disclosure under § 1.56 if the applicant simply chooses to permit the patent to issue, as the public can take care of itself through reexamination or whatever opposition proceedings are instituted.

Response: As indicated supra, no change to § 1.56 is being proposed. In addition, the Office is proposing to limit third party protest procedures, and is not proposing to develop any procedures amounting to pre-grant opposition. Since the Office is continuing the ex parte examination of applications, the proposed modification or abolition of § 1.56 is not considered appropriate.

Comment 11: One comment indicated that an applicant should be allowed to request early publication.

Response: Section 1.306(d) is being proposed to provide for petitions requesting early publication.

Comment 12: One comment indicated that the Office should require that the text of all applications be filed in digital form, and the publication of applications should be purely digital, i.e., that Office should not print any publication.

Response: 35 U.S.C. 22 provides that ''[t]he Commissioner may require papers filed in the Patent and Trademark Office to be printed or typewritten.'' Therefore, the Office does not currently have the authority to require that application papers be submitted in digital form. The Office is considering the legislative and regulatory changes that would be necessary to permit purely digital filing of application papers; however, requiring all applicants to submit application papers in digital form at this time would place an unnecessary burden on those applicants lacking word-processing resources. In addition, the Office received a substantial number of comments requesting a printed publication containing more information, as well as a number of comments opposing the promulgation of any regulations concerning a standard application format which were in excess of EPO and PCT regulations and not necessary to 18-month publication.

Comment 13: One comment indicated that the Office should clearly define or eliminate the ''formal'' pre-examination search requirement in MPEP 708.02.

Response: MPEP 708.02(VIII) provides that an application may be granted special status under the condition that, *inter alia,* the applicant:

> Submits a statement that a pre-examination search was made, and specifying whether by the inventor, attorney, agent, professional searchers, *etc.*, and listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, *etc.* A search made by a foreign patent office satisfies this requirement.

This definition of a pre-examination search is reasonably clear as to what actions are necessary for an applicant to have satisfied this requirement of MPEP 708.02(VIII), and the requirement for a pre-examination search is basic to the justification for granting special status to an application on that basis. No changes to 37 CFR 1.102 are being proposed.

Comment 14: One comment indicated that the publication of applications at 18 months will create a security review problem, especially where a nonprovisional, *i.e.,* 35 U.S.C. 111(a), application claiming the benefit of a prior provisional application not subject to a secrecy order contains additional material which must be reviewed. Therefore, the Office should require that any nonprovisional applications claiming the benefit of a prior provisional application indicate any additional material by underlining and bracketing.

Response: Provisional applications will increase the number of applications requiring security screening. All provisional applications will require security screening immediately after filing in the same manner as nonprovisional applications due to the licensing provision of 35 U.S.C. 184. Any subsequent U.S. patent application claiming the benefit of a prior provisional application will also require security screening unless it is evident on its face that no additional subject matter is contained in the application beyond that in the provisional application. It would be beneficial for the applicant to provide this information to the Office upon filing of the nonprovisional application. Thus, the Office is considering suggesting that applicants employ a standard application transmittal letter similar to the standard transmittal letter for transmitting an international application to the United States Receiving Office (PTO–1382). This standard transmittal letter would indicate, *inter alia:* (1) any difference between a provisional application and a nonprovisional application claiming the benefit of the provisional application; (2) the residence of the inventor(s) to avoid the unnecessary screening of foreign origin applications; and (3) any Government interests in the application, which applications should be screened through contract provisions.

Comment 15: One comment indicated that the Office should automatically place a secrecy order on any nonprovisional application in which the prior provisional application was under a secrecy order.

Response: The Office does not have the authority to impose a secrecy order without a specific recommendation from a defense agency. 35 U.S.C. 181. Additionally, all secrecy orders include the provision that any other patent application already or hereafter filed in this or any foreign country which contains any significant part of the subject matter of the application under secrecy order also falls within the scope of the secrecy order and must be brought to the immediate attention of Licensing and Review. See § 5.2(d). All papers pertaining to such applications must be filed under the provisions of § 5.33, *i.e.,* to the attention of Licensing and Review. Thus, the applicant is obligated to maintain proper security of any nonprovisional application that claims benefit of a prior provisional application under a secrecy order.

Comment 16: One comment expressed concern that the defense agencies may not have sufficient time to complete national security review of applications made available to them under 35 U.S.C. 181 prior to publication at 18 months from the earliest filing date for which a benefit is sought, and suggested that applications not be published until they have been cleared by the defense agencies.

Response: H.R. 1733, if enacted, would provide for withholding an application from publication beyond 18 months from the earliest filing date for which a benefit is sought if the application is under a secrecy order or abandoned. There is no provision for delaying the publication of an application until a completion of all reviews under 35 U.S.C. 181. In addition, 35 U.S.C. 184 authorizes foreign filing of an application without the need for a license once the application has been on file for at least six (6) months. In view of 35 U.S.C. 184, the defense agencies must complete all security reviews within six (6) months of filing to prevent public disclosure. Thus, security review must be completed within six (6) months of the actual U.S. filing date. For those

applications due for publication prior to six (6) months from the actual filing date, e.g., those claiming the benefit of an earlier application filed more than 18 months prior and those which a petition for early publication has been granted, considerations of national security mandate a limited delay in publication. The Office will not pass an application for publication that is still under review by a defense agency unless it has been on file for at least six (6) months and the defense agency has been provided a minimum of three (3) months to review the application.

Comment 17: One comment indicated that the digitized images of the application file contents should be available in magnetic tape form in the morning of the day of publication.

Response: Digitized images of the Patent Application Notice and Technical Contents Publication will be available in magnetic tape form for a fee to all parties as soon as possible after publication similar to the way in which digitized images of granted patents are provided, assuming that there is interest in such products.

Comment 18: One comment indicated that it is unclear as to whether an examiner can cite the Patent Application Notice, and whether the examiner will be required to supply the full application specification.

Response: When an examiner cites a published application, a copy of the Technical Contents Publication will be provided with the Office action under the same conditions that a copy of the entire patent of any cited patent would currently be provided. That is, where an examiner would provide only those portions of a patent relied upon, rather than a copy of the entire patent due to its size, *i.e.,* in instances of jumbo patents, the examiner would similarly be expected to provide only those portions of a published application relied upon in instances of jumbo applications.

Comment 19: One comment indicated that the entire application as filed should be published, otherwise the abandoned published application must be permanently stored in a manner that would permit on-site retrieval.

Response: The Technical Contents Publication of any published application will be electronically available, without any necessity for retrieval of the actual application file. Therefore, a printed publication of the application-as-filed would not provide any information not electronically available. Nevertheless, the actual file of an abandoned application may be readily obtained regardless of where it is stored.

Comment 20: One comment indicated that the 18-Month Publication Notice did not set forth the capacity of Patent and Trademark Depository Libraries (PTDLs) to: (1) Collect fees, (2) provide librarians of assistance, and (3) house new publications.

Response: Each PTDL sets its own service standard procedures. Any customer must directly contact the PTDL to ascertain its customer service standards and requirements. Nevertheless, as the Office proposes to publish only a Patent Application Notice, rather than the entire application-as-filed, in printed form, and further proposes to provide the Patent Application Notices and Technical Contents Publications to PTDLs through CD–ROM collections of facsimile images, this publication of applications would appear to alleviate, rather than exacerbate, any publication storage housing problems.

Comment 21: One comment indicated that the Office should provide a first Office action on the merits in all patent applications within 14 months of the actual filing date of the application in the United States.

Response: The ability of the Office to process application within any established time frame is entirely dependent upon the staff and resources allocated by Congress, the Office of Management and Budget (OMB), and the Department of Commerce (DoC). In January of 1995, the first Office action was mailed within 14 months of the actual filing date of the application in the United States in ninety-two (92) percent of all applications in which a first Office action was mailed. Any applicant who absolutely needs a first Office action on the merits mailed within 14 months of the actual filing date of the application should consider a petition to make special using the special examining procedure for certain new applications set forth in MPEP 708.02(VIII). In addition, any independent inventor meeting the requirements set forth in 35 U.S.C. 122(b)(2) and § 1.306(e), as proposed, may wish to consider filing the application with a petition under § 1.306(e).

Comment 22: One comment noted the current procedure of permitting applicants to submit trade secret material and later expunge the material if it is not necessary to patentability, and indicated that new procedures should be implemented in the content of pre-grant publication of pending applications.

Response: The current procedures for the treatment of petitions to expunge trade secret, proprietary, or protective order material are set forth in MPEP 724.05. Applicants are cautioned, in MPEP 724.05, that in instances in which a decision on the petition is not made prior to the date on which the application issues as a patent, any material in the application file will remain open to public inspection, and, as such, petitions to expunge must be filed as soon as possible. Under an 18-month publication system, any material in the application file on the date the application is published would likewise remain open to public inspection. However, as petitions to expunge are considered under § 1.182, *i.e.,* petitions not otherwise provided for, no change to the rules of practice regarding petitions to expunge is being proposed.

Discussion of Specific Rules

Title 37 of the Code of Federal Regulations, Parts 1, 3 and 5, are proposed to be amended as follows:

Section 1.4(a), as proposed, would add Patent Application Notices and Technical Contents Publications to those services and facilities which correspondence with the Office may comprise.

Section 1.5(a), as proposed, would provide that any letter concerning an application must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number) or serial number and filing date assigned to that application by the Office, or the international application number of the international application, regardless of whether the application is a published application. That is, the identification required for a pending or abandoned application would not change due to its status as a published application.

Section 1.5(f), as proposed, would provide that a paper concerning a provisional application must identify the application as such and by the application number.

Section 1.5(g), as proposed, would provide that a paper relating to a Patent Application Notice should identify it as such and by the Patent Application Notice number. That is, a paper concerning a published application must identify the application by application number, not Patent Application Notice number; however, a paper concerning the Patent Application Notice *per se* must identify it by Patent Application Notice number.

Section 1.9(a), as proposed, would define an international application in subparagraph (a)(4), rather than in paragraph (b).

Section 1.9(b), as proposed, would now define a published application as an application for patent which has

been published pursuant to 35 U.S.C. 122(b).

A new § 1.9(h), as proposed, would define national security classified as specifically authorized under criteria established by Act of Congress or Executive Order to be kept secret in the interest of national defense or foreign policy and in fact properly classified pursuant to Act of Congress or Executive Order.

Section 1.11, as proposed, would provide that, like an issued patent or a statutory invention registration, the specification, drawings, and all papers relating to the case in the file of an abandoned published application would be open to inspection by the public. Section 1.11, as proposed, would further provide that a copy of the specification, drawings, and all papers relating to the case in the file of any published application, a patent, or statutory invention registration may be obtained upon the payment of the fee set forth in § 1.19(b)(2). That is, while the actual application file of an abandoned published application, patent, and statutory invention registration would be available for public inspection, the actual application file of a pending published application would not be available for public inspection, but a copy of the specification, drawings, and all papers relating to a pending published application would, upon the payment of the fee set forth in § 1.19(b)(2), be provided to any member of the public.

Section 1.12, as proposed, would provide that the assignment records relating to published applications are available and open to public inspection at the Office, and copies of those assignment records may be obtained upon request and payment of the fee. Section 1.12 would further exclude the assignment records of published applications from those records that are preserved in confidence. Finally, § 1.12, as proposed, would revise paragraph (c) to read ''preserved in confidence under § 1.14'' for consistency with § 1.14.

Section 1.13, as proposed, would provide that, like an issued patent, certified and non-certified copies of Patent Application Notices, Technical Contents Publications, and the file wrapper and contents of published applications would, upon payment of a fee, be furnished to any person.

Section 1.14, as proposed, would revise the title and paragraphs (a) and (e) to read ''preserved in confidence'' for consistency with the language in 35 U.S.C. 122.

Section 1.14(a), as proposed, would provide that published applications are excluded from those pending and abandoned applications which are maintained in confidence. Section 1.14(a), as proposed, would further change ''the United States of America has been indicated as a Designated State in a published international application'' to ''a published international application in which the United States of America has been indicated as a Designated State'' for clarity, and add ''U.S. published application'' to those documents in which identification of an application by application number or serial number and filing date would entitle the public to status information concerning the application. Section 1.14(a), as proposed, would further provide that reference to an application in a U.S. published application or patent, or identification of an application by application number or serial number and filing date in a published patent document or a published international application in which the United States of America has been indicated as a Designated State would entitle the public to the application number, filing date, and status information concerning any application claiming the benefit of the identified or referenced application. Finally, § 1.14(a), as proposed, would replace the phrase ''serial number'' with ''application number or serial number and filing date'' since the mere reference to a serial number without the series code (application number) or filing date would not constitute a reference to a specific single application.

Section 1.14(b), as proposed, would provide that published applications, as well as applications that are referred to in a published application, are excluded from those abandoned applications which are not open to public inspection. Section 1.14(b), as proposed, would further provide that applications that are referred to in applications open to public inspection pursuant to this section and applications which claim the benefit of an application open to public inspection pursuant to this section are also excluded from those abandoned applications which are not open to public inspection. Finally, § 1.14(b), as proposed, would further remove applications that have been published pursuant to 35 U.S.C. 122(b) from those abandoned applications that may be destroyed after 20 years from their filing date.

Section 1.16(a), (h) and (g), as proposed, would increase the filing fee for an original nonprovisional (35 U.S.C. 111(a)) or reissue application to $780 ($390 for small entities), and plant application to $540 ($270 for small entities). The filing fee for a design application would not be affected by this proposed rule change.

Section 1.17(i), as proposed, would add petitions under § 1.306(d) for early publication of an application, petitions under § 1.306(e) for deferred publication of an application, and under § 1.701(f) for patent term extension based upon administrative delays not specifically provided for to the list of petitions for which the fee set forth in § 1.17(i) is required.

A new § 1.17(t), as proposed, would be added to establish the fee for submitting a protest under § 1.291 after publication of an application.

A new § 1.17(u), as proposed, would be added to establish the surcharge for accepting a late claim for priority under 35 U.S.C. 119(a)–(d) or for the benefit of a prior application under 35 U.S.C. 119(e), 120 or 121 filed during the pendency of the application.

Section 1.18 (a) and (c), as proposed, would increase the issue fee for an original or reissue application to $1280 ($640 for small entities), and plant application to $660 ($330 for small entities). The issue fee for a design application would not be affected by this proposed rule change.

Section 1.19(a)(1), as proposed, would add Patent Application Notices to the documents that the Office would supply in the manner of a patent upon payment of a fee.

A new § 1.19(a)(4), as proposed, would add Technical Contents Publications to the documents that the Office would supply upon payment of a fee.

Section 1.19(b)(2), as proposed, would add the file wrapper and contents of published applications to the files that the Office would supply a copy of upon payment of a fee.

Current § 1.19(b)(4), as proposed, would be redesignated as § 1.19(b)(5), and would add the assignment records of published applications to the assignment records that the Office would supply upon payment of a fee.

A new § 1.19(b)(4), as proposed, would provide the fees for a certified or uncertified copy of documents contained in a pending application. Section 1.19(b)(4)(i), as proposed, would provide that the fee for a certified or uncertified copy of the first document contained in a pending application would be $75.00. Section 1.19(b)(4)(ii), as proposed, would provide that the fee for a copy of each commonly requested additional document contained in such pending application would be $25.00. That is, while the fee for the first document contained in a pending application would be $75.00, the fee for a copy of each additional document

contained in the same pending application and requested together with the first document would be $25.00. Where, however, a person requests a first document from a pending published application, and subsequently requests an additional document, the additional document was not commonly requested with the first document, and the fee for the additional document would be $75.00. Nevertheless, the fee for any further additional document(s) commonly requested with the additional document would be $25.00 per additional document.

Section 1.19(c), as proposed, would provide that copies of all Technical Contents Publications published annually would also be provided to libraries upon payment of the fee for copies of all patents issued annually.

Section 1.20(e)–(g), as proposed, would increase the fee for maintaining an original or reissue patent in force beyond four years, eight years, and twelve years, respectively, to $1020, $2020, and $3020, respectively ($510, $1010, and $1510, respectively, for small entities).

Section 1.24, as proposed, would add the purchase of copies of Patent Application Notices and Technical Contents Publications to those documents for which the coupons set forth therein may be used.

Section 1.51(a)(1), as proposed, would further provide that a complete application comprises, inter alia, an abstract.

Section 1.52(a), as proposed, would provide that all papers which are to become a part of the permanent records of the Office must be legibly typed in permanent dark ink in portrait orientation on flexible, strong, smooth, non-shiny, durable and white paper. Currently, § 1.52(a) permits such papers to be hand-written, and does not limit the color of the ink or paper, quality of the paper, or orientation of the typing. Section 1.52(a), as proposed, would further provide that the application papers must be presented in a form having sufficient clarity and contrast between the paper and the typing thereon to permit electronic reproduction by use of digital imaging and optical character recognition, as well as the direct reproduction currently provided for. Section 1.52(a), as proposed, would further provide that substitute typewritten papers ''will,'' rather than ''may,'' be required if the original application papers are not of the required quality. As any substitute typewritten papers containing the subject matter of the originally filed application papers would constitute a substitute specification, the provisions of § 1.125 governing the entry of a substitute specification would be applicable, and § 1.52(a), as proposed, would include a specific reference to § 1.125.

Section 1.52(b), as proposed, would provide that the claims must be set forth on a separate sheet. Section 1.72(b) currently provides that the abstract must be set forth on a separate sheet. Thus, §§ 1.52(b), as proposed, and 1.72(b) would require that the abstract and claims be set forth on a separate sheet. Section 1.52(b), as proposed, would further provide that the sheets of paper must be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm (8½ by 11 inches), with a top margin of at least 2.0 cm. (¾ inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (¾ inch), and a bottom margin of at least 2.0 cm. (¾ inch), and that no holes should be provided in the paper sheets. Section 1.52(b) currently provides that papers must be written on but one side, but this phrase is proposed to be changed to ''typed on but one side'' to conform to § 1.52(a) which, as proposed, would no longer permit hand-written or hand-printed (''written or printed'') papers. Section 1.52(b), as proposed, would further provide that the lines ''must,'' rather than ''should,'' be 1½ or double spaced, and that the pages ''must,'' rather than ''should,'' be numbered consecutively, starting with page one, with the numbers being centrally located above or below the text. Finally, § 1.52(b), as proposed, would specifically reference drawings to clarify that drawings are part of the application papers, but that the standards for drawings are set forth in § 1.84.

Section 1.52(d), as proposed, would provide that where an application is filed in a language other than English, the verified English translation of the non-English-language application and the fee set forth in § 1.17(k) are required to be filed with the application or within such time period as may be set by the Office, and that extensions of time pursuant to § 1.136(a) would not be available for submitting the English translation.

Section 1.53(d)(1), as proposed, would further provide that the applicant will be given a time period within which to file an abstract and claims on a separate sheet, or substitute specification in compliance § 1.125 with papers typed on but one side of the paper or new sheets of drawings, each of the substitute specification and sheets of drawings of sufficient clarity, contrast, and quality, and in a proper size and format for electronic reproduction in instances in which the application papers did not comply with §§ 1.52 (a) and (b), as proposed, or the drawings were of such poor quality as to preclude their digital image scanning into the electronic data base. Section 1.53(d)(1), as proposed, would further provide that extensions of time pursuant to § 1.136(a) would not be available for filing an abstract and claims on a separate sheet, and a substitute specification with papers typed on but one side of the paper and sheets of drawings, each of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction.

Section 1.54(b), as proposed, would provide that the applicant will be informed of the application number, filing date, and projected publication date on a filing receipt. The phrase ''application serial number'' would be changed to ''application number'' for consistency with § 1.5(a).

Section 1.55(a), as proposed, would provide that any claim to priority under 35 U.S.C. 119(a)–(d) must be stated within two months of filing or within fourteen months of the date of the prior foreign application, whichever is later, and must identify the prior foreign application by specifying its application number, country, and day, month and year of its filing. The proposed amendment to § 1.55, however, would not affect claims to priority under 35 U.S.C. 172, and would not affect the time periods set forth in § 1.55(a) for the perfection of any claim for priority under 35 U.S.C. 119 (a)–(d), i.e., the filing of a certified copy of the foreign application.

Section 1.55(c), as proposed, would provide a procedure for the acceptance of claim to priority under 35 U.S.C. 119(a)–(d) presented after the time period set in § 1.55(a). The procedure would require the filing of a petition during the pendency of the application requesting acceptance of the delayed claim, the surcharge set forth in § 1.17(u), and a statement that the delay was unintentional.

Section 1.55(d), as proposed, would provide that the time periods set forth in this section, i.e., two months of filing or within fourteen months of the filing date of the prior foreign application as set forth in § 1.55(a), and during the pendency of the application as set forth in § 1.55(c), cannot be extended.

Section 1.58(b), as proposed, would be removed and reserved as unnecessary in view of the proposed amendments to §§ 1.52 (a) and (b).

Section 1.58(c), as proposed, would delete the sentence ''[i]f it is not

possible to limit the width of a formula or table to 5 inches (12.7 cm.), it is permissible to present the formula or table with a maximum width of 10¾ inches (27.3 cm.) and to place it sideways on the sheet'' and ''[h]and lettering must be neat, clean, and have a minimum character height of 0.08 inch (2.1 mm.)'' to conform to the typing and paper size and orientation limitations in §§ 1.52 (a) and (b), as proposed. Section 1.58(c), as proposed, would further provide metric dimensions with English equivalents in parentheticals, rather than vice versa.

Section 1.60(d), as proposed, would provide that the applicant will be given a time period, which is not extendable under § 1.136(a), within which to file an abstract and claims on a separate sheet, and a substitute specification in compliance with § 1.125 with papers typed on but one side of the paper and sheets of drawings, each of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction where the papers of the prior application did not comply with §§ 1.52 (a) and (b), as proposed, or the drawings of the prior application were of such poor quality as to preclude their digital image scanning into the electronic data base.

Section 1.62(d), as proposed, would provide that the applicant will be given a time period, which is not extendable under § 1.136(a), within which to file any substitute specification and drawings required under § 1.62(e)(2), discussed infra.

Section 1.62(e), as proposed, would be subdivided into paragraphs (e)(1) and (e)(2) for clarity. Section 1.62(e)(1), as proposed, would contain the first two (2) sentences of § 1.62(e) without change. Section 1.62(e)(2), as proposed, would provide that a substitute specification and drawings would be required when the application being filed under § 1.62 is a continuation-in-part application. Section 1.62(e) currently provides that no copy of the prior application or new specification is required, that the filing of a copy of the prior application or new specification is in fact considered improper, and that a petition with instructions to cancel the copy of the prior application or new specification is necessary to obtain the date of deposit of the request for an application under § 1.62 as the filing date. Section 1.62(e)(2), as proposed, would provide that any new specification filed will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125.

Section 1.62(f), as proposed, would amend ''35 U.S.C. 122'' to read ''35 U.S.C. 122(a)'' to reflect the changes in H.R. 1733, if enacted, would change ''secrecy'' to ''confidence'' as is found in § 1.14, as proposed, and would change ''37 CFR 1.14'' to ''§ 1.14'' for consistency.

Section 1.72(b), as proposed, would provide that the abstract should be prior to the first page of the specification, rather than following the claims, to conform to § 1.77, as proposed.

Section 1.75, as proposed, would include an amendment to paragraph (g), and would add two new paragraphs. Section 1.75(g), as proposed, would add the phrase ''the least restrictive claim should be presented as claim number 1'' to paragraph (g) to facilitate the selection of a representative claim. Section 1.75(h), as proposed, would provide that the claim or claims must be set forth on a separate sheet. Section 1.75(i), as proposed, would provide that where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation to facilitate the digital image and/or OCR scanning of the claim into the electronic data base.

Section 1.77, as proposed, would provide that the elements of the application, if applicable, should appear in the following order: (1) Utility Application Transmittal Form; (2) Fee Transmittal Form; (3) abstract of the disclosure; (4) title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention may be used; (5) cross-reference to related applications; (6) statement regarding federally sponsored research or development; (7) reference to a ''Microfiche appendix; (8) background of the invention; (9), brief summary of the invention; (10) brief description of the several views of the drawing; (11), detailed description; (12) claim or claims; (13) drawings; (14) executed oath or declaration; and (15) sequence listing. The phrase ''if applicable'' is proposed to be inserted in the heading, rather than associated with any particular listed element, to clarify that § 1.77 does not per se require that an application include all of the listed elements, but merely provides that any listed element included in the application should appear in the order set forth in § 1.77. Section 1.77, as proposed, would further provide that the (1) abstract of the disclosure; (2) title of the invention; (3) cross-reference to related applications; (4) statement regarding federally sponsored research or development; (5) background of the invention; (6) brief summary of the invention; (7) brief description of the several views of the drawing; (8) detailed description; (9) claim or claims; and (10) sequence listing, should appear in upper case, without underlining or bold type, as section headings, and if no text follows the section heading, the phrase ''Not Applicable'' should follow the section heading. Finally, § 1.77, as proposed, would be amended to change the reference to § 1.96(b) in § 1.77(c)(2), § 1.77(a)(7) as proposed, to § 1.96(c) for consistency with § 1.96, as proposed.

Section 1.78(a)(2), as proposed, would provide that any claim to the benefit of any prior filed copending nonprovisional application or international application designating the United States of America must be stated within two months of filing or fourteen months from the filing date of the prior application, whichever is later, and must include an identification of the prior application by application number.

Section 1.78(a)(3), as proposed, would delete the sentence ''[s]ince a provisional application can be pending for no more than twelve months, the last day of pendency may occur on a Saturday, Sunday, or Federal holiday within the District of Columbia which for copendency would require the nonprovisional application to be filed prior to the Saturday, Sunday, or Federal holiday.'' In view of the proposed amendment in H.R. 1733 to 35 U.S.C. 119(e), the provisions of § 1.7 would be applicable to a nonprovisional application claiming the benefit of a prior provisional application.

Section 1.78(a)(4), as proposed, would provide that any claim to the benefit of any prior filed copending provisional application must be stated within two months of filing or within fourteen months of the filing date of the prior application, whichever is later, and must include an identification of the prior application by application number.

Section 1.78(a)(5), as proposed, would provide a procedure for the acceptance of a delayed claim to priority under 35 U.S.C. 119(e), 120 or 121. The procedure would require the filing of a petition during the pendency of the application requesting acceptance of the delayed claim, the surcharge set forth in § 1.17(u), and a statement that the delay was unintentional.

Section 1.78(a)(6), as proposed, would provide that the time periods set forth in this paragraph, i.e., two months of filing or within fourteen months of the filing date of the prior application as set forth in §§ 1.78 (a)(2) and (a)(4), and during the pendency of the application

as set forth in § 1.78(a)(5), cannot be extended.

Section 1.78(c), as proposed, would change ''two or more applications or an application and a patent'' to ''an application or a patent under reexamination and an application or a patent'' such that the provisions of § 1.78(c) will also be applicable to a patent under reexamination. Section 1.78(c), as proposed, would further correct ''inventors and owned by the same party contain conflicting claims'' to read ''inventors are owned by the same party and contain conflicting claims.''

Section 1.78(d), as proposed, would change ''obviousness-type double patenting rejection'' to ''non-statutory double patenting rejection'' as current examining procedures authorize non-obviousness-type double patenting rejections, as well as obviousness-type double patenting rejections (MPEP 804(II)), and either may be obviated by filing a terminal disclaimer in accordance with § 1.321(b). Section 1.78(d), as proposed, would further change each instance of ''application'' to ''application or a patent under reexamination'' for consistency with § 1.321(b) and to clarify that double patenting is a proper consideration in reexamination (*Ex parte Obiaya,* 227 USPQ 58, 60–61 (Bd. Pat. App. & Inter. 1985)), and that a non-statutory double patenting rejection in a patent under reexamination may be obviated by filing a terminal disclaimer in accordance with § 1.321(b).

Section 1.84(c), as proposed, would provide that a reference to the application number, or, if an application number has not been assigned, the inventor's name, may be included in the left-hand corner of the drawing sheet, provided that reference appears within 1.5 cm. (9⁄16 inch) from the top of the sheet. As the back side of a drawing sheet will not be scanned into the electronic data base, an applicant can include other identifying indicia on the back side the drawing sheet.

Section 1.84(f), as proposed, would provide that the size of all drawing sheets in an application must be either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches) to conform to the requirement in § 1.52(b) concerning papers in an application.

Section 1.84(g), as proposed, would be amended to delete the margin requirements for the sheet sizes that would no longer be acceptable if the proposed change to § 1.84(f) were adopted. Section 1.84(g), as proposed, would be further amended to provide that, to facilitate digital image scanning of the drawing sheets, the sheets should have scan targets (cross-hairs) on two cater-corner margin corners. Finally, § 1.84(g), as proposed, would increase the bottom and side margins such that each sheet must include a top margin of at least 2.5 cm. (1 inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 1.5 cm. (9⁄16 inch), and a bottom margin of at least 1.0 cm. (3⁄8 inch), thereby leaving a sight no greater than 17.0 cm. by 26.2 cm. on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15⁄16 by 9 5⁄8 inches) on 21.6 cm. by 27.9 cm. (8½ by 11 inch) drawing sheets.

Section 1.84(j), as proposed, would provide that one of the views should be suitable for publication in the Patent Application Notice, and the Gazette of Patent Application Notices, as well as the Official Gazette, as the illustration of the invention.

Section 1.84(x), as proposed, would be amended to delete the provisions indicating the proper location for holes in a drawing sheet, and provide that no holes should be provided in the drawing sheets.

Section 1.85, as proposed, would provide that drawings must be suitable for ''electronic'' reproduction ''by digital imaging'' before being admitted for examination. As discussed supra, as a drawing figure will be included in the Gazette Entry in the Gazette of Patent Application Notices and the Patent Application Notice, drawings suitable for electronic reproduction by digital imaging would be necessary for the initial processing of the application.

Section 1.96, as proposed, would be amended to designate the text preceding current paragraph (a) as paragraph (a), and would redesignate current paragraphs (a) and (b) as paragraphs (b) and (c), respectively. New § 1.96(a), as proposed, would be further amended to insert a period between ''specification'' and ''[a] computer,'' to change ''these rules'' to ''this section,'' and to change ''may be submitted in patent applications in the following forms'' to ''may be submitted in patent applications as set forth in paragraphs (b) and (c) of this section.

New § 1.96(b), as proposed, would be further amended to change the sentences ''[t]he listing may be submitted as part of the specification in the form of computer printout sheets (commonly 14 by 11 inches in size) for use as ''camera ready copy'' when a patent is subsequently printed'' and ''[s]uch computer printout sheets must be original copies from the computer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper, the printing on each sheet must be limited to an area 9 inches high by 13 inches wide, and the sheets should be submitted in a protective cover'' to ''[a]ny listing submitted as part of the specification must be original copies from the computer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper, and the sheets should be submitted in a protective cover,'' to delete the sentence ''[w]hen printed in patents, such computer printout sheets will appear at the end of the description but before the claims and will usually be reduced about ½ in size with two printout sheets being printed as one patent specification page,'' and to delete the phrase ''if the copy is to be used for camera ready copy.'' Section 1.96(a)(1), new § 1.96(b)(1) as proposed, currently provides that the requirements of § 1.84 apply to computer program listings submitted as sheets of drawings, and § 1.96(a)(2), new § 1.96(b)(2) as proposed, currently provides that the requirements of § 1.52 apply to computer program listings submitted as part of the specification. Section 1.52(b), as proposed, would require that the sheets of paper be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm (8½ by 11 inches), with a top margin of at least 2.0 cm. (¾ inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (¾ inch), and a bottom margin of at least 2.0 cm. (¾ inch), and § 1.52(a), as proposed, would require that application papers be legibly typed in permanent dark ink in portrait orientation.

New § 1.96(c), as proposed, would be amended to change the references to § 1.77(c)(2) in new § 1.96(c) to § 1.77(a)(7) for consistency with § 1.77, as proposed, to change ''may'' and ''should'' to ''must,'' to delete the sentence ''[a]ll computer program listings submitted on paper will be printed as part of the patent,'' to relocate the phrase ''except as modified or clarified below'' in subsection (c)(2), to change the phrase ''computer-generated information submitted as an appendix to an application for patent shall be in the form of microfiche in accordance with the standards'' to ''computer-generated information submitted as a ''microfiche appendix'' to an application shall be in accordance with the standards'' for clarity, to change to sentences ''[e]ither Computer-Output-Microfilm (COM) ouput or copies of photographed paper copy may be submitted'' and ''[i] the former case, NMA standards MS1 and MS2 apply; in

the latter case, standard MS5 applies'' to ''[c]omputer-Output-Microfilm (COM) ouput may be submitted in accordance with either NMA standard MS1 or MS2,'' to change ''serial number'' to ''application number,'' and to provide metric dimensions with English equivalents in parentheticals, rather than vice versa.

Section 1.97(a)–(d), as proposed, would be amended to include the phrase ''for an applicant for patent or for reissue of a patent, or an owner of a patent under reexamination'' in paragraph (a) and ''by the applicant or patent owner'' to clarify that § 1.97 is not available for any third party seeking to have information considered in a pending application. Any third party seeking to have information considered in a pending application must proceed under §§ 1.291 or 1.292, both discussed infra. Section 1.97(c), as proposed, would be further amended to correct the phrase ''certification as specified in paragraph (3) of this section'' to read ''certification as specified in paragraph (e) of this section.''

Section 1.98, as proposed, would provide that any Patent Application Notice or Technical Contents Publication listed in an information disclosure statement must be identified by applicant, Patent Application Notice number or Technical Contents Publication number and publication date. Section 1.98, as proposed, would also limit those U.S. patent applications of which a copy need not be included to unpublished applications.

Section 1.107, as proposed, would provide that if domestic published applications are cited by the examiner, their Technical Contents Publication number, publication date, the names of the applicants must be stated. Section 1.107, as proposed, would be amended to delete the phrase ''and the classes of inventions.''

Section 1.108, as proposed, would further except published applications from those abandoned applications that will not be cited as references.

Section 1.131(a), as proposed, would include pending or patented U.S. published applications which substantially show or describe but do not claim the same patentable invention, as defined in § 1.601(n), and abandoned U.S. published applications as references to which the provisions of § 1.131 apply. Pending or patented U.S. applications would be treated in the same manner that U.S. patents are currently treated, i.e., § 1.131 would apply only if the pending or patented application does not claim the same patentable invention. Abandoned U.S. published applications would be treated in the manner that foreign patents or printed publications are currently treated. As U.S. published applications, either pending, abandoned or patented, may constitute prior art under 35 U.S.C. 102(a) or (e), this change, and the change to § 1.132 infra, are necessary to accommodate such references.

In a Notice of Proposed Rulemaking published in the **Federal Register** at 59 FR 49876 (September 30, 1994) and in the Official Gazette at 1167 Off. Gaz. Pat. Office 96–97 (October 25, 1994) (§ 1.131 Notice of Proposed Rulemaking), § 1.131(a) was proposed to be amended to, inter alia, broaden its application to instances in which inventions of a pending application or patent under reexamination and a patent held by a single party are not identical as set forth in 35 U.S.C. 102, but not patentably distinct, and changes to § 1.131 were adopted as a final rule. 60 FR 21043 (May 1, 1995); 1174 Off. Gaz. Pat Office 155 (May 30, 1995). An amendment to § 1.131(a) was proposed in the § 1.131 Notice of Proposed Rulemaking to avoid a potential conflict between § 1.131(a) and § 1.602(a) in instances in which § 1.131(a) prohibits the filing of affidavits or declarations thereunder when the same patentable invention as defined in § 1.601(n) is being claimed, but § 1.602(a) prohibits, unless good cause is shown, the declaration or continuance of an interference when the application(s) and patent are owned by a single party. While this conflict between two pending applications can be avoided by filing a continuation-in-part application merging the conflicting inventions into a single application, this conflict can result in hardship where there is a pending application and an issued patent that can no longer be merged by filing a continuation-in-part application.

Specifically, the proposed amendment to § 1.131(a) in the § 1.131 Notice of Proposed Rulemaking would have permitted the filing of an affidavit or declaration thereunder in a pending application or patent under reexamination to avoid a rejection under 35 U.S.C. 103 based upon a patent which qualifies as prior art only under 35 U.S.C. 102(a) or (e) where the pending application or patent under reexamination and patent upon which the rejection was based were owned by a single party. This proposed amendment to § 1.131(a) in the § 1.131 Notice of Proposed Rulemaking, however, was withdrawn in the final rule to permit further study.

Section 1.131(a), as currently proposed, would permit a showing of prior invention in a pending application or patent under reexamination to avoid a rejection under 35 U.S.C. 103 based upon a patent which qualifies as prior art only under 35 U.S.C. 102(a) or (e), where the application or patent under reexamination and the patent upon which the rejection is based are both owned by a single party, so long as the invention claimed in the pending application or patent under reexamination and in the other patent are not identical as set forth in 35 U.S.C. 102. Section 1.131(a)(3), as proposed, would not require common ownership at the time the latter invention was made, but consistent with § 1.602(a), would require only that there be common ownership when the § 1.131 affidavit or declaration is under consideration.

Where the patent upon which the rejection is based is not prior art under 35 U.S.C. 102 (a) or (e), but is prior art only under 35 U.S.C. 102(f) or (g), to the pending application or patent under reexamination, and the invention claimed in the pending application or patent under reexamination is not identical as set forth in 35 U.S.C. 102, the issue is whether the subject matter of the other patent and the invention claimed in the pending application or patent under reexamination were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person, i.e., whether the patent upon which the rejection is based is disqualified as prior art under the second paragraph of 35 U.S.C. 103, and §§ 1.78 (c) and (d) are applicable to this issue. Where, however, the patent upon which the rejection is based is prior art under 35 U.S.C. 102(a) or (e), it cannot be disqualified as prior art under the second paragraph of 35 U.S.C. 103, and as such §§ 1.78 (c) and (d) are inapplicable. Section 1.131(a)(3), as currently proposed, would permit a showing of prior invention in an application or patent under reexamination where the application or patent under reexamination and patent upon which the rejection was based were owned by a single party.

As the conflict between two pending applications can be avoided by filing a continuation-in-part application merging the conflicting inventions into a single application, § 1.131(a)(3), as proposed, provides only for a showing of prior invention to avoid a rejection based upon a patent. In situations in which two pending applications claiming patentably indistinct but not identical inventions are held by a single party but cannot be merged into a single application, petitions under § 1.183 will be entertained for waiver of the § 1.131

requirement that the rejection be based upon a patent.

Section 1.131, as proposed, would not affect a statutory or non-statutory double patenting rejection. Specifically, affidavits or declarations under § 1.131 will continue to be ineffective where the claims of the pending application or the patent undergoing reexamination are rejected under 35 U.S.C. 101 for double patenting and the claims of the pending application or the patent under reexamination claim the identical invention of a patent. However, where patentably indistinct but not identical inventions are claimed, a non-statutory double patenting rejection can be overcome by filing an appropriate terminal disclaimer.

Section 1.132, as proposed, would change ''domestic'' to ''U.S.'' for consistency with § 1.131, and would include U.S. pending published applications which substantially show or describe but do not claim the invention, and abandoned published applications as references to which the provisions of § 1.132 apply for the reasons discussed supra.

Section 1.136(a), as proposed, would provide that extensions under § 1.136(a) are not available where the response is to a requirement for an English translation, an abstract or claims on a separate sheet, or substitute specification or sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction submitted pursuant to §§ 1.52(d), 1.53(d), 1.60(d), 1.62(d), 1.494(c), or 1.495(c), or an oath or declaration submitted pursuant to §§ 1.494(c) or 1.495(c).

Section 1.138, as proposed, would add ''or publication'' to the end of the sentence that ''express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue'' to clarify that the express abandonment must be filed in sufficient time to permit its correlation with the application file and the termination of the publication process. Section 1.138, as proposed, would further provide that an applicant seeking to abandon an application to avoid publication of the application must submit a proper letter of express abandonment at least two months prior to the projected date of publication to allow sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process, and that unless an applicant receives written acknowledgement of the letter of express abandonment prior to the projected date of publication, applicant should expect that the application will be published in due course.

Section 1.154, as proposed, would provide that the elements of a design application, if applicable, should appear in the following order: (1) Design Application Transmittal Form; (2) Fee Transmittal Form; (3) preamble, stating name of the applicant and title of the design; (4) cross-reference to related applications; (5), statement regarding federally sponsored research or development; (6) description of the figure or figures of the drawing; (7) description; (8) claim; (9) drawings or photographs; and (10) executed oath or declaration. The phrase ''[t]he following order of arrangement should be observed in framing design specifications'' is proposed to be changed to ''[t]he elements of the design application, if applicable, should appear in the following order'' to clarify that § 1.154 does not per se require that an application include all of the listed elements, but merely provides that any listed element included in the application should appear in the order set forth in § 1.154.

A new § 1.163(c), as proposed, would be added to provide that the elements of a plant application, if applicable, should appear in the following order: (1) Plant Application Transmittal Form; (2) Fee Transmittal Form; (3) abstract of the disclosure; (4) title of the invention; (5) cross-reference to related applications; (6) statement regarding federally sponsored research or development; (7) background of the invention; (8) brief summary of the invention; (9) brief description of the drawing; (10) detailed botanical description; (11) claim; (12) drawings (in duplicate); (13) executed oath or declaration; and (14) Plant Color Coding Sheet. The phrase ''if applicable'' is proposed to be included in the heading, rather than associated with any particular listed element, to clarify that § 1.163 does not per se require that an application include all of the listed elements, but merely provides that any listed element included in the application should appear in the order set forth in § 1.163.

A new § 1.163(d), as proposed, would be added to define a plant color coding sheet. A plant color coding sheet is a sheet that specifies a color coding system as designated in a recognized color dictionary, and lists every plant structure to which color is a distinguishing feature and the corresponding color code which best represents that plant structure. The plant color coding sheet will provide a means for applicants to uniformly convey detailed color characteristics of the plant. Providing this information is a systematic manner will facilitate the examination of the application.

Section 1.291, as proposed, would provide that a protest must be filed within two months of the date the application is published or prior to the mailing of a Notice of Allowance, whichever occurs first, to be considered timely, and that any protest submitted after publication must be accompanied by the fee set forth in § 1.17(t). In addition, § 1.291(a)(2), as proposed, would require that any protest filed after the date the application was published be served upon the applicant in accordance with § 1.248, i.e., filing two copies of the protest in the Office would not be acceptable. As a protest cannot be considered subsequent to issuance of the application as a patent, § 1.291(b), as proposed, would provide that the protest will be considered if the application is still pending when the protest and application file is brought before the examiner, i.e., that the application was pending at the time the protest was filed would be immaterial to its ultimate consideration. Finally, § 1.291, as proposed, would further locate the sentences ''[p]rotests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues'' and [p]rotests which do not adequately identify a pending patent application will be disposed of and will not be considered by the Office'' in paragraph (b).

Section 1.292, as proposed, would be amended to delete the phrase ''is filed by one having information of the pendency of an application'' as applications will no longer necessarily be maintained in confidence throughout their entire pendency, and would move the requirement for the fee set forth in § 1.17(j) from paragraph (a) to paragraph (b) where the conditions for entry of a petition for the institution of public use proceedings are set forth. Section 1.292, as proposed, would further require that any petition filed after the date the application was published be served on the applicant in accordance with § 1.248. Finally, § 1.292, as proposed, would provide that a petition to institute public use proceedings must be filed within two months of the date the application is published or prior to the mailing of a Notice of Allowance, whichever occurs first, to be considered timely.

Sections 1.305 through 1.309 are proposed to be added to set forth the procedures for the 18-month publication of patent applications.

Section 1.305, as proposed, would provide that applications may be

withdrawn from publication at the initiative of the Office or upon request by the applicant. The basis for the withdrawal of an application from publication would be limited to: (1) A mistake on the part of the Office, e.g., the application is abandoned or has issued as a patent, or the projected publication date is not at 18 months from the earliest filing date for which a benefit is sought; (2) the application is either national security classified or subject to a secrecy order pursuant to 35 U.S.C. 181; or (3) express abandonment of the application.

Section 1.306(a), as proposed, would provide that applications under 35 U.S.C. 111(a), 161 or 371 will be published as soon as possible after the expiration of a period of 18 months from the filing date, including the earliest filing date for which a benefit is sought, but excludes applications that: (1) Are national security classified or subject to a secrecy order pursuant to 35 U.S.C. 181; (2) have issued as a patent; (3) are recognized by the Office as no longer pending, i.e., are abandoned; or (4) were previously published through early publication.

Section 1.306(b), as proposed, would provide that the publication of an application will include a notice designated as a ''Gazette Entry'' containing information such as the application number, filing date, title, inventor's name, abstract, a drawing figure, a representative claim, and U.S. and IPC classification in a Gazette of Patent Application Notices, and a printed publication designated as a Patent Application Notice or PAN containing information such as the application number, filing date, title, inventor's name, correspondence address, abstract, a drawing figure, a representative claim, and U.S. and IPC classification. In addition, § 1.306(b), as proposed, would provide that the publication of an application will include a document designated as a Technical Contents Publication containing the Patent Application Notice, and the specification, abstract, claims, and drawings of the original application papers. Finally, § 306(b), as proposed, would provide that publication would include public access to a copy of the specification, drawings, and all papers relating to the application file in accordance with § 1.11.

Section 1.306(c), as proposed, would provide that provisional applications under 35 U.S.C. 111(b) shall not be published, and that design applications under 35 U.S.C. 171 and reissue applications under 35 U.S.C. 251 shall not be published pursuant to § 1.306. H.R. 1733, if enacted, would not authorize the publication of design applications (prior to their issuance as patents) or provisional applications. Reissue applications are currently published through the announcement in the Official Gazette of the filing of the reissue application, and the opening of the application to public inspection in accordance with § 1.11(b).

Section 1.306(d), as proposed, would provide for the early publication of applications. Any request for early publication of an application should be filed as soon as possible, and must be by way of petition, including the fee set forth in § 1.17(i). In addition, any application must include an abstract and claims on a separate sheet, any substitute specification or drawings required pursuant to §§ 1.53(d), 1.60(d), or 1.62(d), and any English translation required pursuant to § 1.52(d). The Office cannot assure publication of an application on any certain date, and, as such, requests for publication on a date certain will be treated as a request for publication as soon as possible. Finally, as H.R. 1733, if enacted, would not authorize the publication of provisional applications, no consideration will be given to any request for the early publication of a provisional application.

Section 1.306(e), as proposed, would implement the provisions in H.R. 1733 (35 U.S.C. 122(b)(2)) for, under limited circumstances, not publishing an application under 35 U.S.C. 122(b) until three months after an Office action under 35 U.S.C. 132. Section 1.306(e), as proposed, would specifically provide that an applicant who is an independent inventor and has been accorded status under 35 U.S.C. 41(h) in an application that does not claim the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, 365(a) or 365(c) may request that the application not be published until three months after an action on the merits, and that a petition requesting that the application not be published until three months after an action on the merits must be submitted on filing, and accompanied by the petition fee set forth in § 1.17(i) and a certification that the invention disclosed in the application was not or will not be the subject of an application filed in a foreign country, which certification must be verified if made by a person not registered to practice before the Patent and Trademark Office.

Section 1.307, as proposed, would provide for the delivery of the printed publication, i.e., the Patent Application Notice or PAN, to the correspondence address of record, which is the manner in which a patent is currently delivered to the patentee.

Section 1.308, as proposed, would provide for the correction of the printed publication, but such correction would be granted only for a significant mistake made by the Office which is apparent from Office records.

Section 1.315, as proposed, would change ''the attorney or agent of record, if there be one; or if the attorney or agent so requests, to the patentee or assignee of an interest therein; or, if there be no attorney or agent, to the patentee or to the assignee of the entire interest, if he so requests'' to ''the correspondence address of record. See § 1.33(a)'' for simplicity as patents are currently mailed to the patentee at the correspondence address of record.

Section 1.321(c), as proposed, would change ''double patenting rejection'' to ''non-statutory double patenting rejection'' for consistency with § 1.78(c), as proposed, and to clarify that the filing of a terminal disclaimer is ineffective to overcome a statutory double patenting rejection.

Section 1.492(a), as proposed, would increase the basic national fee for international applications entering the national stage under 35 U.S.C. 371 to: (1) $710 ($355 for a small entity) where an international preliminary examination fee as set forth in § 1.482 has been paid on the international application to the Office; (2) $780 ($390 for a small entity) where no international preliminary examination fee as set forth in § 1.482 has been paid to the Office, but an international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the Office as an International Searching Authority; (3) $1040 ($520 for a small entity) where no international preliminary examination fee as set forth in § 1.482 has been paid and no international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the Office; (4) $120 ($60 for a small entity) where the international preliminary examination fee as set forth in § 1.482 has been paid to the Office and the international preliminary examination report states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1) to (4) have been satisfied for all the claims presented in the application entering the national stage (see § 1.496(b)); and (5) $910 ($455 for a small entity) where a search report on the international application has been prepared by the European Patent Office or the Japanese Patent Office.

Section 1.494 (c) and (g), as proposed, would provide that the applicant will be given a time period within which to file an abstract and claims on a separate

sheet, or substitute specification in compliance § 1.125 with papers typed on but one side of the paper or new sheets of drawings, each of the substitute specification and sheets of drawings of sufficient clarity, contrast, and quality, and in a proper size and format for electronic reproduction in instances in which the application papers did not comply with §§ 1.52 (a) and (b), as proposed, or the drawings were of such poor quality as to preclude their digital image scanning into the electronic data base. Section 1.494(c), as proposed, would further provide that extensions of time pursuant to § 1.136(a) would not be available for filing an English translation, oath or declaration, abstract and claims on a separate sheet, and a substitute specification with papers typed on but one side of the paper and sheets of drawings, each of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction.

Section 1.495 (c) and (h), as proposed, would provide that the applicant will be given a time period within which to file an abstract and claims on a separate sheet, or substitute specification in compliance § 1.125 with papers typed on but one side of the paper or new sheets of drawings, each of the substitute specification and sheets of drawings of sufficient clarity, contrast, and quality, and in a proper size and format for electronic reproduction in instances in which the application papers did not comply with §§ 1.52 (a) and (b), as proposed, or the drawings were of such poor quality as to preclude their digital image scanning into the electronic data base. Section 1.495(c), as proposed, would further provide that extensions of time pursuant to § 1.136(a) would not be available for filing an English translation, oath or declaration, abstract and claims on a separate sheet, and a substitute specification with papers typed on but one side of the paper and sheets of drawings, each of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction.

The proposed rules to implement 18-month publication provide that extensions of time pursuant to § 1.136(a) are not available for submissions which will affect the publication of the application. Section 1.53(d)(1), as proposed, does not exclude extensions of time pursuant to § 1.136(a) for the filing of an oath or declaration as the absence of an oath or declaration for an application filed under 35 U.S.C. 111(a) does not affect the publication of the application. Section 1.306(a), as proposed, does not provide for the publication of a national application for patent which resulted from an international application until after compliance with 35 U.S.C. 371, and an international application is not in compliance with 35 U.S.C. 371 until an oath or declaration is filed. See 35 U.S.C. 371(c)(4). Therefore, the absence of an oath or declaration will affect the publication of an application under 35 U.S.C. 371. Accordingly, §§ 1.494(c) and 1.495(c), unlike § 1.53(d)(1), provide that the period for filing the oath or declaration cannot be extended pursuant to § 1.136(a) to consistently provide that extensions of time pursuant to § 1.136(a) are not available for submissions which will affect the publication of the application.

Section 1.497(a), as proposed, would be amended to provide that an applicant in an international application must file an oath or declaration that: (1) is executed in accordance with either §§ 1.66 or 1.68, (2) identifies the specification to which it is directed, (3) identifies each inventor and the country of citizenship of each inventor, and (4) states that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought, rather than an oath or declaration in accordance with § 1.63, to enter the national stage pursuant to §§ 1.494 or 1.495. Currently, the failure to file an oath or declaration in strict compliance with § 1.63 results in non-compliance with § 1.497, and thus 35 U.S.C. 371, which in turn delays the entry of the international application into the national stage. To expedite the entry of international applications into the national stage, § 1.497(a), as proposed, would require only an oath or declaration that is properly executed, identifies the specification to which it is directed, and, as required by 35 U.S.C. 115, identifies each inventor and the country of citizenship of each inventor and states that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.

Section 1.497(b), as proposed, would be subdivided into paragraphs (b)(1) and (b)(2). Section 1.497(b)(1), as proposed, would provide that the oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47. Section 1.497(b)(2), as proposed, would change ''[i]f the international application was made as provided in §§ 1.422, 1.423 or 1.425, the applicant shall state his or her relationship to the inventor and, upon information and belief, the facts which the inventor is required by § 1.63 to state'' to ''[i]f the person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47), the oath or declaration shall state the relationship of the person to the inventor and, upon information and belief, the facts which the inventor is required to state'' such that § 1.497(b), as proposed, would be parallel to § 1.64.

Section 1.497(c), as proposed, would be added to provide that the oath or declaration must comply with the requirements of § 1.63. Section 1.497(c), as proposed, would further provide that in instances in which the oath or declaration does not comply with § 1.63, but meets the requirements of § 1.497 (a) and (b), as proposed, the oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) and §§ 1.494(c) or 1.495(c), thus permitting the application to enter the national stage and the assignment of dates under 35 U.S.C. 102(e) and 371(c). A supplemental oath or declaration in compliance with § 1.63, however, will be required in accordance with § 1.67.

Section 1.701(a), as proposed, would add ''an unusual administrative delay by the Office'' to the bases for extension of patent term due to prosecution delay. H.R. 1733 provides that the Commissioner shall prescribe regulations to govern the particular circumstances deemed to be an unusual administrative delay. Section 1.701(a)(4)(i), as proposed, would set forth the failure to act on a reply under § 1.111 or appeal brief under § 1.192 within six months of the date it was filed; the failure to act on an application within six months of the date of a decision under § 1.196 by the Board of Patent Appeals and Interferences where claims stand allowed in an application or the nature of the decision requires further action by the examiner; and the failure to issue a patent within six months of the date that the issue fee was paid and all outstanding requirements were satisfied as circumstances constituting a *prima facie* unusual administrative delay. In an application entitled to an extension under § 1.701(a)(3), however, any unusual administrative delay during the appellate proceeding would be disregarded under § 1.701(a)(4) in accordance with the ''not overlapping'' provision in § 1.701(b). Requests for patent term extension based upon circumstances not specifically set forth in § 1.701(a)(4)(i) as a *prima facie* unusual administrative delay must be specifically requested by petition and would be considered on a case-by-case basis. Section 1.701(a), as proposed,

would further add ''subject to the provisions of this section'' and delete the phrase ''if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review'' from paragraph (a)(3).

Section 1.701(b), as proposed, would add paragraph (c)(4) to those paragraphs summed in calculating the period of extension, and change the maximum extension from five years to ten years in accordance with H.R. 1733.

Section 1.701(c), as proposed, would provide that the period of delay is the sum of the number of days, if any, in the period of unusual delay by the Office. That is, the ordinary delay in processing and examining an application would not be included under § 1.701(c), as proposed, in determining the extension under § 1.701(b). For example, (1) where there was a failure to act on a reply under § 1.111 within six months of the date it was filed, the period of delay is the number of days in excess of six months, if any, in the period beginning on the date a reply under § 1.111 was filed and ending on the mailing date of an action in response thereto, (2) where there was a failure to act on an appeal brief under § 1.192 within six months of the date it was filed, and the application is not entitled to an extension under § 1.701(a)(3), the period of delay is the number of days in excess of six months, if any, in the period beginning on the date an appeal brief under § 1.192 was filed and ending on the mailing date of either a notification under § 1.192(d) or examiner's answer under § 1.193, and (3) where there was a failure to issue a patent within six months of the date that the issue fee was paid and all outstanding requirements were satisfied, § 1.701(a)(3), the period of delay is the number of days in excess of six months, if any, in the period beginning on the date the issue fee was paid or all outstanding requirements were satisfied, whichever is later, and the date the patent was issued.

Section 1.701(d), as proposed, would change ''[t]he period of delay set forth in paragraph (c)(3)'' to ''[t]he period set forth in paragraph (c),'' as the limitation on patent term extension in H.R. 1733 based upon an applicant's failure to engage in reasonable efforts to conclude processing or examination of the application is not limited to extension under 35 U.S.C. 154(b)(2), i.e., delays during appellate proceedings. Section 1.701(d), as proposed, would further delete ''any time during the period of appellate review that occurred before three years from the filing date of the first national application for a patent presented for examination.'' Public Law 103–465 provides that extensions under 35 U.S.C. 154(b)(2) shall be reduced by any time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination, where H.R. 1733 provides only that no patent shall be extended under 35 U.S.C. 154(b) that has issued before the expiration of three years after the filing date of the application or entry of the application into the national stage under 35 U.S.C. 371, whichever is later, not taking into account any claim to the benefit of the filing date of any application under 35 U.S.C. 120, 121, or 365(c).

Section 1.701(d), as proposed, would further change ''any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence'' and ''[i]n determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review'' to ''any time during the processing or examination of the application, as determined by the Commissioner, during which the applicant for patent failed to engage in reasonable efforts to conclude processing or examination of the application,'' ''[i]n determining whether an applicant failed to engage in reasonable efforts to conclude processing or examination of the application, the Commissioner may examine the facts and circumstances of the applicant's actions during the entire prosecution of the application to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, an applicant for patent seeking to conclude the processing or examination of the application,'' and ''[c]ircumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application include: (1) requesting suspension of action under § 1.103, and (2) abandonment of the application.''

H.R. 1733 provides that the period of extension under 35 U.S.C. 154(b) shall be reduced by a period equal to the time during the processing or examination of the application leading to the patent in which the applicant failed to engage in reasonable efforts to conclude processing or examination of the application and that the Commissioner shall prescribe regulations establishing the circumstances that constitute a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application. Section § 1.701(d) specifically sets forth requesting suspension of action under § 1.103 and abandonment of the application as examples of *prima facie* failures to engage in reasonable efforts to conclude processing or examination of the application. In determining whether an applicant engaged in reasonable efforts to conclude processing or examination of the application, however, the facts and circumstances of applicant's actions during the entire prosecution of the application will be considered on a case-by-case basis to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, an applicant for patent seeking to conclude the processing or examination of the application. As such, it is not possible to list all of the specific circumstances in § 1.701(d). That is, circumstances other than the examples specifically set forth § 1.701(d) may, on a case-by-case basis, be considered the failure to engage in reasonable efforts to conclude the processing or examination of the application.

A new § 1.701(e), as proposed, would provide that no patent shall be extended under this section: (1) beyond the expiration date specified in a terminal disclaimer in a patent whose term has been disclaimed in such terminal disclaimer, or (2) an instance in which the patent issued before the expiration of three years after the filing date of the application or entry of the application into the national stage under 35 U.S.C. 371, whichever is later, not taking into account any claim to the benefit of the filing date of any application under 35 U.S.C. 120, 121, or 365(c). H.R. 1733 provides these limitations on extensions under 35 U.S.C. 154(b).

A new § 1.701(f), as proposed, would provide that any extension of patent term under § 1.701(a)(4) on the basis of an administrative delay other than one specifically set forth in §§ 1.701(a)(4)(i)(A)-(C) must be requested by petition. Due to the necessity for individualized determinations of patent term extensions based upon prosecution delay due to an unusual administrative delay by the Office not specifically provided for, such extensions of patent term under § 1.701(a)(4) must be specifically requested by petition in a timely manner. Section 1.701(f), as proposed, would specifically provide

that any petition for patent term extension based upon § 1.701(a)(4) for an unusual administrative delay by the Office other than one specifically set forth in §§ 1.701(a)(4)(i)(A)-(C) cannot be filed prior to the mailing of a notice of allowance under § 1.311 and must be accompanied by a statement of the facts involved, the administrative delay by the Office to be reviewed, the period of extension requested, and the fee set forth in § 1.17(i). The petition may include a request that the petition fee be refunded if an extension of the patent term under § 1.701(a)(4) is granted.

Section 1.808(a), as proposed, would provide that upon the publishing of the application, all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed, subject to provisions of § 1.808(b).

Section 3.31, as proposed, would provide that the assignment cover sheet may, but need not, include an indication that the assignment information is to be printed on the Patent Application Notice. Section 3.31, as proposed, would further provide that, due to constraints in the publication process, any such indication not submitted within two months of filing or fourteen months from the earliest filing date for which a benefit is claimed, whichever is later, may result in the assignment information not being printed on the Patent Application Notice.

Section 5.1, as proposed, would include a new paragraph (c) which would provide defense agencies adequate time to complete national security review under 35 U.S.C. 181 before an application would be released for publication under § 1.306. Specifically, the period for completion of a defense agency review would be six (6) months from the actual U.S. filing date for applications filed under 35 U.S.C. 111(a) or three (3) months from the date the application was made available to the defense agency for review, whichever is later.

Section 5.1, as proposed, would further include a new paragraph (d) which would set forth the current practice that applications on inventions not made in the United States and on inventions in which the Federal Government has a known property interest are not made available to defense agencies under § 5.2(b).

A new § 5.9, as proposed, would set forth the procedures for the treatment of national security classified applications. The procedures set forth in this section, except for those pertaining to the publication of applications pursuant to § 1.306, are the current procedures for the treatment of national security classified applications. It is, however, considered appropriate to implement these procedures through the rulemaking process.

35 U.S.C. 181 authorizes the withholding of the grant of a patent on an application that has been placed under a secrecy order; however, title 35, United States Code, does not specifically authorize the withholding of the grant of a patent on an application that is national security classified, but not placed under a secrecy order. Nevertheless, the Office is prohibited by Executive Order and statute from disclosing a national security classified application. Therefore, procedures for obtaining a secrecy order pursuant to 35 U.S.C. 181 on a national security classified application, or the declassification of such application, are necessary.

Section 5.9(a), as proposed, would provide that patent applications and papers that are national security classified and contain authorized national security markings of ''Confidential,'' ''Secret'' or ''Top Secret'' are accepted by the Office, that national security classified documents mailed to the Office must be addressed in compliance with § 5.33, and that national security classified documents may be hand-carried to Licensing and Review.

Section 5.9(b), as proposed, would provide that a national security classified patent application will not be published pursuant to § 1.306 or allowed pursuant to § 1.311 of this chapter until the application is declassified.

Section 5.9(c), as proposed, would clarify that, in a national security classified application, it is the applicant's responsibility to either obtain a secrecy order pursuant to § 5.2, or have the application declassified by the relevant department or agency. Section 5.9(c), as proposed, would further provide that in a national security classified patent application filed without a notification pursuant to § 5.2(a), *i.e.*, a recommendation for imposition of a secrecy order from the relevant department or agency, the Office will set a time period within which the application must be declassified, a secrecy order must be obtained, or evidence of a good faith effort to obtain a secrecy from the relevant department or agency must be presented in order to prevent abandonment of the application.

Section 5.9(d), as proposed, would provide for instances in which, after an effort to obtain a secrecy order, the national security classified application has not been declassified and a secrecy order has not been obtained. Section 5.9(d), as proposed, would specifically provide that in each instance in which the national security classified application has not been declassified and a secrecy order has not been obtained, but the applicant has presented evidence of a good faith effort to obtain a secrecy order, the Office will again set a time period within which the application must be declassified, a secrecy order pursuant to § 5.2 must be obtained, or evidence of a good faith effort to again obtain a secrecy order pursuant to § 5.2 from the relevant department or agency must be presented in order to prevent abandonment of the application. This process will reiterate until the application becomes abandoned, e.g., through a lack of a good faith effort to obtain a secrecy order or failure to prosecute under 35 U.S.C. 133, the application is declassified, or a secrecy order is obtained.

Other Considerations

The proposed rule changes are in conformity with the requirements of the Regulatory Flexibility Act (5 U.S.C. 601 *et seq.*), Executive Order 12612, and the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.* It has been determined that this rulemaking is significant for the purposes of Executive Order 12866.

The Assistant General Counsel for Legislation and Regulation of the Department of Commerce has certified to the Chief Counsel for Advocacy, Small Business Administration, that these proposed rule changes will not have a significant economic impact on a substantial number of small entities (Regulatory Flexibility Act, 5 U.S.C. 605(b)). The principal impact of these proposed changes is to require that application papers be filed in a format which permits their digital image and OCR scanning into an electronic data base, and that claims for the benefit of the filing date of prior foreign and domestic applications be submitted promptly to permit publication of the application at 18 months from the earliest filing date for which a benefit is sought.

The Office has also determined that this notice has no Federalism implications affecting the relationship between the National Government and the States as outlined in Executive Order 12612.

These proposed rule changes contain a collection of information requirements subject to the Paperwork Reduction Act of 1980, 44 U.S.C. 3501 *et seq.* The initial patent application filing is

currently approved by the Office of Management and Budget under Control No. 0651–0032. Public reporting burden for the collection of information for filing the initial patent application is estimated to average 11 hours per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information.

The Fee Transmittal form, Utility Patent Application Transmittal form, Design Patent Application Transmittal form, Plant Patent Application Transmittal form, Plant Color Coding Sheet, Declaration form, and Plant Patent Application Declaration form will reduce the burden and uncertainty associated with the submission of an application and related information, and enhance the Office's ability to use standardized automation routines (optical character recognition, etc.) to record and process information concerning applications. Public reporting burden for these collections of information is estimated to average: (1) 12 minutes per response for the Fee Transmittal form, (2) 12 minutes per response for the Utility Patent Application Transmittal form, (3) 12 minutes per response for the Design Patent Application Transmittal form, (4) 12 minutes per response for the Plant Patent Application Transmittal form, (5) 12 minutes per response for the Plant Color Coding Sheet, (6) 24 minutes per response for the Declaration form, and (7) 24 minutes per response for the Plant Patent Application Declaration. These estimates include the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collections of information.

The assignment cover sheet is currently approved by the Office of Management and Budget under Control No. 0651–0027. Public reporting burden for the collection of information on the assignment cover sheet is estimated to average 30 minutes per response, including the time for reviewing instructions, searching existing data sources, gathering and maintaining the data needed, and completing and reviewing the collection of information.

Send comments regarding this burden estimate or any other aspect of this collection of information, including suggestions for reducing this burden to the Office of Assistance Quality and Enhancement Division, Patent and Trademark Office, Washington, D.C. 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget, Washington, DC 20503 (ATTN: Paperwork Reduction Act Projects 0651–0027 and 0651–0032). The Fee Transmittal form, Utility Patent Application Transmittal form, Design Patent Application Transmittal form, Plant Patent Application Transmittal form, Plant Color Coding Sheet, Declaration form, and Plant Patent Application Declaration form have been submitted to the Office of Management and Budget for clearance under the Paperwork Reduction Act. See 60 FR 35174 (July 6, 1995). Written comments and recommendations for the proposed information collection should be sent to Maya A. Bernstein, OMB Desk Officer, room 10236, New Executive Office Building, Washington, D.C. 20230.

Notice is hereby given that pursuant to the authority granted to the Commissioner of Patents and Trademarks by 35 U.S.C. 6, the Patent and Trademark Office proposes to amend Title 37, Chapter I, of the Code of Federal Regulations as set forth below.

List of Subjects

37 CFR Part 1

Administrative practice and procedure, Courts, Freedom of Information, Inventions and patents, Reporting and record keeping requirements, Small Businesses.

37 CFR Part 3

Administrative practice and procedure, Inventions and patents, Reporting and record keeping requirements.

37 CFR Part 5

Classified information, foreign relations, inventions and patents.

For the reasons set forth in the preamble, 37 CFR parts 1, 3 and 5 are proposed to be amended as follows, with removals indicated by brackets ([]) and additions by arrows (><):

PART 1—RULES OF PRACTICE IN PATENT CASES

1. The authority citation for 37 CFR part 1 would continue to read as follows:

Authority: 35 U.S.C. 6, unless otherwise noted.

2. Section 1.4 is proposed to be amended by revising paragraph (a)(1) to read as follows:

§ 1.4 Nature of correspondence and signature requirements.

(a) Correspondence with the Patent and Trademark Office comprises:

(1) Correspondence relating to services and facilities of the Office, such as general inquiries, requests for publications supplied by the Office, orders for printed copies of patents >, patent application notices, technical contents publications< or trademark registrations, orders for copies of records, transmission of assignments for recording, and the like; and

* * * * *

3. Section 1.5 is proposed to be amended by revising paragraph (a) and adding paragraphs (f) and (g) to read as follows:

§ 1.5 Identification of application, patent or registration.

(a) No correspondence relating to an application should be filed prior to when notification of the application number is received from the Patent and Trademark Office. When a letter directed to the Patent and Trademark Office concerns a previously filed application for a patent, >including a published application,< it must identify on the top page in a conspicuous location, the application number (consisting of the series code and the serial number; e.g., 07/123,456), or the serial number and filing date assigned to that application by the Patent and Trademark Office, or the international application number of the international application. Any correspondence not containing such identification will be returned to the sender where a return address is available. The returned correspondence will be accompanied with a cover letter which will indicate to the sender that if the returned correspondence is resubmitted to the Patent and Trademark Office within two weeks of the mail date on the cover letter, the original date of receipt of the correspondence will be considered by the Patent and Trademark Office as the date of receipt of the correspondence. Applicants may use either the Certificate of Mailing or Transmission procedure under § 1.8 or the Express Mail procedure under § 1.10 for resubmissions of returned correspondence if they desire to have the benefit of the date of deposit in the United States Postal Service. If the returned correspondence is not resubmitted within the two-week period, the date of receipt of the resubmission will be considered to be the date of receipt of the correspondence. The two-week period to resubmit the returned correspondence will not be extended. If for some reason, returned correspondence is resubmitted with proper identification later than two weeks after the return mailing by the Patent and Trademark Office, the resubmitted correspondence will be

accepted but given its date of receipt. In addition to the application number, all letters directed to the Patent and Trademark Office concerning applications for patents should also state ''PATENT APPLICATION,'' the name of the applicant, the title of the invention, the date of filing the same, and, if known, the group art unit or other unit within the Patent and Trademark Office responsible for considering the letter and the name of the examiner or other person to which it has been assigned.

* * * * *

>(f) When a paper concerns a provisional application, it should identify the application as such and include the application number.

(g) A paper relating to a patent application notice should identify it as such and include the patent application notice number.<

4. Section 1.9 is proposed to be amended by revising paragraphs (a) and (b) and adding a paragraph (h) to read as follows:

§ 1.9 Definitions.

(a)(1) A national application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

(2) A provisional application as used in this chapter means a U.S. national application for patent filed in the Office under 35 U.S.C. 111(b).

(3) A nonprovisional application as used in this chapter means a U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a), or which entered the national stage from an international application after compliance with 35 U.S.C. 371.

>(4)<[(b)] An international application as used in this chapter means an international application for patent filed under the Patent Cooperation Treaty prior to entering national processing at the Designated Office stage.

>(b) A published application as used in this chapter means an application for patent which has been published pursuant to 35 U.S.C. 122(b).<

* * * * *

>(h) National security classified as used in this chapter means specifically authorized under criteria established by Act of Congress or Executive order to be kept secret in the interest of national defense or foreign policy and in fact properly classified pursuant to Act of Congress or Executive order.<

5. Section 1.11 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.11 Files open to the public.

(a) [After a patent has been issued or a statutory invention registration has been published, the] >The< specification, drawings, and all papers relating to the case in the file of >an abandoned published application, a< [the] patent >,< or >a< statutory invention registration are open to inspection by the public >.< [, and copies may be obtained upon paying the fee therefor.] >A copy of the specification, drawings, and all papers relating to the case in the file of a published application, a patent, or statutory invention registration may be obtained upon the payment of the fee set forth in § 1.19(b)(2).< See § 2.27 for trademark files.

* * * * *

6. Section 1.12 is proposed to be amended by revising paragraphs (a)–(c) to read as follows:

§ 1.12 Assignment records open to public inspection.

(a)(1) Separate assignment records are maintained in the Patent and Trademark Office for patents and trademarks. The assignment records, relating to original or reissue patents, including digests and indexes, for assignments recorded on or after May 1, 1957, >published applications,< and assignment records relating to pending or abandoned trademark applications and to trademark registrations, for assignments recorded on or after January 1, 1955, are open to public inspection at the Patent and Trademark Office, and copies of those assignment records may be obtained upon request and payment of the fee set forth in § 1.19 and § 2.6 of this chapter.

(2) All records of assignments of patents recorded before May 1, 1957, and all records of trademark assignments recorded before January 1, 1955, are maintained by the National Archives and Records Administration (NARA). The records are open to public inspection. Certified and uncertified copies of those assignment records are provided by NARA upon request and payment of the fees required by NARA.

(b) Assignment records, digests, and indexes relating to any pending or abandoned application >which has not been published pursuant to 35 U.S.C. 122(b)< are not available to the public. Copies of any such assignment records and information with respect thereto shall be obtainable only upon written authority of the applicant or applicant's assignee or attorney or agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee, or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules.

(c) Any request by a member of the public seeking copies of any assignment records of any pending or abandoned patent application preserved in >confidence< [secrecy] under § 1.14, or any information with respect thereto, must:

(1) Be in the form of a petition accompanied by the petition fee set forth in § 1.17(i); or

(2) Include written authority granting access to the member of the public to the particular assignment records from the applicant or applicant's assignee or attorney or agent of record.

* * * * *

7. Section 1.13 is proposed to be revised to read as follows:

§ 1.13 Copies and certified copies.

(a) Non-certified copies of patents >, patent application notices, technical contents publications, file wrapper and contents of published applications,< and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the Patent and Trademark Office and open to the public, will be furnished by the Patent and Trademark Office to any person, and copies of other records or papers will be furnished to persons entitled thereto, upon payment of the fee therefor.

(b) Certified copies of the patents >, patent application notices, technical contents publications, file wrapper and contents of published applications,< and trademark registrations and of any records, books, papers, or drawings within the jurisdiction of the Patent and Trademark Office and open to the public or persons entitled thereto will be authenticated by the seal of the Patent and Trademark Office and certified by the Commissioner, or in his name attested by an officer of the Patent and Trademark Office authorized by the Commissioner, upon payment of the fee for the certified copy.

8. Section 1.14 is proposed to be amended by revising the section heading, paragraphs (a)–(b) and (e) to read as follows:

§ 1.14 Patent applications preserved in >confidence< [secrecy].

(a) Except as provided in § 1.11(b) >,< pending patent applications >which have not been published pursuant to 35 U.S.C. 122(b)< are preserved in >confidence.< [secrecy.] No information

will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority in that particular application from the applicant or his assignee or attorney or agent of record, unless the application has been identified by >application number or< serial number >and filing date< in a published patent document >, a U.S. published application,< or >a published international application in which< the United States of America has been indicated as a Designated State [in a published international application], in which case status information such as whether it is pending, abandoned, or patented may be supplied, >or unless the application claims the benefit of the filing date of an application that has been referred to in a U.S. published application or patent, or identified by application number or serial number and filing date in a published patent document or a published international application in which the United States of America has been indicated as a Designated State, in which case the application number, filing date, and status information such as whether it is pending, abandoned, or patented may be supplied,< or unless it shall be necessary to the proper conduct of business before the Office or as provided by this part. Where an application has been patented, the patent number and issue date may also be supplied.

(b) [Except as provided in § 1.11(b), abandoned] >Abandoned< applications >which have not been published pursuant to 35 U.S.C. 122(b)< are likewise not open to public inspection, except >as provided in § 1.11(b) and as set forth below.< [that if] >If< an application referred to in a U.S. >published application or< patent, >application open to public inspection pursuant to this section, application which claims the benefit of the filing date of an application open to public inspection pursuant to this section,< or in an application in which the applicant has filed an authorization to open the complete application to the public, is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant. Complete applications (§ 1.51(a)) which are abandoned >and have not been published pursuant to 35 U.S.C. 122(b)< may be destroyed after 20 years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

* * * * *

(e) Any request by a member of the public seeking access to, or copies of, any pending or abandoned application preserved in >confidence< [secrecy] pursuant to paragraphs (a) and (b) of this section, or any papers relating thereto, must:

(1) Be in the form of a petition and be accompanied by the petition fee set forth in § 1.17(i); or

(2) Include written authority granting access to the member of the public in that particular application from the applicant or the applicant's assignee or attorney or agent of record.

* * * * *

9. Section 1.16 is proposed to be amended by revising paragraphs (a) and (g)–(h) to read as follows:

§ 1.16 National application filing fees.

(a) Basic fee for filing each application for an original patent, except provisional, design or plant cases:

By a small entity (§ 1.9(f))..... >$390.00< [$365.00]
By other than a small entity ..... >780.00< [730.00]

* * * * *

(g) Basic fee for filing each plant application, except provisional applications:

By a small entity (§ 1.9(f)) ...>270.00< [245.00]
By other than a small entity ..... >540.00< [490.00]

(h) Basic fee for filing each reissue application:

By a small entity (§ 1.9(f)) ...>390.00< [365.00]
By other than a small entity ..... >780.00< [730.00]

* * * * *

10. Section 1.17 is proposed to be amended by revising paragraph (i) and adding new paragraphs (t) and (u) to read as follows:

§ 1.17 Patent application processing fees.

* * * * *

(i) For filing a petition to the Commissioner under a section listed below which refers to this paragraph 130.00

§ 1.12—for access to an assignment record.

§ 1.14—for access to an application.

§ 1.53—to accord a filing date.

§ 1.55—for entry of late priority papers.

§ 1.60—to accord a filing date.

§ 1.62—to accord a filing date.

§ 1.97(d)—to consider an information disclosure statement.

§ 1.102—to make application special

§ 1.103—to suspend action in application.

§ 1.177—for divisional reissues to issue separately.

§ 1.312—for amendment after payment of issue fee.

§ 1.313—to withdraw an application from issue.

>§ 1.306(d)—for early publication of an application.

§ 1.306(e)—to defer publication of an application.<

§ 1.314—to defer issuance of a patent.

§ 1.666(b)—for access to interference settlement agreement.

>§ 1.701(f)—for patent term extension based upon administrative delay not specifically provided for.<

§ 3.81—for patent to issue to assignee, assignment submitted after payment of the issue fee.

* * * * *

>(t) For filing a protest under § 1.291 in an application after the date the application was published 220.00

(u) For the acceptance of a late claim for priority under 35 U.S.C. 119(a)-(d) or for acceptance of a late claim for the benefit of a prior application under 35 U.S.C. 119(e), 120 or 121 filed during the pendency of the application ..... 1500.00<

11. Section 1.18 is proposed to be amended by revising paragraphs (a) and (c) to read as follows:

§ 1.18 Patent issue fees.

(a) Issue fee for issuing each original or reissue patent, except a design or plant patent:

By a small entity (§ 1.9(f))..... >$640.00< [$605.00]
By other than a small entity ..... >1280.00< [1210.00]

* * * * *

(c) Issue fee for issuing a plant patent:

By a small entity (§ 1.9(f)) ...>330.00< [305.00]
By other than a small entity ..... >660.00< [610.00]

12. Section 1.19 is proposed to be amended by revising paragraphs (a)-(d) to read as follows:

§ 1.19 Document supply fees.

* * * * *

(a) Uncertified copies of patents >, patent application notices, and technical contents publications<:

(1) Printed copy of a >patent application notice,< patent, including a design patent, statutory invention registration, or defensive publication document, except plant or statutory invention registration containing color drawing:

(i) Regular service $3.00
(ii) Overnight delivery to PTO Box or

overnight fax 6.00
(iii) Expedited service for copy ordered by expedited mail or fax delivery service and delivered to the customer within two workdays 25.00
(2) Printed copy of a plant patent in color 12.00
(3) Copy of a utility patent or statutory invention registration containing color drawing (see § 1.84(a)(2)) 24.00
>(4) Copy of a technical contents publication.....9.00<

(b) Certified and uncertified copies of Office documents:

(1) Certified or uncertified copy of patent application as filed:

(i) Regular service.....>15.00< [12.00]
(ii) Expedited local service .....>30.00< [24.00]

(2) Certified or uncertified copy of >published application or< patent-related file wrapper and contents 150.00
(3) Certified or uncertified copy of Office records, per document >,< except >those contained in a pending application and< as otherwise provided in this section 25.00

>(4) Certified or uncertified copy of documents contained in a pending application:

(i) First document contained in a pending application 75.00
(ii) For each commonly requested additional document contained in such pending application.....25.00
(5)< [(4)] For assignment records, abstract of title and certification, per >published application or< patent 25.00
(c) Library service (35 U.S.C. 13): For providing to libraries copies of all patents issued annually >and technical contents publications published annually<, per annum 50.00
(d) For list of all United States >published applications,< patents and statutory invention registrations in a subclass 3.00

* * * * *

13. Section 1.20 is proposed to be amended by revising paragraphs (e)-(g) to read as follows:

§ 1.20 Post-issuance fees.

* * * * *

(e) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond four years; the fee is due by three years and six months after the original grant

By small entity (§ 1.9(f)).....>510.00< [480.00]
By other than a small entity .....>1020.00< [960.00]

(f) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond eight years; the fee is due by seven years and six months after the original grant

By a small entity (§ 1.9(f)).....>1010.00< [965.00]
By other than a small entity .....>2020.00< [1930.00]

(g) For maintaining an original or reissue patent, except a design or plant patent, based on an application filed on or after December 12, 1980, in force beyond twelve years; the fee is due by eleven years and six months after the original grant

By a small entity (§ 1.9(f)).....>1510.00< [1450.00]
By other than a small entity .....>3020.00< [2900.00]

* * * * *

14. Section 1.24 is proposed to be revised to read as follows:

§ 1.24 Coupons.

Coupons in denominations of three dollars, for the purchase of patents, >patent application notices and technical contents publications,< designs, defensive publications, statutory invention registrations, and trademark registrations are sold by the Patent and Trademark Office for the convenience of the general public; these coupons may not be used for any other purpose. The three-dollar coupons are sold individually and in books of 50 for $150.00. These coupons are good until used; they may be transferred but cannot be redeemed.

15. Section 1.51 is proposed to be amended by revising paragraph (a)(1) to read as follows:

§ 1.51 General requisites of an application.

(a) * * *

(1) A complete application filed under § 1.53(b)(1) comprises:

(i) A specification, including >an abstract and< a claim or claims, see §§ 1.71 to 1.77;

(ii) An oath or declaration, see §§ 1.63 and 1.68;

(iii) Drawings, when necessary, see §§ 1.81 to 1.85; and

(iv) The prescribed filing fee, see § 1.16.

* * * * *

16. Section 1.52 is proposed to be amended by revising paragraphs (a)–(b) and (d) to read as follows:

§ 1.52 Language, paper, writing, margins.

(a) The application, any amendments or corrections thereto, and the oath or declaration must be in the English language except as provided for in § 1.69 and paragraph (d) of this section, or be accompanied by a verified translation of the application and a translation of any corrections or amendments into the English language. All papers which are to become a part of the permanent records of the Patent and Trademark Office must be legibly [written,] typed [, or printed] in permanent >dark< ink >in portrait orientation on flexible, strong, smooth, non-shiny, durable and white paper.< [or its equivalent in quality.]

All of the application papers must be presented in a form having sufficient clarity and contrast between the paper and the [writing,] typing [, or printing] thereon to permit the direct reproduction of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes >and electronic reproduction by use of digital imaging and optical character recognition<. If the papers are not of the required quality, substitute typewritten [or printed] papers of suitable quality >will< [may] be required. >See § 1.125 for filing substitute typewritten papers constituting a substitute specification.<

(b) >Except for drawings, the< [The] application papers (specification, including claims, abstract, oath or declaration, and papers as provided for in §§ 1.42, 1.43, 1.47, etc.) and also papers subsequently filed, must be plainly >typed< [written] on but one side of the paper >, with the abstract and claims set forth on a separate sheet. See §§ 1.72(b) and 1.75(h)<. The [size of all] sheets of paper >must be the same size and either 21.0 cm. by 29.7 cm. (DIN size A4) or 21.6 cm. by 27.9 cm. (8½ by 11 inches).< [should be 8 to 8½ by 10½ to 13 inches (20.3 to 21.6 cm. by 26.6 to 33.0 cm.).] >Each sheet must include a top margin of at least 2.0 cm. (¾ inch), a left side margin of at least 2.5 cm. (1 inch), a right side margin of at least 2.0 cm. (¾ inch), and a bottom margin of at least 2.0 cm. (¾ inch), and no holes should be provided in the sheets.< [A margin of at least approximately one inch (2.5 cm.) must be reserved on the left-hand of each page. The top of each page of the application, including claims, must have a margin of at least approximately ¾ inch (2 cm.).] The lines must [not be crowded too closely together; typewritten lines should] be 1½ or double spaced. The pages of the application including claims and abstract >must< [should] be numbered consecutively, starting with 1, the numbers being centrally located above or preferably, below, the text. >See § 1.84 for drawings.<

* * * * *

(d) An application may be filed in a language other than English. A verified

English translation of the non-English-language application and the fee set forth in § 1.17(k) are required to be filed with the application or within such time >period< as may be set by the Office. >The period for filing the verified English translation cannot be extended pursuant to § 1.136(a).<

17. Section 1.53 is proposed to be amended by revising the section heading and paragraph (d)(1) to read as follows:

§ 1.53 Serial Number, filing date, and completion of application.

* * * * *

(d)(1) If an application which has been accorded a filing date pursuant to paragraph (b)(1) of this section does not include the appropriate filing fee >,< [or] an oath or declaration by the applicant, >an abstract on a separate sheet, claims on a separate sheet, papers typed on but one side of the paper, or application papers or sheets of drawings of sufficient clarity, contrast, and quality, and in the proper size and format for electronic reproduction,< applicant will be so notified, if a correspondence address has been provided >. The applicant will be< [and] given a period of time within which to >correct the deficiencies< [file the fee, oath or declaration] and to pay the surcharge as set forth in § 1.16(e) >if the application did not include the basic filing fee or the oath or declaration by the applicant< in order to prevent abandonment of the application. A copy of the ''Notice to File Missing Parts'' form mailed to applicant should accompany any response thereto submitted to the Office. If the required filing fee is not timely paid, or if the processing and retention fee set forth in § 1.21(l) is not paid within one year of the date of mailing of the notification required by this paragraph, the application will be disposed of. No copies will be provided or certified by the Office of an application which has been disposed of or in which neither the required basic filing fee nor the processing and retention fee has been paid. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. If no correspondence address is included in the application, applicant has two months from the filing date to file the basic filing fee, oath or declaration >, abstract or claims on a separate sheet, papers typed on but one side of the paper, papers and sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction,< and to pay the surcharge as set forth in § 1.16(e) >if the application did not include the basic filing fee or the oath or declaration by the applicant< in order to prevent abandonment of the application; or, if no basic filing fee has been paid, one year from the filing date to pay the processing and retention fee set forth in § 1.21(l) to prevent disposal of the application. >The period for filing an abstract and claims on a separate sheet, and a substitute specification and sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction cannot be extended pursuant to § 1.136(a).<

* * * * *

18. Section 1.54 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.54 Parts of application to be filed together; filing receipt.

* * * * *

(b) Applicant will be informed of the application [serial] number >,< [and] filing date >, and projected publication date< by a filing receipt.

19. Section 1.55 is proposed to be amended by revising paragraph (a) and adding paragraphs (c)–(d) to read as follows:

§ 1.55 Claim for foreign priority.

(a) An applicant in a nonprovisional application may claim the benefit of the filing date of a prior foreign application under the conditions specified in 35 U.S.C. 119 (a)–(d) and 172. The claim to priority >under 35 U.S.C. 172< need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by § 1.63. >The claim to priority under 35 U.S.C. 119(a)–(d) must be presented within two months of filing or fourteen months from the filing date of the prior foreign application, whichever is later, must identify the prior foreign application by specifying its application number, country, and the day, month and year of its filing, and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by § 1.63.< The [claim for priority and the] certified copy of the foreign application specified in 35 U.S.C. 119(b) must be filed in the case of an interference (§ 1.630), when necessary to overcome the date of a reference relied upon by the examiner, when specifically required by the examiner, and in all other cases, before the patent is granted. If the [claim for priority or the] certified copy of the foreign application is filed after the date the issue fee is paid, it must be accompanied by a petition requesting entry and by the fee set forth in § 1.17(i). If the certified copy filed is not in the English language, a translation need not be filed except in the case of interference; or when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, in which event an English language translation must be filed together with a statement that the translation of the certified copy is accurate. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office.

* * * * *

>(c) If a claim to priority under 35 U.S.C. 119(a)–(d) is presented after the time period provided by paragraph (a) of this section, the claim may be accepted if the claim identifying the prior foreign application by specifying its application number, country, and the day, month and year of its filing is filed during the pendency of the application and the delay in stating the claim was unintentional. A petition to accept a delayed claim to priority under 35 U.S.C. 119(a)–(d) must be accompanied by:

(1) The surcharge set forth in § 1.17(u); and

(2) A statement that the delay was unintentional. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the delay was unintentional.

(d) The time periods set forth in this section cannot be extended.<

20. Section 1.58 is proposed to be amended by removing and reserving paragraph (b) and revising paragraph (c) to read as follows:

§ 1.58 Chemical and mathematical formulas and tables.

* * * * *

(b) >[Reserved]< [All tables and chemical and mathematical formulas in the specification, including claims, and amendments thereto, must be on paper which is flexible, strong, white, smooth, non-shiny, durable in order to permit use as camera copy when printing any patent which may issue. A good grade of bond paper is acceptable; watermarks should not be prominent. India ink or its equivalent, or solid black typewriter, should be used to secure perfectly black solid lines.]

(c) To facilitate camera copying when printing, the width of formulas and tables as presented should be limited normally to >12.7 cm. (5 inches)< [5 inches (12.7 cm.)] so that it may appear as a single column in the printed patent.

[If it is not possible to limit the width of a formula or table to 5 inches (12.7 cm.), it is permissible to present the formula or table with a maximum width of 10¾ inches (27.3 cm.) and to place it sideways on the sheet.] Typewritten characters used in such formulas and tables must be from a block (nonscript) type font or lettering style having capital letters which are at least >2.1 mm. (0.08 inch)< [0.08 inch (2.1 mm.)] high (*e.g.*, elite type). [Hand lettering must be neat, clean, and have a minimum character height of 0.08 inch (2.1 mm.)]. A space at least >.64 cm. (¼ inch)< [¼ inch (6.4 mm.)] high should be provided between complex formulas and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with high degree of legibility.

21. Section 1.60 is proposed to be amended by revising the section heading and paragraph (d) to read as follows:

§ 1.60 Continuation or divisional application for invention disclosed in a prior application.

* * * * *

(d) If an application filed pursuant to paragraph (b) of this section is otherwise complete, but does not include the appropriate filing fee, a true copy of the oath or declaration from the prior complete application, showing the signature or an indication it was signed, >or the prior application did not include an abstract and claims on a separate sheet, and application papers typed on but one side of the paper with application papers or sheets of drawings of sufficient clarity, contrast, or quality in the proper size and format for electronic reproduction,< a filing date will be granted and applicant will be so notified and given a period of time within which to file the fee, or the true copy of the oath or declaration >, an abstract and claims on a separate sheet, substitute specification in compliance with § 1.125 with papers typed on but one side of the paper and sheets of drawings, each of the substitute specification and sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction,< and to pay the surcharge as set forth in § 1.16(e) >if the application did not include the basic filing fee or the copy of the oath or declaration from the prior application< in order to prevent abandonment of the application. The notification pursuant to this paragraph may be made simultaneously with any notification pursuant to paragraph (c) of this section. >The period for filing an abstract and claims on a separate sheet and a substitute specification and sheets of drawings of sufficient clarity, contrast, and quality for electronic reproduction cannot be extended pursuant to § 1.136(a).<

22. Section 1.62 is proposed to be amended by revising paragraphs (d)–(f) to read as follows:

§ 1.62 File wrapper continuing procedure.

* * * * *

(d) If an application which has been accorded a filing date pursuant to paragraph (a) of this section does not include the appropriate basic filing fee pursuant to paragraph (b) of this section, or an oath or declaration by the applicant in the case of a continuation-in-part application pursuant to paragraph (c) of this section, >or any substitute specification and drawings pursuant to paragraph (e)(2) of this section,< applicant will be so notified and given a period of time within which to file the fee, oath [,] or declaration >, substitute specification, and drawings< and to pay the surcharge as set forth in § 1.16(e) >if the application did not include the basic filing fee or oath or declaration< in order to prevent abandonment of the application. The notification pursuant to this paragraph may be made simultaneously with any notification of a defect pursuant to paragraph (a) of this section. >The period for filing a substitute specification cannot be extended pursuant to § 1.136(a).<

(e)>(1)< An application filed under this section will utilize the file wrapper and contents of the prior application to constitute the new continuation, continuation-in-part, or divisional application but will be assigned a new application [serial] number. Changes to the prior application must be made in the form of an amendment to the prior application as it exists at the time of filing the application under this section.

>(2)< No copy of the prior [application or new] specification >or drawings< is required >, unless the application is a continuation-in-part application containing any additional disclosure, in which case a substitute specification in compliance with § 1.125 and drawings are required. Any new specification filed will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with § 1.125<. [The filing of such a copy or specification will be considered improper, and a filing date as of the date of deposit of the request for an application under this section will not be granted to the application unless a petition with the fee set forth in § 1.17(i) is filed with instructions to cancel the copy or specification.]

(f) The filing of an application under this section will be construed to include a waiver of >confidence< [secrecy] by the applicant under 35 U.S.C. 122>(a)< to the extent that any member of the public who is entitled under the provisions of >§ < [37 CFR] 1.14 to access to, or information concerning either the prior application or any continuing application filed under the provisions of this section may be given similar access to, or similar information concerning, the other application(s) in the file wrapper.

* * * * *

23. Section 1.72 is proposed to be amended by revising paragraph (b) to read as follows:

§ 1.72 Title and abstract.

* * * * *

(b) A brief abstract of the technical disclosure in the specification must be set forth on a separate sheet, preferably >prior to the first page of the specification< [following the claims] under the heading ''Abstract of the Disclosure''. The purpose of the abstract is to enable the Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure. The abstract shall not be used for interpreting the scope of the claims.

24. Section 1.75 is proposed to be amended by revising paragraph (g) and adding paragraphs (h) and (i) to read as follows:

§ 1.75 Claim(s).

* * * * *

(g) >The least restrictive claim should be presented as claim number 1, and all< [All] dependent claims should be grouped together with the claim or claims to which they refer to the extent possible.

>(h) The claim or claims must be set forth on a separate sheet.

(i) Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.<

25. Section 1.77 is proposed to be revised to read as follows:

§ 1.77 Arrangement of application elements.

>(a)< The elements of the application >, if applicable,< should appear in the following order:

[(a)] >(1) Utility Application Transmittal Form.

(2) Fee Transmittal Form.

(3) Abstract of the disclosure.

(4)< Title of the invention; or an introductory portion stating the name,

citizenship, and residence of the applicant, and the title of the invention may be used.

>(5)<[(c)(1)] Cross-reference to related applications [, if any].

>(6)< [(2)] >Statement regarding federally sponsored research or development.

(7)< Reference to a ''Microfiche appendix'' [if any]. (See § 1.96 >(c)< [(b)]). The total number of microfiche and total number of frames should be specified.

>(8)< [(d)] >Background of the invention.

(9)< Brief summary of the invention.

>(10)< [(e)] Brief description of the several views of the drawing [, if there are drawings].

>(11)< [(f)] Detailed description.

>(12)< [(g)] Claim or claims.

>(13)< [(h) Abstract of the disclosure.

(i) Signed oath or declaration.

(j)] Drawings.

>(14) Executed oath or declaration.

(15) Sequence Listing (See § 1.821 *et seq.*).

(b) The elements set forth in paragraphs (a)(3) through (a)(6), (a)(8) through (a)(12) and (a)(15) of this section should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, with the phrase ''Not Applicable'' should follow the section heading.<

26. Section 1.78 is proposed to be amended by revising paragraphs (a) and (c)–(d) to read as follows:

§ 1.78 Claiming benefit of earlier filing date and cross references to other applications.

(a)(1) A nonprovisional application may claim an invention disclosed in one or more prior filed copending nonprovisional applications or international applications designating the United States of America. In order for a nonprovisional application to claim the benefit of a prior filed copending nonprovisional application or international application designating the United States of America, each prior application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior application must be:

(i) Complete as set forth in § 1.51(a)(1); or

(ii) Entitled to a filing date as set forth in § 1.53(b)(1), § 1.60 or § 1.62 and include the basic filing fee set forth in § 1.16; or

(iii) Entitled to a filing date as set forth in § 1.53(b)(1) and have paid therein the processing and retention fee set forth in § 1.21(l) within the time period set forth in § 1.53(d)(1).

(2) Any nonprovisional application claiming the benefit of one or more prior filed copending nonprovisional applications or international applications designating the United States of America must >, within two months of filing or within fourteen months of the filing date of the prior application, whichever is later,< contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior application, identifying it by application number (consisting of the series code and serial number) or international application number and international filing date and indicating the relationship of the applications. Cross-references to other related applications may be made when appropriate. (See § 1.14(b)).

(3) A nonprovisional application other than for a design patent may claim an invention disclosed in one or more prior filed copending provisional applications. [Since a provisional application can be pending for no more than twelve months, the last day of pendency may occur on a Saturday, Sunday, or Federal holiday within the District of Columbia which for copendency would require the nonprovisional application to be filed prior to the Saturday, Sunday, or Federal holiday.] In order for a nonprovisional application to claim the benefit of one or more prior filed copending provisional applications, each prior provisional application must name as an inventor at least one inventor named in the later filed nonprovisional application and disclose the named inventor's invention claimed in at least one claim of the later filed nonprovisional application in the manner provided by the first paragraph of 35 U.S.C. 112. In addition, each prior provisional application must be:

(i) Complete as set forth in § 1.51(a)(2); or

(ii) Entitled to a filing date as set forth in § 1.53(b)(2) and include the basic filing fee set forth in § 1.16(k).

(4) Any nonprovisional application claiming the benefit of one or more prior filed copending provisional applications must >, within two months of filing or within fourteen months of the filing date of the prior application, whichever is later,< contain or be amended to contain in the first sentence of the specification following the title a reference to each such prior provisional application, identifying it as a provisional application, and including the provisional application number (consisting of series code and serial number).

>(5) If a claim to the benefit of any prior filed copending nonprovisional application or international application designating the United States of America is presented in a nonprovisional application after the time period provided by paragraph (a)(2) of this section, or if a claim to the benefit of any prior filed copending provisional application is presented in a nonprovisional application other than for a design patent after the time period provided by paragraph (a)(4) of this section, the claim may be accepted in the application if the claim identifying the prior application by application number or international application number and international filing date is filed during the pendency of the application and the delay in stating the claim was unintentional. A petition to accept a delayed claim to the benefit of a prior filed copending application must be accompanied by:

(i) The surcharge set forth in § 1.17(u); and

(ii) A statement that the delay was unintentional. The statement must be a verified statement if made by a person not registered to practice before the Patent and Trademark Office. The Commissioner may require additional information where there is a question whether the delay was unintentional.

(6) The time periods set forth in paragraphs (a)(2), (4) and (5) of this section cannot be extended.<

* * * * *

(c) Where >an< [two or more] application [s,] >or a patent under reexamination< [or an application] and >an application or< a patent naming different inventors >are< [and] owned by the same party >and< contain conflicting claims, and there is no statement of record indicating that the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, the assignee may be called upon to state whether the claimed inventions were commonly owned or subject to an obligation of assignment to the same person at the time the later invention was made, and if not, indicate which named inventor is the prior inventor. In addition to making said statement, the assignee may also explain why an interference should or should not be declared.

(d) Where an application >or a patent under reexamination< claims an invention which is not patentably distinct from an invention claimed in a commonly owned patent with the same

or a different inventive entity, a double patenting rejection will be made in the application >or a patent under reexamination<. >A non-statutory< [An obviousness-type] double patenting rejection may be obviated by filing a terminal disclaimer in accordance with § 1.321(b).

27. Section 1.84 is proposed to be amended by revising paragraphs (c), (f)–(g), (j) and (x) to read as follows:

§ 1.84 Standards for drawings.

* * * * *

(c) *Identification of drawings.* Identifying indicia, if provided, should include the application number or the title of the invention, inventor's name, docket number (if any), and the name and telephone number of a person to call if the Office is unable to match the drawings to the proper application. This information should be placed on the back of each sheet of drawings a minimum distance of 1.5 cm. (⅝ inch) down from the top of the page. >In addition, a reference to the application number, or, if an application number has not been assigned, the inventor's name, may be included in the left-hand corner, provided that the reference appears within 1.5 cm. (9/16 inch) from the top of the sheet.<

* * * * *

(f) *Size of paper.* All drawing sheets in an application must be the same size. One of the shorter sides of the sheet is regarded as its top. The size of the sheets on which drawings are made must be:

[(1) 21.6 cm. by 35.6 cm. (8½ by 14 inches),

(2) 21.6 cm. by 33.1 cm. (8½ by 13 inches),

(3) 21.6 cm. by 27.9 cm. (8½ by 11 inches), or

(4)] >(1)< 21.0 cm. by 29.7 cm. (DIN size A4) >; or

(2) 21.6 cm. by 27.9 cm. (8½ by 11 inches)<.

(g) *Margins.* The sheets must not contain frames around the sight; i.e., the usable surface [.] >, but should have scan target points, i.e., cross-hairs, printed on two catercorner margin corners.< [The following margins are required:

(1) On 21.6 cm. by 35.6 cm. (8½ by 14 inches) drawing sheets, each sheet must include a top margin of 5.1 cm. (2 inches), and bottom and side margins of .64 cm. (¼ inch) from the edges, thereby leaving a sight no greater than 20.3 cm. by 29.8 cm. (8 by 11¾ inches).

(2) On 21.6 cm. by 33.1 cm. (8½ by 13 inches) drawing sheets, each sheet must include a top margin of 2.5 cm. (1 inch) and bottom and side margins of .64 cm. (¼ inch) from the edges, thereby leaving a sight no greater than 20.3 cm. by 29.8 cm. (8 by 11¾ inches).

(3) On 21.6 cm. by 27.9 cm. (8½ by 11 inch) drawing sheets, each sheet must include a top margin of 2.5 cm. (1 inch) and bottom and side margins of .64 cm. (¼ inch) from the edges, thereby leaving a sight no greater than 20.3 cm. by 24.8 cm. (8 by 9¾ inches).

(4) On 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, each] >Each< sheet must include a top margin of at least 2.5 cm. >(1 inch)<, a left side margin of >at least< 2.5 cm. >(1 inch)<, a right side margin of >at least< 1.5 cm. >(9/16 inch)<, and a bottom margin of >at least< 1.0 cm. >(⅜ inch)<, thereby leaving a sight no greater than 17.0 cm. by 26.2 cm >on 21.0 cm. by 29.7 cm. (DIN size A4) drawing sheets, and a sight no greater than 17.6 cm. by 24.4 cm. (6 15/16 by 9⅝ inches) on 21.6 cm. by 27.9 cm. (8½ by 11 inch) drawing sheets<.

* * * * *

(j) *View for Official Gazette.* One of the views should be suitable for publication in the Official Gazette >, the patent application notice, and the Gazette of Patent Application Notices< as the illustration of the invention.

* * * * *

(x) *Holes.* >No holes should be provided in the drawing sheets.< [The drawing sheets may be provided with two holes in the top margin. The holes should be equally spaced from the respective side edges, and their center lines should be spaced 7.0 cm. (2¾ inches) apart.]

(See § 1.152 for design drawings, § 1.165 for plant drawings, and § 1.174 for reissue drawings.)

28. Section 1.85 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.85 Corrections to drawings.

(a) The requirements of § 1.84 relating to drawings will be strictly enforced. A drawing not executed in conformity thereto, if suitable for >electronic< reproduction >by digital imaging< , may be admitted for examination but in such case a new drawing must be furnished.

* * * * *

29. Section 1.96 is proposed to be revised to read as follows:

§ 1.96 Submission of computer program listings.

>(a) General.< Descriptions of the operation and general content of computer program listings should appear in the description portion of the specification >.< A computer program listing for the purpose of >this section< [these rules] is defined as a printout that lists in appropriate sequence the instructions, routines, and other contents of a program for a computer. The program listing may be either in machine or machine-independent (object or source) language which will cause a computer to perform a desired procedure or task such as solve a problem, regulate the flow of work in a computer, or control or monitor events. Computer program listings may be submitted in patent applications >as set forth in paragraphs (b) and (c) of this section.< [in the following forms:]

>(b)< [(a)] *Material which will be printed in the patent.* If the computer program listing is contained on 10 printout pages or less, it must be submitted either as drawings or as part of the specification.

(1) *Drawings.* The listing may be submitted in the manner and complying with the requirements for drawings as provided in § 1.84. At least one figure numeral is required on each sheet of drawing.

(2) *Specification.* (i) The listing may be submitted as part of the specification in accordance with the provisions of § 1.52, at the end of the description but before the claims.

(ii) >Any< [The] listing [may be] submitted as part of the specification [in the form of computer printout sheets (commonly 14 by 11 inches in size) for use as ''camera ready copy'' when a patent is subsequently printed. Such computer printout sheets] must be original copies from the computer with dark solid black letters not less than 0.21 cm high, on white, unshaded and unlined paper, [the printing on each sheet must be limited to an area 9 inches high by 13 inches wide,] and the sheets should be submitted in a protective cover. [When printed in patents, such computer printout sheets will appear at the end of the description but before the claims and will usually be reduced about ½ in size with two printout sheets being printed as one patent specification page.] Any amendments must be made by way of submission of a substitute sheet >.< [if the copy is to be used for camera ready copy.]

>(c)< [(b)] *As an appendix which will not be printed.* If a computer program listing printout is 11 or more pages long, applicants >must< [may] submit such listing in the form of microfiche, referred to in the specification (see § 1.77 >(a)(7)< [(c)(2)]). Such microfiche filed with a patent application is to be referred to as a ''microfiche appendix.'' The ''microfiche appendix'' will not be part of the printed patent. Reference in the application to the ''microfiche appendix'' >must< [should] be made at the beginning of the specification at the

location indicated in § 1.77 >(a)(7)< [(c)(2)]. Any amendments thereto must be made by way of revised microfiche. [All computer program listings submitted on paper will be printed as part of the patent.]

(1) *Availability of appendix.* Such computer program listings on microfiche will be available to the public for inspection, and microfiche copies thereof will be available for purchase with the file wrapper and contents, after a patent based on such application is granted or the application is otherwise made publicly available.

(2) *Submission requirements.* >Except as modified or clarified below, computer-generated< [Computer-generated] information submitted as >a ''microfiche appendix''< [an appendix] to an application [for patent] shall be in [the form of microfiche in] accordance with the standards set forth in the following American National Standards Institute (ANSI) or National Micrographics Association (NMA) standards [(Note: As new editions of these standards are published, the latest shall apply)]:

ANSI PH 1.28–1976—Specifications for Photographic Film for Archival records, Silver-Gelatin Type, on Cellulose Ester Base.

ANSI PH 1.41–1976 Specifications for Photographic Film for Archival Records, Silver-Gelatin Type, on Polyester Base.

NMA-MSI (1971) Quality Standards for Computer Output Microfilm.

ANSI/NMA MS2 (1978) Format and Coding Standards for Computer Output Microfilm.

NMA MS5 (ANSI PH 5.9–1975) Microfiche of Documents.

ANSI PH 2.19 (1959)—Diffuse Transmission Density. [Except as modified or clarified below:]

(i) [Either] Computer-Output-Microfilm (COM) output [or copies of photographed paper copy] may be submitted >in accordance with either< [. In the former case,] NMA >standard< [standards] MS1 >or< [and] MS2 >.< [apply; in the latter case, standard MS5 applies.]

(ii) Film submitted shall be first generation (camera film) negative appearing microfiche (with emulsion on the back side of the film when viewed with the images right reading).

(iii) Reduction ratio of microfiche submitted should be 24:1 or a similar ratio where variation from said ratio is required in order to fit the documents into the image area of the microfiche format used.

(iv) Film submitted shall have a thickness of at least >0.13 mm (.005 inches)< [.005 inches (0.13 mm)] and not more than >0.23 mm (.009 inches)< [.009 inches (0.23 mm)] for either cellulose acetate base or polyester base type.

(v) Both microfiche formats A1 (98 frames, 14 columns x 7 rows) and A3 (63 frames, 9 columns x 7 rows) which are described in NMA standard MS2 (A1 is also described in MS5) are acceptable for use in preparation of microfiche submitted.

(vi) At least the left-most ⅓ (50 mm x 12 mm) of the header or title area of each microfiche submitted shall be clear or positive appearing so that the Patent and Trademark Office can apply >application< [serial] number and filing date thereto in an eye-readable form. The middle portion of the header shall be used by applicant to apply an eye-readable application identification such as the title and/or the first inventor's name. The attorney's docket number may be included. The final right-hand portion of the microfiche shall contain sequence in-formation for the microfiche, such as 1 of 4, 2 of 4, etc.

(vii) Additional requirements which apply specifically to microfiche of filmed paper copy:

(A) The first frame of each microfiche submitted shall contain a standard test target which contains five NBS Micro-copy Resolution Test Charts (No. 1010A), one in the center and one in each corner. See illustration on page 2 of NMA Recommended Practice MS104, Inspection and Quality Control of First Generation Silver Halide Microfilm. See also paragraph 7 of NMA-MS5.

(B) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(C) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(D) Pagination of the microfiche frames shall be from left to right and from top to bottom.

(E) At a reduction of 24:1 resolution of the original microfilm shall be at least 120 lines per mm (5.0 target) so that reproduction copies may be expected to comply with provisions of paragraph 7.1.4 of NMA Standard MS5.

(F) Background density of negative appearing camera master microfiche of filmed paper documents shall be within the range of 0.9 to 1.2 and line density should be no greater than 0.08. The density shall be visual diffuse density as measured using the method described in ANSI Standard PH 2.19.

(G) An index, when included, should appear in the last frame (lower right hand corner when data is right-reading) of each microfiche. See NMA-MS5, paragraph 6.6.

(viii) Microfiche generated by Computer Output Microfilm (COM).

(A) Background density of negative-appearing COM-generated camera master microfiche shall be within the range of 1.5 to 2.0 and line density should be no greater than 0.2. The density shall be visual diffuse density as described in ANSI PH2.19.

(B) The first frame of each microfiche submitted should contain a resolution test frame in conformance with NMA standard MS1.

(C) The second frame of each microfiche submitted must contain a fully descriptive title and the inventor's name as filed.

(D) The pages or lines appearing on the microfiche frames should be consecutively numbered.

(E) It is preferred that pagination of the microfiche frames be from left to right and top to bottom but the alternative, i.e., from top to bottom and from left to right, is also acceptable.

(F) An index, when included, should appear on the last frame (lower right hand corner when data is right reading) of each microfiche.

(G) Amendment of microfiche must be made by way of replacement microfiche.

30. Section 1.97 is proposed to be amended by revising paragraphs (a)–(d) to read as follows:

§ 1.97 Filing of an information disclosure statement.

(a) In order >for an applicant for patent or for reissue of a patent, or an owner of a patent under reexamination< to have information considered by the Office during the pendency of a patent application, an information disclosure statement in compliance with § 1.98 should be filed in accordance with this section.

(b) An information disclosure statement shall be considered by the Office if filed >by the applicant or patent owner<:

(1) Within three months of the filing date of a national application;

(2) Within three months of the date of entry of the national stage as set forth in § 1.491 in an international application; or

(3) Before the mailing date of a first Office action on the merits, whichever event occurs last.

(c) An information disclosure statement shall be considered by the Office if filed >by the applicant or patent owner< after the period specified in paragraph (b) of this section, but before the mailing date of either:

(1) A final action under § 1.113; or

(2) A notice of allowance under § 1.311, whichever occurs first, provided the statement is accompanied

by either a certification as specified in paragraph >(e)< [(3)] of this section or the fee set forth in § 1.17(p).

(d) An information disclosure statement shall be considered by the Office if filed >by the applicant or patent owner< after the mailing date of either:

(1) A final action under § 1.113; or

(2) A notice of allowance under § 1.311, whichever occurs first, but before payment of the issue fee, provided the statement is accompanied by:

(i) A certification as specified in paragraph (e) of this section;

(ii) A petition requesting consideration of the information disclosure statement; and

(iii) The petition fee set forth in § 1.17(i).

* * * * *

31. Section 1.98 is proposed to be amended by revising paragraphs (a)–(b) to read as follows:

§ 1.98 Content of information disclosure statement.

(a) Any information disclosure statement filed under § 1.97 shall include:

(1) list of all patents, publications or other information submitted for consideration by the Office;

(2) A legible copy of:

(i) Each U.S. >patent application notice, technical contents publication and U.S.< and foreign patent;

(ii) Each publication or that portion which caused it to be listed; and

(iii) All other information or that portion which caused it to be listed, except that no copy of >an unpublished< [a] U.S. patent application need be included; and

(3) A concise explanation of the relevance, as it is presently understood by the individual designated in § 1.56(c) most knowledgeable about the content of the information, of each patent, publication, or other information listed that is not in the English language. The concise explanation may be either separate from the specification or incorporated therein.

(b) Each U.S. patent listed in an information disclosure statement shall be identified by patentee, patent number and issue date. >Each U.S. patent application notice or technical contents publication listed in an information disclosure statement shall be identified by applicant, patent application notice number or technical contents publication number and publication date.< Each foreign patent or published foreign patent application shall be identified by the country or patent office which issued the patent or published the application, an appropriate document number, and the publication date indicated on the patent or published application. Each publication shall be identified by author (if any), title, relevant pages of the publication, date, and place of publication.

* * * * *

32. Section 1.107 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.107 Citation of references.

(a) If domestic patents are cited by the examiner, their numbers and dates, and the names of the patentees [, and the classes of inventions] must be stated. >If domestic published applications are cited by the examiner, their technical contents publication number, publication date, and the names of the applicants must be stated.< If foreign published applications or patents are cited, their nationality or country, numbers and dates, and the names of the patentees must be stated, and such other data must be furnished as may be necessary to enable the applicant, or in the case of a reexamination proceeding, the patent owner, to identify the published applications or patents cited. In citing foreign published applications or patents, in case only a part of the document is involved, the particular pages and sheets containing the parts relied upon must be identified. If printed publications are cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given.

* * * * *

33. Section 1.108 is proposed to be revised to read as follows:

§ 1.108 Abandoned applications not cited.

Abandoned applications as such will not be cited as references >,< except those which >are published applications or< have been opened to inspection by the public following a defensive publication.

34. Section 1.131 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.131 Affidavit or declaration of prior invention to overcome cited patent or publication.

(a)(1) When any claim of an application or a patent under reexamination is rejected under 35 U.S.C. 102(a) or (e), or 35 U.S.C. 103 based on a U.S. patent >or pending or patented published application< to another which is prior art under 35 U.S.C. 102 (a) or (e) and which substantially shows or describes but does not claim the same patentable invention, as defined in § 1.601(n), or on reference to a foreign patent >, an abandoned U.S. published application,< or to a printed publication, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to overcome the patent >, published application< or publication. The oath or declaration must include facts showing a completion of the invention in this country or in a NAFTA or WTO member country before the filing date of the >U.S. published application or the< application on which the U.S. patent issued, or before the date of the foreign patent, or before the date of the printed publication. When an appropriate oath or declaration is made, the patent >, published application< or publication cited shall not bar the grant of a patent to the inventor or the confirmation of the patentability of the claims of the patent, unless the date of such patent >, published application< or publication is more than one year prior to the date on which the inventor's or patent owner's application was filed in this country.

(2) A date of completion of the invention may not be established under this section before December 8, 1993, in a NAFTA country, or before January 1, 1996, in a WTO member country other than a NAFTA country.

>(3) Notwithstanding the provisions of paragraph (a)(1) of this section, a showing may be made under this section where the inventions defined by a claim in an application or a patent under reexamination and by a claim in U.S. patent or pending or patented published application are not identical as set forth in 35 U.S.C. 102, and where the inventions are owned by the same party, unless the date of such patent or published application is more than one year prior to the date on which the inventor's or patent owner's application was filed in this country.<

* * * * *

35. Section 1.132 is proposed to be revised to read as follows:

§ 1.132 Affidavits or declarations traversing grounds of rejection.

When any claim of an application or a patent under reexamination is rejected on reference to a [domestic] >U.S.< patent >or pending U.S. published application< which substantially shows or describes but does not claim the invention, or on reference to a foreign patent, >an abandoned U.S. published application,< or to a printed publication, or to facts within the personal knowledge of an employee of the Office, or when rejected upon a

mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative or lacking in utility, or frivolous or injurious to public health or morals, affidavits or declarations traversing these references or objections may be received.

36. Section 1.136 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.136 Filing of timely responses with petition and fee for extension of time and extensions of time for cause.

(a)(1) If an applicant is required to respond within a nonstatutory or shortened statutory time period, applicant may respond up to four months after the time period set if a petition for an extension of time and the fee set in § 1.17 are filed prior to or with the response, unless:

(i) Applicant is notified otherwise in an Office action;

(ii) >The response is to a requirement for an English translation, an abstract or claims on a separate sheet, or substitute specification or sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction submitted pursuant to §§ 1.52(d), 1.53(d), 1.60(d), 1.62(d), 1.494(c) or 1.495(c), or an oath or declaration submitted pursuant to §§ 1.494(c) or 1.495(c);

(iii)< The response is a reply brief submitted pursuant to § 1.193(b);

>(iv)< [(iii)] The response is a request for an oral hearing submitted pursuant to § 1.194(b);

>(v)< [(iv)] The response is to a decision by the Board of Patent Appeals and Interferences pursuant to § 1.196, § 1.197 or § 1.304; or

>(vi)< [(v)] The application is involved in an interference declared pursuant to § 1.611.

(2) The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for purposes of determining the period of extension and the corresponding amount of the fee. The expiration of the time period is determined by the amount of the fee paid. In no case may an applicant respond later than the maximum time period set by statute, or be granted an extension of time under paragraph (b) of this section when the provisions of this paragraph are available. See § 1.136(b) for extensions of time relating to >the filing of an English translation pursuant to §§ 1.52(d), 1.494(c) or 1.495(c), the filing of an abstract or claims on a separate sheet, substitute specification or sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction pursuant to §§ 1.53(d), 1.60(d), 1.62(d), 1.494(c), or 1.495(c), the filing of an oath or declaration pursuant to §§ 1.494(c) or 1.495(c), or< proceedings pursuant to §§ 1.193(b), 1.194, 1.196 or 1.197. See § 1.304 for extension of time to appeal to the U.S. Court of Appeals for the Federal Circuit or to commence a civil action. See § 1.550(c) for extension of time in reexamination proceedings and § 1.645 for extension of time in interference proceedings.

37. Section 1.138 is proposed to be revised to read as follows:

§ 1.138 Express abandonment.

An application may be expressly abandoned by filing in the Patent and Trademark Office a written declaration of abandonment signed by the applicant and the assignee of record, if any, and identifying the application. An application may also be expressly abandoned by filing a written declaration of abandonment signed by the attorney or agent of record. A registered attorney or agent acting under the provision of § 1.34(a), or of record, may also expressly abandon a prior application as of the filing date granted to a continuing application when filing such a continuing application. Express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue >or publication. An applicant seeking to abandon an application to avoid publication of the application must submit a proper letter of express abandonment more than two months prior to the projected date of publication to allow sufficient time to permit the appropriate officials to recognize the abandonment and remove the application from the publication process, and unless an applicant receives written acknowledgement of the letter of express abandonment prior to the projected date of publication, applicant should expect that the application will be published in regular course<.

38. Section 1.154 is proposed to be revised to read as follows:

§ 1.154 Arrangement of specification.

>(a) The elements of the design application, if applicable, should appear in the following order< [The following order of arrangement should be observed in framing design specifications]:

>(1) Design Application Transmittal Form.

(2) Fee Transmittal Form.

(3)< [(a)] Preamble, stating name of the applicant and title of the design.

>(4) Cross-reference to related applications.

(5) Statement regarding federally sponsored research or development.<

>(6)< [(b)] Description of the figure or figures of the drawing.

>(7)< [(c)] Description [, if any].

>(8)< [(d)] Claim.

>(9) Drawings or photographs

(10)< [(e)] Executed oath or declaration (See § 1.153(b)).

(b) [Reserved]

39. Section 1.163 is proposed to be amended by adding new paragraphs (c) and (d) to read as follows:

§ 1.163 Specification.

* * * * *

>(c) The elements of the plant application, if applicable, should appear in the following order:

(1) Plant Application Transmittal Form.

(2) Fee Transmittal Form.

(3) Abstract of the disclosure.

(4) Title of the invention.

(5) Cross-reference to related applications.

(6) Statement regarding federally sponsored research or development.

(7) Background of the invention.

(8) Brief summary of the invention.

(9) Brief description of the drawing.

(10) Detailed Botanical Description.

(11) Claim.

(12) Drawings (in duplicate).

(13) Executed oath or declaration.

(14) Plant color coding sheet.

(d) A plant color coding sheet as used in this section means a sheet that specifies a color coding system as designated in a recognized color dictionary, and lists every plant structure to which color is a distinguishing feature and the corresponding color code which best represents that plant structure.<

40. Section 1.291 is proposed to be amended by revising paragraphs (a)–(b) to read as follows:

§ 1.291 Protests by the public against pending applications.

(a) Protests by a member of the public against pending applications will be referred to the examiner having charge of the subject matter involved. A protest specifically identifying the application to which the protest is directed will be entered in the application file if:

(1) The protest is [timely] submitted >:

(i) prior to the date the application was published or the mailing of a notice of allowance under § 1.311, whichever occurs first; or

(ii) within two months of the date the application was published or prior to

the mailing of a notice of allowance under § 1.311, whichever occurs first, if accompanied by the fee set forth in § 1.17(t)<; and

(2) The protest is either served upon the applicant in accordance with § 1.248, or >, if submitted prior to the date the application was published,< filed with the Office in duplicate in the event service is not possible.

[Protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues. Protests which do not adequately identify a pending patent application will be disposed of and will not be considered by the Office.]

(b) >Protests raising fraud or other inequitable conduct issues will be entered in the application file, generally without comment on those issues. Protests which do not adequately identify a pending patent application will be disposed of and will not be considered by the Office.< A protest submitted in accordance with the second sentence of paragraph (a) of this section will be considered by the Office if >the application is still pending when the protest and application file are brought before the examiner and< it includes:

(1) A listing of the patents, publications, or other information relied upon;

(2) A concise explanation of the relevance of each listed item;

(3) A copy of each listed patent or publication or other item of information in written form or at least the pertinent portions thereof; and

(4) An English language translation of all the necessary and pertinent parts of any non-English language patent, publication, or other item of information in written form relied upon.

* * * * *

41. Section 1.292 is proposed to be amended by revising paragraphs (a)–(b) to read as follows:

§ 1.292 Public use proceedings.

(a) When a petition for the institution of public use proceedings, supported by affidavits or declarations [and the fee set forth in § 1.17(j), is filed by one having information of the pendency of an application and] is found, on reference to the examiner, to make a *prima facie* showing that the invention claimed in an application believed to be on file had been in public use or on sale more than one year before the filing of the application, a hearing may be had before the Commissioner to determine whether a public use proceeding should be instituted. If instituted, the Commissioner may designate an appropriate official to conduct the public use proceeding, including the setting of times for taking testimony, which shall be taken as provided by §§ 1.671 through 1.685. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.

(b) The petition and accompanying papers [should either: (1) Reflect that a copy of the same has been served upon the applicant or upon his attorney or agent of record; or (2) be filed with the Office in duplicate in the event service is not possible. The petition and accompanying papers], or a notice that such a petition has been filed, shall be entered in the application file [.] >if:

(1) The petition is accompanied by the fee set forth in § 1.17(j);

(2) The petition is served on the applicant in accordance with § 1.248, or, if submitted prior to the date the application was published, filed with the Office in duplicate in the event service is not possible; and

(3) The petition is submitted within two months of the date the application was published or prior to the mailing of a notice of allowance under § 1.311, whichever occurs first.<

* * * *

42. A new, undesignated center heading and new sections 1.305 through 1.308 are proposed to be added to Subpart B-National Processing Provisions to read as follows:

>Publication of Applications

§ 1.305 Withdrawal from publication.

Applications may be withdrawn from publication at the initiative of the Office or upon request by the applicant. An application will not be withdrawn from publication for any reason except:

(a) A mistake on the part of the Office;

(b) The application is either national security classified (see § 5.9(b)) or subject to a secrecy order pursuant to 35 U.S.C. 181; or

(c) Express abandonment of the application pursuant to § 1.138.

§ 1.306 Publication of application.

(a) A U.S. national application for patent which was either filed in the Office under 35 U.S.C. 111(a) or which resulted from an international application after compliance with 35 U.S.C. 371, or an application filed in the Office under 35 U.S.C. 161 will be published as soon as possible after the expiration of a period of 18 months from the filing date, including the earliest filing date for which a benefit is sought, unless:

(1) The application is national security classified (see § 5.9(b)) or subject to a secrecy order pursuant to 35 U.S.C. 181;

(2) The application has issued as a patent;

(3) The application is recognized by the Office as no longer pending; or

(4) The application was previously published pursuant to paragraph (d) of this section.

(b) The publication of an application shall consist of:

(1) A notice designated as a ''Gazette Entry'' containing information such as the application number, filing date, title, inventor's name, abstract, a drawing figure (if appropriate), a representative claim, and U.S. and International Patent Classification (IPC) classification(s) in a Gazette of Patent Application Notices;

(2) A printed publication designated as a ''patent application notice'' containing information such as the application number, filing date, title, inventor's name, correspondence address, abstract, a drawing figure (if appropriate), a representative claim, and U.S. and International Patent Classification (IPC) classification(s);

(3) A document designated as a ''technical contents publication'' containing the patent application notice and the specification, abstract, claim(s), and drawing(s); and

(4) Public access to a copy of the specification, drawings, and all papers relating to the application file in accordance with § 1.11(a).

(c) Provisional applications filed in the Office under 35 U.S.C. 111(b) shall not be published, and design applications filed in the Office under 35 U.S.C. 171 and reissue applications filed in the Office under 35 U.S.C. 251 shall not be published pursuant to this section.

(d) Applications that will be published pursuant to paragraph (a) of this section may be published earlier than as set forth in paragraph (a) of this section upon petition by the applicant. Any petition requesting early publication of an application must be accompanied by the fee set forth in § 1.17(i) and filed as soon as possible. No consideration will be given to requests for early publication in an application lacking an abstract or claims on a separate sheet, any English translation required pursuant to § 1.52(d), or substitute specification or drawings required pursuant to §§ 1.53(d), 1.60(d), or 1.62(d). No consideration will be given to requests for publication on a certain date, and such requests will be treated as a request for publication as soon as possible.

(e) An applicant who is an independent inventor and has been

accorded status under 35 U.S.C. 41(h) in an application that will be published pursuant to paragraph (a) of this section and does not claim the benefit of an earlier filing date under 35 U.S.C. 119, 120, 121, 365(a) or 365(c) may request that the application not be published until three months after an action on the merits. A petition requesting that the application not be published until three months after an action on the merits must be submitted with the filing of the application and be accompanied by:

(1) The petition fee set forth in § 1.17(i); and

(2) A certification that the invention disclosed in the application was not or will not be the subject of an application filed in a foreign country. The certification must be verified if made by a person not registered to practice before the Patent and Trademark Office.

§ 1.307 Delivery of the printed publication.

The patent application notice will be delivered or mailed on the day of its publication to the correspondence address of record. See § 1.33(a).

§ 1.308 Correction of the printed publication.

A request for a certificate of correction for the patent application notice will only be granted when the Office makes a significant mistake which is apparent from Office records.<

43. Section 1.315 is proposed to be revised to read as follows:

§ 1.315 Delivery of patent.

The patent will be delivered or mailed >upon issuance< [on the day of its date] to >the correspondence address of record. See § 1.33(a).< [the attorney or agent of record, if there be one; or if the attorney or agent so requests, to the patentee or assignee of an interest therein; or, if there be no attorney or agent, to the patentee or to the assignee of the entire interest, if he so requests.]

44. Section 1.321 is proposed to be amended by revising paragraph (c) to read as follows:

§ 1.321 Statutory disclaimers, including terminal disclaimers.

* * * * *

(c) A terminal disclaimer, when filed to obviate a >non-statutory< double patenting rejection in a patent application or in a reexamination proceeding, must:

(1) Comply with the provisions of paragraphs (b)(2) through (b)(4) of this section;

(2) Be signed in accordance with paragraph (b)(1) of this section if filed in a patent application or in accordance with paragraph (a)(1) of this section if filed in a reexamination proceeding; and

(3) Include a provision that any patent granted on that application or any patent subject to the reexamination proceeding shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection.

45. Section 1.492 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.492 National stage fees.

* * * * *

(a) The basic national fee:

(1) Where an international preliminary examination fee as set forth in § 1.482 has been paid on the international application to the United States Patent and Trademark Office:

By a small entity (§ 1.9(f))—>$355.00< [$330.00]

By other than a small entity—>710.00< [660.00]

(2) Where no international preliminary examination fee as set forth in § 1.482 has been paid to the United States Patent and Trademark Office, but an international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office as an International Searching Authority:

By a small entity (§ 1.9(f))—>390.00< [365.00]

By other than a small entity—>780.00< [730.00]

(3) Where no international preliminary examination fee as set forth in § 1.482 has been paid and no international search fee as set forth in § 1.445(a)(2) has been paid on the international application to the United States Patent and Trademark Office:

By a small entity (§ 1.9(f))—>520.00< [490.00]

By other than a small entity—>1040.00< [980.00]

(4) Where the international preliminary examination fee as set forth in § 1.482 has been paid to the United States Patent and Trademark Office and the international preliminary examination report states that the criteria of novelty, inventive step (non-obviousness), and industrial applicability, as defined in PCT Article 33(1) to (4) have been satisfied for all the claims presented in the application entering the national stage (see § 1.496(b)):

By a small entity (§ 1.9(f))—>60.00< [46.00]

By other than a small entity—>120.00< [92.00]

(5) Where a search report on the international application has been prepared by the European Patent Office or the Japanese Patent Office:

By a small entity (§ 1.9(f))—>455.00< [425.00]

By other than a small entity—>910.00< [850.00]

* * * * *

46. Section 1.494 is proposed to be amended by revising paragraphs (c) and (g) to read as follows:

§ 1.494 Entering the national stage in the United States of America as a Designated Office.

* * * * *

(c) If applicant complies with paragraph (b) of this section before expiration of 20 months from the priority date but omits:

(1) A translation of the international application, as filed, into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) >;< [and/or]

(2) The oath or declaration of the inventor (35 U.S.C. 371(c)(4); see § 1.497);

>(3) An abstract or claims on a separate sheet (see §§ 1.72(b) and 1.75(h));

(4) Papers typed on but one side of the paper (see § 1.52(b)); and/or

(5) Application papers or sheets of drawings of sufficient clarity, contrast, and quality, and in the proper size and format for electronic reproduction (see §§ 1.52(a) and (b) and 1.85(a)),< applicant will be so notified and given a period of time within which to file the >English< translation >,< [and/or] oath or declaration >, abstract or claims on a separate sheet, and a substitute specification in compliance with § 1.125 with papers typed on but one side of the paper and sheets of drawings, each of the substitute specification and sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction< in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 20 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of 20 months after the priority date. >The period for filing the English translation, oath or declaration, an abstract and claims on a separate sheet, and a substitute specification and sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction cannot be extended pursuant to § 1.136(a).< A copy of the notification mailed to

applicant should accompany any response thereto submitted to the Office.

* * * * *

(g) An international application becomes abandoned as to the United States 20 months from the priority date if the requirements of paragraph (b) of this section have not been complied with within 20 months from the priority date where the United States has been designated but not elected by the expiration of 19 months from the priority date. If the requirements of paragraph (b) of this section are complied with within 20 months from the priority date but any required translation of the international application as filed >,< [and/or] the oath or declaration >,abstract or claims on a separate sheet, and/or substitute specification in compliance with § 1.125 with papers typed on but one side of the paper and sheets of drawings, each of the substitute specification and sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction< are not timely filed, an international application will become abandoned as to the United States upon expiration of the time period set pursuant to paragraph (c) of this section.

47. Section 1.495 is proposed to be amended by revising paragraphs (c) and (h) to read as follows:

§ 1.495 Entering the national stage in the United States of America as an Elected Office.

* * * * *

(c) If applicant complies with paragraph (b) of this section before expiration of 30 months from the priority date but omits:

(1) A translation of the international application, as filed, into the English language, if it was originally filed in another language (35 U.S.C. 371(c)(2)) >;< [and/or]

(2) The oath or declaration of the inventor (35 U.S.C. 371(c)(4); see § 1.497);

>(3) An abstract or claims on a separate sheet (see §§ 1.72(b) and 1.75(h));

(4) Papers typed on but one side of the paper (see § 1.52(b)); and/or

(5) Application papers or sheets of drawings of sufficient clarity, contrast, and quality, and in the proper size and format for electronic reproduction (see §§ 1.52(a) and (b) and 1.85(a)),< applicant will be so notified and given a period of time within which to file the >English< translation >,< [and/or] oath or declaration >, abstract or claims on a separate sheet, and a substitute specification in compliance with § 1.125 with papers typed on but one side of the paper and sheets of drawings, each of the substitute specification and sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction< in order to prevent abandonment of the application. The payment of the processing fee set forth in § 1.492(f) is required for acceptance of an English translation later than the expiration of 30 months after the priority date. The payment of the surcharge set forth in § 1.492(e) is required for acceptance of the oath or declaration of the inventor later than the expiration of 30 months after the priority date. >The period for filing the English translation, oath or declaration, an abstract and claims on a separate sheet, and a substitute specification and sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction cannot be extended pursuant to § 1.136(a).< A copy of the notification mailed to applicant should accompany any response thereto submitted to the Office.

* * * * *

(h) An international application becomes abandoned as to the United States 30 months from the priority date if the requirements of paragraph (b) of this section have not been complied with within 30 months from the priority date where the United States has been elected by the expiration of 19 months from the priority date. If the requirements of paragraph (b) of this section are complied with within 30 months from the priority date but any required translation of the international application as filed >,< [and/or] the oath or declaration >,abstract or claims on a separate sheet, and/or a substitute specification in compliance with § 1.125 with papers typed on but one side of the paper and sheets of drawings, each of the substitute specification and sheets of drawings of sufficient clarity, contrast, and quality and in the proper size and format for electronic reproduction< are not timely filed, an international application will become abandoned as to the United States upon expiration of the time period set pursuant to paragraph (c) of this section.

48. Section 1.497 is proposed to be revised to read as follows:

§ 1.497 Oath or declaration under 35 U.S.C. 371(c)(4).

(a) When an applicant of an international application [, if the inventor,] desires to enter the national stage under 35 U.S.C. 371 pursuant to §§ 1.494 or 1.495, he or she must file an oath or declaration >that:

(1) Is executed in accordance with either §§ 1.66 or 1.68;

(2) Identifies the specification to which it is directed;

(3) Identifies each inventor and the country of citizenship of each inventor; and

(4) States that the person making the oath or declaration believes the named inventor or inventors to be the original and first inventor or inventors of the subject matter which is claimed and for which a patent is sought.< [in accordance with § 1.63.]

(b) >(1) The oath or declaration must be made by all of the actual inventors except as provided for in §§ 1.42, 1.43 or 1.47.

(2)< If the >person making the oath or declaration is not the inventor (§§ 1.42, 1.43 or 1.47),< [international application was made as provided in §§ 1.422, 1.423 or 1.425,] the >oath or declaration shall state the relationship of the person< [applicant shall state his or her relationship] to the inventor and, upon information and belief, the facts which the inventor is required [by § 1.63] to state.

>(c) The oath or declaration must comply with the requirements of § 1.63; however, if the oath or declaration meets the requirements of paragraphs (a) and (b) of this section, the oath or declaration will be accepted as complying with 35 U.S.C. 371(c)(4) and §§ 1.494(c) or 1.495(c). If the oath or declaration does not meet the requirements of § 1.63, a supplemental oath or declaration in compliance with § 1.63 will be required in accordance with § 1.67.<

49. Section 1.701 is proposed to be revised as follows:

§ 1.701 Extension of patent term due to prosecution delay.

(a) A patent, other than for designs, issued on an application filed on or after June 8, 1995, is >, subject to the provisions of this section,< entitled to extension of the patent term if the issuance of the patent was delayed due to:

(1) Interference proceedings under 35 U.S.C. 135(a); and/or

(2) The application being placed under a secrecy order under 35 U.S.C. 181; and/or

(3) Appellate review by the Board of Patent Appeals and Interferences or by a Federal court under 35 U.S.C. 141 or 145, if the patent was issued pursuant to a decision reversing an adverse determination of patentability >; and/or< [and if the patent is not subject to a terminal disclaimer due to the issuance of another patent claiming subject matter that is not patentably distinct from that under appellate review.]

>(4) An unusual administrative delay by the Office.

(i) Circumstances constituting an unusual administrative delay by the Office include the failure to:

(A) Act on a reply under § 1.111 or appeal brief under § 1.192 within six months of the date it was filed;

(B) Act on an application within six months of the date of a decision under § 1.196 by the Board of Patent Appeals and Interferences where claims stand allowed in an application or the nature of the decision requires further action by the examiner (§ 1.197); and

(C) Issue a patent within six months of the date that the issue fee was paid or all outstanding requirements were satisfied, whichever is later.<

(ii) [Reserved]

(b) The term of a patent entitled to extension under paragraph (a) of this section shall be extended for the sum of the periods of delay calculated under paragraphs (c)(1), (c)(2), (c)(3) >, (c)(4)< and (d) of this section, to the extent that these periods are not overlapping, up to a maximum of >ten< [five] years. The extension will run from the expiration date of the patent.

(c)(1) The period of delay under paragraph (a)(1) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) With respect to each interference in which the application was involved, the number of days, if any, in the period beginning on the date the interference was declared or redeclared to involve the application in the interference and ending on the date that the interference was terminated with respect to the application; and

(ii) The number of days, if any, in the period beginning on the date prosecution in the application was suspended by the Patent and Trademark Office due to interference proceedings under 35 U.S.C. 135(a) not involving the application and ending on the date of the termination of the suspension.

(2) The period of delay under paragraph (a)(2) of this section for an application is the sum of the following periods, to the extent that the periods are not overlapping:

(i) The number of days, if any, the application was maintained in a sealed condition under 35 U.S.C. 181;

(ii) The number of days, if any, in the period beginning on the date of mailing of an examiner's answer under § 1.193 in the application under secrecy order and ending on the date the secrecy order and any renewal thereof was removed;

(iii) The number of days, if any, in the period beginning on the date applicant was notified that an interference would be declared but for the secrecy order and ending on the date the secrecy order and any renewal thereof was removed; and

(iv) The number of days, if any, in the period beginning on the date of notification under § 5.3(c) >of this chapter< and ending on the date of mailing of the notice of allowance under § 1.311.

(3) The period of delay under paragraph (a)(3) of this section is the sum of the number of days, if any, in the period beginning on the date on which an appeal to the Board of Patent Appeals and Interferences was filed under 35 U.S.C. 134 and ending on the date of a final decision in favor of the applicant by the Board of Patent Appeals and Interferences or by a Federal court in an appeal under 35 U.S.C. 141 or a civil action under 35 U.S.C. 145.

>(4) The period of delay under paragraph (a)(4) of this section is the sum of the number of days, if any, in the period of unusual delay by the Office.<

(d) The period [of delay] set forth in paragraph (c)[(3)] shall be reduced by >any time during the processing or examination of the application, as determined by the Commissioner, during which the applicant for patent failed to engage in reasonable efforts to conclude processing or examination of the application. In determining whether an applicant failed to engage in reasonable efforts to conclude processing or examination of the application, the Commissioner may examine the facts and circumstances of the applicant's actions during the entire prosecution of the application to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, an applicant for patent seeking to conclude the processing or examination of the application. Circumstances constituting a failure to engage in reasonable efforts to conclude processing or examination of the application include:

(1) Requesting suspension of action under § 1.103; and

(2) Abandonment of the application.<

[:

(1) any time during the period of appellate review that occurred before three years from the filing date of the first national application for patent presented for examination; and

(2) any time during the period of appellate review, as determined by the Commissioner, during which the applicant for patent did not act with due diligence. In determining the due diligence of an applicant, the Commissioner may examine the facts and circumstances of the applicant's actions during the period of appellate review to determine whether the applicant exhibited that degree of timeliness as may reasonably be expected from, and which is ordinarily exercised by, a person during a period of appellate review.]

>(e) No patent term shall be extended under this section:

(1) Beyond the expiration date specified in a terminal disclaimer in a patent whose term has been disclaimed in such terminal disclaimer; or

(2) In a patent issued before the expiration of three years after the filing date of the application or entry of the application into the national stage under 35 U.S.C. 371, whichever is later, not taking into account any claim to the benefit of the filing date of any application under 35 U.S.C. 120, 121, 365(c).

(f) Any extension of patent term under paragraph (a)(4) of this section on the basis of an administrative delay other than one specifically set forth in paragraphs (a)(4)(i)(A) through (C) of this section must be requested by petition. A petition for an extension of patent term based upon unusual administrative delay by the Office other than one specifically set forth in paragraphs (a)(4)(i)(A) through (C) of this section cannot be filed prior to the mailing of a notice of allowance under § 1.311 and must be accompanied by:

(1) A statement of the facts involved, the administrative delay by the Office to be reviewed, and the period of extension requested; and

(2) The fee set forth in § 1.17(i). The petition may include a request that the petition fee be refunded if an extension of the patent term under paragraph (a)(4) of this section is granted.<

50. Section 1.808 is proposed to be amended by revising paragraph (a) to read as follows:

§ 1.808 Furnishing of samples.

(a) A deposit must be made under conditions that assure that:

(1) Access to the deposit will be available during pendency of the patent application making reference to the deposit to one determined by the Commissioner to be entitled thereto under § 1.14 and 35 U.S.C. 122>(a)<, and

(2) Subject to paragraph (b) of this section, all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the >publication of the application under § 1.306 or< granting of the patent.

* * * * *

PART 3—ASSIGNMENT, RECORDING AND RIGHTS OF ASSIGNEE

51. The authority citation for 37 CFR part 3 would continue to read as follows:

Authority: 15 U.S.C. 1123; 35 U.S.C. 6.

52. Section 3.31 is proposed to be amended by redesignating paragraph (b) as paragraph (c) and adding a new paragraph (b) to read as follows:

§ 3.31 Cover sheet content.

* * * * *

(b) >For a patent application, the cover sheet may include an indication that the assignment information is to be printed on the patent application notice. If the assignment and cover sheet containing the above-mentioned indication is not submitted within two months of filing or fourteen months from the earliest filing date for which a benefit is claimed, whichever is later, the assignment information may not be printed on the patent application notice.<

* * * * *

PART 5—SECRECY OF CERTAIN INVENTIONS AND LICENSES TO EXPORT AND FILE APPLICATIONS IN FOREIGN COUNTRIES

53. The authority citation for 37 CFR part 5 would continue to read as follows:

Authority: 35 U.S.C. 6, 41, 181–188, as amended by the Patent Law Foreign Filing Amendments Act of 1988, Pub. L. 100–418, 102 Stat. 1567; the Arms Export Control Act, as amended, 22 U.S.C. 2751 et seq.; the Atomic Energy Act of 1954, as amended, 42 U.S.C. 2011 et seq.; and the Nuclear Non-Proliferation Act of 1978, 22 U.S.C. 3201 et seq.; and the delegations in the regulations under these Acts to the Commissioner (15 CFR 370.10(j), 22 CFR 125.04, and 10 CFR 810.7).

54. Section 5.1 is proposed to be amended by adding new paragraphs (c) and (d) to read as follows:

§ 5.1 Defense inspection of certain applications.

* * * * *

>(c) Defense agency inspection must be promptly completed to enable those applications due for publication under § 1.306 of this chapter to be published in regular course. Applications under defense agency review will be released for publication six months from the actual U.S. filing date or three months from the date the application was made available to a defense agency under paragraph (b) of this section, whichever is later.

(d) Applications on inventions not made in the United States and on inventions in which the U.S. Government has a property interest will not be made available to defense agencies under § 5.2(b).<

55. A new § 5.9 is proposed to be added under the undesignated center heading ''Secrecy Orders'' to read as follows:

>**§ 5.9 National security classified applications.**

(a) Patent applications and papers relating thereto that are national security classified and contain authorized national security markings of ''Confidential,'' ''Secret'' or ''Top Secret,'' as appropriate, are accepted by the Office. National security classified documents mailed to the Office must be addressed in compliance with § 5.33. National security classified documents may be hand-carried to Licensing and Review.

(b) A national security classified patent application will not be published pursuant to § 1.306 of this chapter or allowed pursuant to § 1.311 of this chapter until the application is declassified.

(c) The applicant in a national security classified patent application must obtain a secrecy order pursuant to § 5.2. In a national security classified patent application filed without a notification pursuant to § 5.2(a), the Office will set a time period within which the application must be declassified, a secrecy order pursuant to § 5.2 must be obtained, or evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2 from the relevant department or agency must be presented in order to prevent abandonment of the application.

(d) Where evidence of a good faith effort to obtain a secrecy order pursuant to § 5.2 from the relevant department or agency is presented within the time period set by the Office, but the application has not been declassified and a secrecy order pursuant to § 5.2 has not been obtained, the Office will again set a time period within which the application must be declassified, a secrecy order pursuant to § 5.2 must be obtained, or evidence of a good faith effort to again obtain a secrecy order pursuant to § 5.2 from the relevant department or agency must be presented in order to prevent abandonment of the application.<

Dated: July 27, 1995.

Bruce A. Lehman,

Assistant Secretary of Commerce and Commissioner of Patents and Trademarks.

Note: The following appendixes will not appear in the Code of Federal Regulations.

BILLING CODE 3510–16–P

Appendix A—Forms

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Rev. 6/95

U.S. Department of Commerce
Patent and Trademark Office

FEE TRANSMITTAL

TOTAL AMOUNT OF PAYMENT ($)

Complete if Known	
Application Number	
Filing Date	
First Named Inventor	
Group Art Unit	
Examiner Name	
Attorney Docket Number	

METHOD OF PAYMENT *(check one)*

1 ☐ **The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:**

Deposit Account Number

Deposit Account Name

☐ Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

☐ Charge the Issue Fee Set in 37 CFR 1.18 at the Mailing of the Notice of Allowance, 37 CFR 1.311(b)

2 ☐ **Payment Enclosed:**

☐ Check

☐ Money Order

☐ Other

(reserved space)

FEE CALCULATION *(fees effective 10/01/94)*

1 FILING FEE

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
101	730	201	365	Utility filing	
106	300	206	150	Design filing fee	
107	490	207	245	Plant filing fee	
108	730	208	365	Reissue filing fee	

SUBTOTAL (1) ($)

2 CLAIMS

		Extra	Fee from below	Fee Paid
Total Claims	☐ - 20 =	☐	X ___	=
Independent Claims	☐ - 3 =	☐	X ___	=
Multiple Dependent Claims	☐			=

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description
102	76	202	38	Independent claims in excess of 3
103	22	203	11	Claims in excess of 20
104	240	204	120	Multiple dependent claim
109	76	209	38	Reissue independent claims over original patent
110	22	210	11	Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) ($)

3 ADDITIONAL FEES

Large Entity Fee Code	Large Entity Fee ($)	Small Entity Fee Code	Small Entity Fee ($)	Fee Description	Fee Paid
105	130	205	65	Surcharge-late filing fee or oath	
139	130	139	130	Non-English specification	
147	2,320	147	2,320	For filing a request for reexamination	
112	840	112	840	Requesting publication of SIR prior to Examiner action	
113	1,690	113	1,690	Requesting publication of SIR after Examiner action	
115	110	215	55	Extension for response within first month	
116	370	216	185	Extension for response within second month	
117	870	217	435	Extension for response within third month	
118	1,360	218	680	Extension for response within fourth month	
119	280	219	140	Notice of Appeal	
120	280	220	140	Filing a brief in support of an appeal	
121	240	221	120	Request for oral hearing	
138	1,390	138	1,390	Petition to institute a public use proceeding	
140	110	240	55	Petition to revive unavoidably abandoned application	
141	1,210	241	605	Petition to revive unintentionally abandoned application	
142	1,210	242	605	Utility issue fee (or reissue)	
143	420	243	210	Design issue fee	
144	610	244	305	Plant issue fee	
122	130	122	130	Petitions to the Commissioner	
126	210	126	210	Submission of Information Disclosure Stmt	
581	40	581	40	Recording each patent assignment per property (x no. properties)	
114	150	214	75	Provisional Application filing	

Other fee (specify) _____

Other fee (specify) _____

SUBTOTAL (3) ($)

SUBMITTED BY				Complete *(if applicable)*	
Typed or Printed Name				Reg. Number	
Signature		Date		Deposit Account User ID	

Burden Hour Statement: This form is estimated to take .2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0032), Washington DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Please type a plus sign (+) inside this box --> ☐

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U.S. Department of Commerce
Patent and Trademark Office

NEW UTILITY PATENT APPLICATION TRANSMITTAL

(to be used for new applications only)

Attorney Docket Number	
First Named Inventor	
Total Pages in this Submission	

APPLICATION ELEMENTS

*Notice: Checklist items mentioned under **Application Elements** section construct a new utility patent application. Please refer to MPEP Sections 506, 601, (37CFR 1.77, 1.53, 35 USC 111, 112, 113) for detailed explanation regarding completeness of an original patent application.*

1. ☐ Fee Transmittal Form (prescribed filing fee(s))
2. Specification
   - ☐ Abstract of the Disclosure
   - ☐ Title of the Invention
   - ☐ Cross References to Related Applications *(if applicable)*
   - ☐ Statement Regarding Federally-sponsored Research/Development *(if applicable)*
   - ☐ Reference to Microfiche Appendix *(if applicable)*
   - ☐ Background of the Invention
   - ☐ Brief Summary of the Invention
   - ☐ Brief Description of the Drawings *(if drawings filed)*
   - ☐ Detailed Description
   - ☐ Claim or Claims
3. ☐ Drawing(s) *(when necessary as prescribed by 35 USC 113)*
4. ☐ Executed Declaration
5. Genetic Sequence Submission *(if applicable, all must be included)*
   - ☐ Paper Copy
   - ☐ Computer Readable Copy
   - ☐ Statement Verifying Identical Paper and Computer Readable Copy

ACCOMPANYING APPLICATION PARTS

6. ☐ Assignment Papers
7. ☐ Certified Copy of Priority Document(s) *(if foreign priority is claimed)*
8. ☐ Computer Program in Microfiche
9. ☐ English Translation Document *(if applicable)*
10. ☐ Information Disclosure Statement/PTO-1449 ☐ Copies of IDS Citations
11. ☐ Petition Checklist and Accompanying Petition
12. ☐ Preliminary Amendment
13. ☐ Proprietary Information
14. ☐ Return Receipt Postcard
15. ☐ Small Entity Statement
16. ☐ Additional Enclosures *(please identify below):*

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm *or* Individual name	
Signature	
Date	

FOR OFFICIAL USE ONLY

Application Number			Class		Independent Claims	
Date of Receipt	Application Type		GAU		Total Claims	
	Filing Date		Foreign Filing License?		Drawing Sheets	
	Small Entity		Foreign Address?		Special Handling?	

Burden Hour Statement: This form is estimated to take .2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0032), Washington DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Please type a plus sign (+) inside this box --> ☐

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Rev. 6/95

U.S. Department of Commerce
Patent and Trademark Office

NEW DESIGN PATENT APPLICATION TRANSMITTAL

(to be used for new applications only)

Attorney Docket Number	
First Named Inventor	
Total Pages in this Submission	

APPLICATION ELEMENTS

*Notice: Checklist items mentioned under **Application Elements** section construct a new design patent application. Please refer to MPEP Section1500 (37 CFR 1.151, 1.152, 1.153, 1.154) for detailed explanation regarding completeness of an original design application*

1. ☐ Fee Transmittal Form (prescribed filing fee(s))
2. Specification
   - ☐ Preamble (Application name, Title of Design)
   - ☐ Cross References to Related Applications *(if applicable)*
   - ☐ Statement Regarding Federally-sponsored Research/Development *(if applicable)*
   - ☐ Description of the Figure(s) of the Drawings
   - ☐ Claim
3. ☐ Drawings
   - ☐ Photographs
4. ☐ Executed Declaration

ACCOMPANYING APPLICATION PARTS

5. ☐ Assignment Papers
6. ☐ Certified Copy of Priority Document(s) *(if foreign priority is claimed)*
7. ☐ English Translation Document *(if applicable)*
8. ☐ Information Disclosure Statement/PTO-1449 ☐ Copies of IDS Citations
9. ☐ Petition Checklist and Accompanying Petition
10. ☐ Preliminary Amendment
11. ☐ Proprietary Information
12. ☐ Return Receipt Postcard
13. ☐ Small Entity Statement
14. ☐ Additional Enclosures *(please identify below):*

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm *or* Individual name	
Signature	
Date	

FOR OFFICIAL USE ONLY

Application Number			Class		Drawing Sheets	
Date of Receipt	Application Type		GAU		Special Handling?	
	Filing Date		Foreign Filing License?			
	Small Entity		Foreign Address?			

Burden Hour Statement: This form is estimated to take .2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0032), Washington DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

Please type a plus sign (+) inside this box --> ☐

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U.S. Department of Commerce
Patent and Trademark Office

NEW PLANT PATENT APPLICATION TRANSMITTAL

(to be used for new applications only)

Attorney Docket Number	
First Named Inventor	
Total Pages in this Submission	

APPLICATION ELEMENTS

*Notice: Checklist items mentioned under **Application Elements** section construct a new plant patent application. Please refer to MPEP Sections 506, 601, 1600 (37 CFR 1.53, 35 USC 111, 112, 113) for detailed explanation regarding completeness of an original plant application.*

1. ☐ Fee Transmittal Form (prescribed filing fee(s))
2. Specification
   - ☐ Abstract of the Disclosure
   - ☐ Title of the Invention *(with Plant's name)*
   - ☐ Cross References to Related Applications *(if applicable)*
   - ☐ Statement Regarding Federally-sponsored Research/Development *(if applicable)*
   - ☐ Background of the Invention
   - ☐ Brief Summary of the Invention
   - ☐ Brief Description of the Drawings
   - ☐ Detailed Botanical Description
   - ☐ Claim
3. ☐ Drawing(s) in duplicate *(as prescribed by 35 USC 165)*
4. ☐ Executed Declaration
5. ☐ Plant Color Coding Sheet

ACCOMPANYING APPLICATION PARTS

6. ☐ Assignment Papers
7. ☐ Certified Copy of Priority Document(s) *(if foreign priority is claimed)*
8. ☐ English Translation Document *(if applicable)*
9. ☐ Information Disclosure Statement/PTO-1449 ☐ Copies of IDS Citations
10. ☐ Petition Checklist and Accompanying Petition
11. ☐ Preliminary Amendment
12. ☐ Proprietary Information
13. ☐ Return Receipt Postcard
14. ☐ Small Entity Statement
15. ☐ Additional Enclosures *(please identify below):*

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm *or* Individual name	
Signature	
Date	

FOR OFFICIAL USE ONLY

Application Number			Class		Drawing Sheets	
Date of Receipt	Application Type		GAU		Special Handling?	
	Filing Date		Foreign Filing License?			
	Small Entity		Foreign Address?			

Burden Hour Statement: This form is estimated to take .2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0032), Washington DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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U.S. Department of Commerce
Patent and Trademark Office

PLANT COLOR CODING SHEET

(to be used for new applications only)

Sheet		of	

Attorney Docket Number	
First Named Inventor	
FOR OFFICIAL USE ONLY	
Date of Receipt	
Application Number	

PLEASE LIST THE ITEM TO WHICH COLOR IS A DISTINGUISHING FEATURE, THE COLOR CODE WHICH BEST REPRESENTS THAT PLANT STRUCTURE AND THE COLOR CODE SYSTEM.

ITEM	COLOR

COLOR CODE SYSTEM:	

Burden Hour Statement: This form is estimated to take .2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0032), Washington DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

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Type a plus sign (+) inside this box → ☐ Approved for use through OMB 0651-0032

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0010/PTO Rev. 6/95 — U.S. Department of Commerce Patent and Trademark Office

DECLARATION

☐ Declaration Submitted with Initial Filing OR ☐ Declaration Submitted after Initial Filing

Attorney Docket Number	
First Named Inventor	
COMPLETE IF KNOWN	
Application Number	
Filing Date	
Group Art Unit	
Examiner Name	

As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled :

(Title of the Invention)

the specification of which

☐ is attached hereto

OR

☐ was filed on (MM/DD/YYYY) ☐ as United States Application Number or PCT International

Application Number ☐ and was amended on (MM/DD/YYYY) ☐ (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37 Code of Federal Regulations, §1.56.

I hereby claim foreign priority benefits under Title 35, United States Code §119 (a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365 (a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Copy Attached? YES	NO
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐

☐ Additional foreign application numbers are listed on a supplemental priority sheet attached hereto:

I hereby claim the benefit under Title 35, United States Code §119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date (MM/DD/YYYY)	
		☐ Additional provisional application numbers are listed on a supplemental priority sheet attached hereto.

Burden Hour Statement: This form is estimated to take .4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0032), Washington DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

DECLARATION

Page 2

I hereby claim the benefit under Title 35, United States Code §120 of any United States application(s), or §365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code §112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. Parent Application Number	PCT Parent Number	Parent Filing Date (MM/DD/YYYY)	Parent Patent Number *(if applicable)*

☐ Additional U.S. or PCT international application numbers are listed on a supplemental priority sheet attached hereto.

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Firm Name | Payor Number (if applicable)

Name	Registration Number	Name	Registration Number

☐ Additional attorney(s) and/or agent(s) named on a supplemental sheet attached hereto.

☐ Please direct all correspondence to: **Name**

Address

Address

City | **State** | **ZIP**

Country | **Telephone** | **Fax**

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor: ☐ A petition has been filed for this unsigned inventor

Given Name | **Middle Initial** | **Family Name** | **Suffix**

Inventor's Signature | **Date**

RESIDENCE: City | **State** | **Country** | **Citizenship**

POST OFFICE ADDRESS

City | **State** | **Zip** | **Country** | **Applicant Authority**

☐ Additional inventors are being named on supplemental sheet(s) attached hereto

Type a plus sign (+) inside this box --> ☐

DECLARATION

ADDITIONAL INVENTOR(S) Supplemental Sheet

Name of Additional Joint Inventor, if any: ☐ A petition has been filed for this unsigned inventor

Given Name		Middle Initial		Family Name		Suffix	
Inventor's Signature						Date	
RESIDENCE: City		State		Country		Citizenship	
POST OFFICE ADDRESS							
City		State		Zip		Country		Applicant Authority	

Name of Additional Joint Inventor, if any: ☐ A petition has been filed for this unsigned inventor

Given Name		Middle Initial		Family Name		Suffix	
Inventor's Signature						Date	
RESIDENCE: City		State		Country		Citizenship	
POST OFFICE ADDRESS							
City		State		Zip		Country		Applicant Authority	

Name of Additional Joint Inventor, if any: ☐ A petition has been filed for this unsigned inventor

Given Name		Middle Initial		Family Name		Suffix	
Inventor's Signature						Date	
RESIDENCE: City		State		Country		Citizenship	
POST OFFICE ADDRESS							
City		State		Zip		Country		Applicant Authority	

Name of Additional Joint Inventor, if any: ☐ A petition has been filed for this unsigned inventor

Given Name		Middle Initial		Family Name		Suffix	
Inventor's Signature						Date	
RESIDENCE: City		State		Country		Citizenship	
POST OFFICE ADDRESS							
City		State		Zip		Country		Applicant Authority	

☐ Additional inventors are being named on supplemental sheet(s) attached hereto

DECLARATION	**PRIORITY DATA (Supplemental Sheet)**

Additional foreign applications:

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Copy Attached? YES	Copy Attached? NO
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐

Additional provisional applications:

Application Number	Filing Date (MM/DD/YYYY)

Additional U.S. applications:

U.S. Parent Application Number	PCT Parent Number	Parent Filing Date (MM/DD/YYYY)	Parent Patent Number *(if applicable)*

DECLARATION	ATTORNEY and/or AGENT INFORMATION (Supplemental Sheet)

Name	Registration Number	Name	Registration Number

PTO/SB/ xx (6-95)

Type a plus sign (+) inside this box → ☐ Approved for use through OMB 0651-0032

Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

0010/PTO Rev. 6/95 — U.S. Department of Commerce Patent and Trademark Office

PLANT PATENT APPLICATION (35 USC §161) DECLARATION

☐ Declaration Submitted with Initial Filing OR ☐ Declaration Submitted after Initial Filing

Attorney Docket Number	
First Named Inventor	
COMPLETE IF KNOWN	
Application Number	
Filing Date	
Group Art Unit	
Examiner Name	

As a below named inventor, I hereby declare that:

My residence, post office address, and citizenship are as stated below next to my name.

I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the new and distinct variety of:

plant named:

which is claimed and for which a plant patent is sought,

the specification of which ☐ is attached hereto ☐ was filed on (MM/DD/YYYY) as United States Application Number or PCT International Application Number and was amended on (MM/DD/YYYY) (if applicable).

I hereby state that I have reviewed and understand the contents of the above identified specification, including the claims, as amended by any amendment specifically referred to above.

I hereby asexually reproduced the plant to which this application applies.

☐ Said plant was found in a cultivated area *(check this box for newly found plant only)*

I acknowledge the duty to disclose information which is material to patentability as defined in Title 37 Code of Federal Regulations, § 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code §119 (a)-(d) or §365(b) of any foreign application(s) for patent or inventor's certificate, or §365(a) of any PCT international application which designated at least one country other than the United States of America, listed below and have also identified below, by checking the box, any foreign application for patent or inventor's certificate, or of any PCT international application having a filing date before that of the application on which priority is claimed.

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Copy Attached? YES	NO
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐
			☐	☐	☐

☐ Additional foreign application numbers are listed on a supplemental sheet(s) attached hereto:

I hereby claim the benefit under Title 35, United States Code § 119(e) of any United States provisional application(s) listed below.

Application Number(s)	Filing Date (MM/DD/YYYY)	
		☐ Additional provisional application numbers are list on a supplemental sheet(s) attached hereto.

Burden Hour Statement: This form is estimated to take .4 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0032), Washington, DC 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

DECLARATION

Page 2

I hereby claim the benefit under Title 35, United States Code § 120 of any United States application(s) or § 365(c) of any PCT international application designating the United States of America, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States or PCT International application in the manner provided by the first paragraph of Title 35, United States Code § 112, I acknowledge the duty to disclose information which is material to patentability as defined in Title 37, Code of Federal Regulations § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application.

U.S. Parent Application Number	PCT Parent Number	Parent Filing Date (MM/DD/YYYY)	Parent Patent Number *(if applicable)*

☐ Additional U.S. or PCT international application numbers are listed on a supplemental sheet(s) attached hereto:

As a named inventor, I hereby appoint the following attorney(s) and/or agent(s) to prosecute this application and to transact all business in the Patent and Trademark Office connected therewith:

Firm Name | Payor Number (if applicable)

Name	Registration Number	Name	Registration Number

☐ Please direct all correspondence to: **Name**

Address

Address

City | **State** | **ZIP**

Country | **Telephone** | **Fax**

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Name of Sole or First Inventor: ☐ A petition has been filed for this unsigned inventor

Given Name		Middle Initial		Family Name		Suffix	
Inventor's Signature					Date		
RESIDENCE: City		State		Country		Citizenship	
POST OFFICE ADDRESS							
City		State		Zip		Country		Applicant Authority	

☐ Additional inventors are being named on separately numbered sheets attached hereto.

Type a plus sign (+) inside this box --> ☐

DECLARATION

Additional Inventor(s) Supplemental Sheet

Name of Additional Joint Inventor, if any:		☐ A petition has been filed for this unsigned inventor							
Given Name		Middle Initial		Family Name		Suffix			
Inventor's Signature						Date			
RESIDENCE: City		State		Country		Citizenship			
POST OFFICE ADDRESS									
City		State		Zip		Country		Applicant Authority	
Name of Additional Joint Inventor, if any:		☐ A petition has been filed for this unsigned inventor							
Given Name		Middle Initial		Family Name		Suffix			
Inventor's Signature						Date			
RESIDENCE: City		State		Country		Citizenship			
POST OFFICE ADDRESS									
City		State		Zip		Country		Applicant Authority	
Name of Additional Joint Inventor, if any:		☐ A petition has been filed for this unsigned inventor							
Given Name		Middle Initial		Family Name		Suffix			
Inventor's Signature						Date			
RESIDENCE: City		State		Country		Citizenship			
POST OFFICE ADDRESS									
City		State		Zip		Country		Applicant Authority	
Name of Additional Joint Inventor, if any:		☐ A petition has been filed for this unsigned inventor							
Given Name		Middle Initial		Family Name		Suffix			
Inventor's Signature						Date			
RESIDENCE: City		State		Country		Citizenship			
POST OFFICE ADDRESS									
City		State		Zip		Country		Applicant Authority	

☐ Additional inventors are being named on separately numbered sheets attached hereto

SUPPLEMENTAL PRIORITY SHEET

Additional foreign applications:

Prior Foreign Application Number(s)	Country	Foreign Filing Date (MM/DD/YYYY)	Priority Not Claimed	Copy Attached? YES	Copy Attached? NO
			☐	☐	☐
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			☐	☐	☐
			☐	☐	☐

Additional provisional applications:

Application Number	Filing Date (MM/DD/YYYY)

Additional U.S. applications:

U.S. Parent Application Number	PCT Parent Number	Parent Filing Date (MM/DD/YYYY)	Parent Patent Number *(if applicable)*

BILLING CODE 3510–16–C

APPENDIX B—COMPARISON OF EXISTING AND REVISED FEE AMOUNTS

37 CFR sec.	Description	Pre-Oct 1995	Oct 1995	Jan 1996
1.16(a)	Basic Filing Fee	$730	$750	$780
1.16(a)	Basic Filing Fee (Small Entity)	365	375	390
1.16(b)	Independent Claims	76	78	—
1.16(b)	Independent Claims (Small Entity)	38	39	—
1.16(c)	Claims in Excess of 20	22	—	—
1.16(c)	Claims in Excess of 20 (Small Entity)	11	—	—
1.16(d)	Multiple Dependent Claims	240	250	—
1.16(d)	Multiple Dependent Claims (Small Entity)	120	125	—
1.16(e)	Surcharge—Late Filing Fee	130	—	—
1.16(e)	Surcharge—Late Filing Fee (Small Entity)	65	—	—
1.16(f)	Design Filing Fee	300	310	—
1.16(f)	Design Filing Fee (Small Entity)	150	155	—
1.16(g)	Plant Filing Fee	490	510	540
1.16(g)	Plant Filing Fee (Small Entity)	245	255	270
1.16(h)	Reissue Filing Fee	730	750	780
1.16(h)	Reissue Filing Fee (Small Entity)	365	375	390
1.16(i)	Reissue Independent Claims	76	78	—
1.16(i)	Reissue Independent Claims (Small Entity)	38	39	—
1.16(j)	Reissue Claims in Excess of 20	22	—	—
1.16(j)	Reissue Claims in Excess of 20 (Small Entity)	11	—	—
1.16(k)	Provisional Application Filing Fee	150	—	—
1.16(k)	Provisional Application Filing Fee (Small Entity)	75	—	—
1.16(l)	Surcharge—Incomplete Provisional App. Filed	50	—	—
1.16(l)	Surcharge—Incomplete Provisional App. Filed (Small Entity)	25	—	—
1.17(a)	Extension—First Month	110	—	—
1.17(a)	Extension—First Month (Small Entity)	55	—	—
1.17(b)	Extension—Second Month	370	380	—
1.17(b)	Extension—Second Month (Small Entity)	185	190	—
1.17(c)	Extension—Third Month	870	900	—
1.17(c)	Extension—Third Month (Small Entity)	435	450	—
1.17(d)	Extension—Fourth Month	1,360	1,400	—
1.17(d)	Extension—Fourth Month (Small Entity)	680	700	—
1.17(e)	Notice of Appeal	280	290	—
1.17(e)	Notice of Appeal (Small Entity)	140	145	—
1.17(f)	Filing a Brief	280	290	—
1.17(f)	Filing a Brief (Small Entity)	140	145	—
1.17(g)	Request for Oral Hearing	240	250	—
1.17(g)	Request for Oral Hearing (Small Entity)	120	125	—
1.17(h)	Petition—Not All Inventors	130	—	—
1.17(h)	Petition—Correction of Inventorship	130	—	—
1.17(h)	Petition—Decision on Questions	130	—	—
1.17(h)	Petition—Suspend Rules	130	—	—
1.17(h)	Petition—Expedited License	130	—	—
1.17(h)	Petition—Scope of License	130	—	—
1.17(h)	Petition—Retroactive License	130	—	—
1.17(h)	Petition—Refusing Maintenance Fee	130	—	—
1.17(h)	Petition—Refusing Maintenance Fee—Expired Patent	130	—	—
1.17(h)	Petition—Interference	130	—	—
1.17(h)	Petition—Reconsider Interference	130	—	—
1.17(h)	Petition—Late Filing of Interference	130	—	—
1.20(b)	Petition—Correction of Inventorship	130	—	—
1.17(h)	Petition—Refusal to Publish SIR	130	—	—
1.17(i)	Petition—For Assignment	130	—	—
1.17(i)	Petition—For Application	130	—	—
1.17(i)	Petition—Late Priority Papers	130	—	—
1.17(i)	Petition—Suspend Action	130	—	—
1.17(i)	Petition—Divisional Reissues to Issue Separately	130	—	—
1.17(i)	Petition—For Interference Agreement	130	—	—
1.17(i)	Petition—Amendment After Issue	130	—	—
1.17(i)	Petition—Withdrawal After Issue	130	—	—
1.17(i)	Petition—Defer Issue	130	—	—
1.17(i)	Petition—Issue to Assignee	130	—	—
1.17(i)	Petition—Accord a Filing Date Under § 1.53	130	—	—
1.17(i)	Petition—Accord a Filing Date Under § 1.62	130	—	—
1.17(i)	Petition—Make Application Special	130	—	—
1.17(j)	Petition—Public Use Proceeding	1,390	1,430	—
1.17(k)	Non-English Specification	130	—	—
1.17(l)	Petition—Revive Abandoned Application	110	—	—
1.17(l)	Petition—Revive Abandoned Application (Small Entity)	55	—	—
1.17(m)	Petition—Revive Unintentionally Abandoned Application	1,210	1,250	—
1.17(m)	Petition—Revive Unintent Abandoned Application (Small Entity)	605	625	—

APPENDIX B—COMPARISON OF EXISTING AND REVISED FEE AMOUNTS—Continued

37 CFR sec.	Description	Pre-Oct 1995	Oct 1995	Jan 1996
1.17(n)	SIR—Prior to Examiner's Action	840	870	—
1.17(o)	SIR—After Examiner's Action	1,690	1,740	—
1.17(p)	Submission of an Information Disclosure Statement (§ 1.97)	210	220	—
1.17(q)	Petition—Correction of Inventorship (Provisional Application)	50	—	—
1.17(q)	Petition—Accord a filing date (Prov. App.)	50	—	—
1.17(r)	Filing a submission after final rejection (1.129(a))	730	750	—
1.17(r)	Filing a submission after final rejection (1.129(a)) (Small Entity)	365	375	—
1.17(s)	Per add'l invention to be examined (1.129(b))	730	750	—
1.17(s)	Per add'l invention to be examined (1.129(b)) (Small Entity)	365	375	—
1.17(t)	For filing a protest in an application after publication (1.291)	—	—	220
1.17(u)	Acceptance of a late claim for priority (119(a)–(d))	—	—	1,500
1.17(u)	Acceptance of a late claim for benefit of prior application (119(e))	—	—	1,500
1.18(a)	Issue Fee	1,210	1,250	1,280
1.18(a)	Issue Fee (Small Entity)	605	625	640
1.18(b)	Design Issue Fee	420	430	—
1.18(b)	Design Issue Fee (Small Entity)	210	215	—
1.18(c)	Plant Issue Fee	610	630	660
1.18(c)	Plant Issue Fee (Small Entity)	305	315	330
1.19(a)(1)(i)	Copy of Patent	3	—	—
1.19(a)(1)(ii)	Patent Copy—Overnight delivery to PTO Box or overnight fax	6	—	—
1.19(a)(1)(iii)	Patent Copy Ordered by Expedited Mail or Fax—Expedited service	25	—	—
1.19(a)(2)	Plant Patent Copy	12	—	—
1.19(a)(3)(i)	Copy of Utility Patent or SIR in Color	24	—	—
1.19(a)(4)	Copy of a technical contents publication	—	—	9
1.19(b)(1)(i)	Certified Copy of Patent Application as Filed	12	15	—
1.19(b)(1)(ii)	Certified Copy of Patent Application as Filed, Expedited	24	30	—
1.19(b)(2)	Certified or Uncertified Copy of pub. app. or patent-related file wrapper.	150	—	—
1.19(b)(3)	Cert. or Uncert. Copies of Office Records, per Document	25	—	—
1.19(b)(4)(i)	Certified or uncertified copy of first doc. contained in pending application.	—	—	75
1.19(b)(4)(ii)	Certified or uncertified copy of second and subsequent doc. in pending application.	—	—	25
1.19(b)(5)	For Assignment Records, Abstract of Title and Certification	25	—	—
1.19(c)	Library Service	50	—	—
1.19(d)	List of Patents and Published Applications in Subclass	3	—	—
1.19(e)	Uncertified Statement-Status of Maintenance Fee Payment	10	—	—
1.19(f)	Copy of Non-U.S. Patent Document	25	—	—
1.19(g)	Comparing and Certifying Copies, Per Document, Per Copy	25	—	—
1.19(h)	Duplicate or Corrected Filing Receipt	25	—	—
1.20(a)	Certificate of Correction	100	—	—
1.20(c)	Reexamination	2,320	2,390	—
1.20(d)	Statutory Disclaimer	110	—	—
1.20(d)	Statutory Disclaimer (Small Entity)	55	—	—
1.20(e)	Maintenance Fee—3.5 Years	960	990	1,020
1.20(e)	Maintenance Fee—3.5 Years (Small Entity)	480	495	510
1.20(f)	Maintenance Fee—7.5 Years	1,930	1,990	2,020
1.20(f)	Maintenance Fee—7.5 Years (Small Entity)	965	995	1,010
1.20(g)	Maintenance Fee—11.5 Years	2,900	2,990	3,020
1.20(g)	Maintenance Fee—11.5 Years (Small Entity)	1,450	1,495	1,510
1.20(h)	Surcharge—Maintenance Fee—6 Months	130	—	—
1.20(h)	Surcharge—Maintenance Fee—6 Months (Small Entity)	65	—	—
1.20(i)(1)	Surcharge—Maintenance After Expiration—Unavoidable	640	660	—
1.20(i)(2)	Surcharge—Maintenance After Expiration—Unintentional	1,500	1,550	—
1.20(j)	Extension of Term of Patent	1,030	1,060	—
1.21(a)(1)	Admission to Examination	300	310	—
1.21(a)(2)	Registration to Practice	100	—	—
1.21(a)(3)	Reinstatement to Practice	15	—	—
1.21(a)(4)	Certificate of Good Standing	10	—	—
1.21(a)(4)	Certificate of Good Standing, Suitable Framing	20	—	—
1.21(a)(5)	Review of Decision of Director, OED	130	—	—
1.21(a)(6)	Regrading of Examination	130	—	—
1.21(b)(1)	Establish Deposit Account	10	—	—
1.21(b)(2)	Service Charge Below Minimum Balance	25	—	—
1.21(b)(3)	Service Charge Below Minimum Balance	25	—	—
1.21(c)	Filing a Disclosure Document	10	—	—
1.21(d)	Box Rental	50	—	—
1.21(e)	International Type Search Report	40	—	—
1.21(g)	Self-Service Copy Charge	.25	—	—
1.21(h)	Recording Patent Property	40	—	—
1.21(i)	Publication in the OG	25	—	—

APPENDIX B—COMPARISON OF EXISTING AND REVISED FEE AMOUNTS—Continued

37 CFR sec.	Description	Pre-Oct 1995	Oct 1995	Jan 1996
1.21(j)	Labor Charges for Services	30	—	—
1.21(k)	Unspecified Other Services	(1)	—	—
1.21(k)	Terminal Use APS-CSIR (per hour)	50	—	—
1.21(m)	Processing Returned Checks	50	—	—
1.21(n)	Handling Fee—Incomplete Application	130	—	—
1.21(o)	Terminal Use APS-TEXT	40	—	—
1.24	Coupons for Patent and Trademark Copies	3	—	—
1.296	Handling Fee—Withdrawal SIR	130	—	—
1.445(a)(1)	Transmittal Fee	210	220	—
1.445(a)(2)(i)	PCT Search Fee—No U.S. Application	640	660	—
1.445(a)(2)(ii)	PCT Search Fee—Prior U.S. Application	420	430	—
1.445(a)(3)	Supplemental Search	180	190	—
1.482(a)(1)(i)	Preliminary Exam Fee	460	470	—
1.482(a)(1)(ii)	Preliminary Exam Fee	690	710	—
1.482(a)(2)(i)	Additional Invention	140	—	—
1.482(a)(2)(ii)	Additional Invention	240	250	—
1.492(a)(1)	Preliminary Examining Authority	660	680	710
1.492(a)(1)	Preliminary Examining Authority (Small Entity)	330	340	355
1.492(a)(2)	Searching Authority	730	750	780
1.492(a)(2)	Searching Authority (Small Entity)	365	375	390
1.492(a)(3)	PTO Not ISA nor IPEA	980	1,010	1,040
1.492(a)(3)	PTO Not ISA nor IPEA (Small Entity)	490	505	520
1.492(a)(4)	Claims—IPEA	92	94	120
1.492(a)(4)	Claims—IPEA (Small Entity)	46	47	60
1.492(a)(5)	Filing with EPO/JPO Search Report	850	880	910
1.492(a)(5)	Filing with EPO/JPO Search Report (Small Entity)	425	440	455
1.492(b)	Claims—Extra Independent (Over 3)	76	78	—
1.492(b)	Claims—Extra Independent (Over 3) (Small Entity)	38	39	—
1.492(c)	Claims—Extra Total (Over 20)	22	—	—
1.492(c)	Claims—Extra Total (Over 20) (Small Entity)	11	—	—
1.492(d)	Claims—Multiple Dependents	240	250	—
1.492(d)	Claims—Multiple Dependents (Small Entity)	120	125	—
1.492(e)	Surcharge	130	—	—
1.492(e)	Surcharge (Small Entity)	65	—	—
1.492(f)	English Translation—After 20 Months	130	—	—
2.6(a)(1)	Application for Registration, Per Class	245	—	—
2.6(a)(2)	Amendment to Allege Use, Per Class	100	—	—
2.6(a)(3)	Statement of Use, Per Class	100	—	—
2.6(a)(4)	Extension for Filing Statement of Use, Per Class	100	—	—
2.6(a)(5)	Application for Renewal, Per Class	300	—	—
2.6(a)(6)	Surcharge for Late Renewal, Per Class	100	—	—
2.6(a)(7)	Publication of Mark Under §12(c), Per Class	100	—	—
2.6(a)(8)	Issuing New Certificate of Registration	100	—	—
2.6(a)(9)	Certificate of Correction of Registrant's Error	100	—	—
2.6(a)(10)	Filing Disclaimer to Registration	100	—	—
2.6(a)(11)	Filing Amendment to Registration	100	—	—
2.6(a)(12)	Filing Affidavit Under Section 8, Per Class	100	—	—
2.6(a)(13)	Filing Affidavit Under Section 15, Per Class	100	—	—
2.6(a)(14)	Filing Affidavit Under Sections 8 & 15, Per Class	200	—	—
2.6(a)(15)	Petitions to the Commissioner	100	—	—
2.6(a)(16)	Petition to Cancel, Per Class	200	—	—
2.6(a)(17)	Notice of Opposition, Per Class	200	—	—
2.6(a)(18)	Ex Parte Appeal to the TTAB, Per Class	100	—	—
2.6(a)(19)	Dividing an Application, Per New Application Created	100	—	—
2.6(b)(1)(i)	Copy of Registered Mark	3	—	—
2.6(b)(1)(ii)	Copy of Registered Mark, overnight delivery to PTO box or fax	6	—	—
2.6(b)(1)(iii)	Copy of Reg. Mark Ordered Via Exp. Mail or Fax, Exp. Svc.	25	—	—
2.6(b)(2)(i)	Certified Copy of TM Application as Filed	12	15	—
2.6(b)(2)(ii)	Certified Copy of TM Application as Filed, Expedited	24	30	—
2.6(b)(3)	Cert. or Uncert. Copy of TM-Related File Wrapper/Contents	50	—	—
2.6(b)(4)(i)	Cert. Copy of Registered Mark, Title or Status	10	—	—
2.6(b)(4)(ii)	Cert. Copy of Registered Mark, Title or Status—Expedited	20	—	—
2.6(b)(5)	Certified or Uncertified Copy of TM Records	25	—	—
2.6(b)(6)	Recording Trademark Property, Per Mark, Per Document	40	—	—
2.6(b)(6)	For Second and Subsequent Marks in Same Document	25	—	—
2.6(b)(7)	For Assignment Records, Abstracts of Title and Cert.	25	—	—
2.6(b)(8)	Terminal Use X-SEARCH	40	—	—

APPENDIX B—COMPARISON OF EXISTING AND REVISED FEE AMOUNTS—Continued

37 CFR sec.	Description	Pre-Oct 1995	Oct 1995	Jan 1996
2.6(b)(9)	Self-Service Copy Charge	0.25	—	—
2.6(b)(10)	Labor Charges for Services	30	—	—
2.6(b)(11)	Unspecified Other Services	(1)	—	—

[1] Actual cost.

[FR Doc. 95–18886 Filed 8–14–95; 8:45 am]

BILLING CODE 3510–16–P